





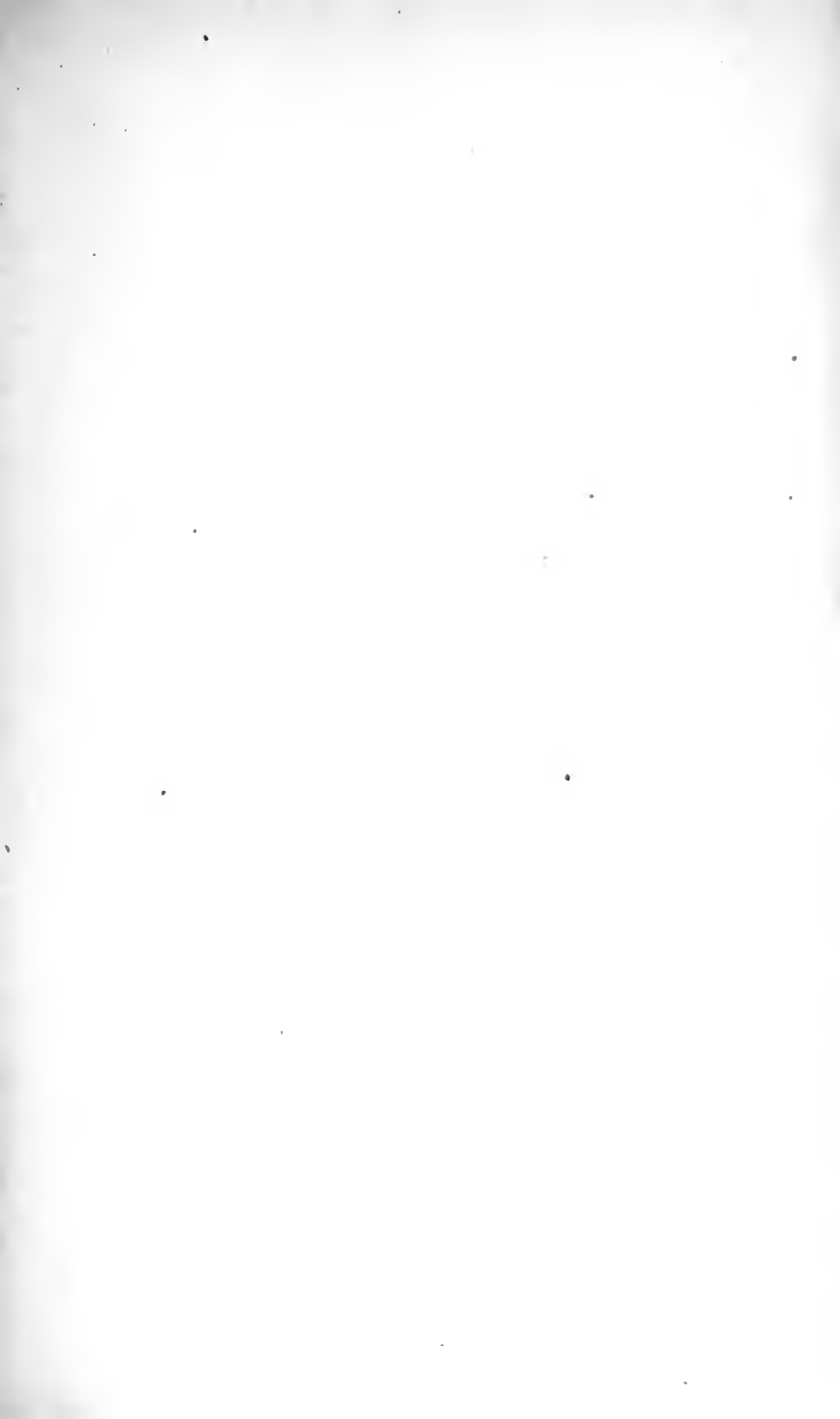
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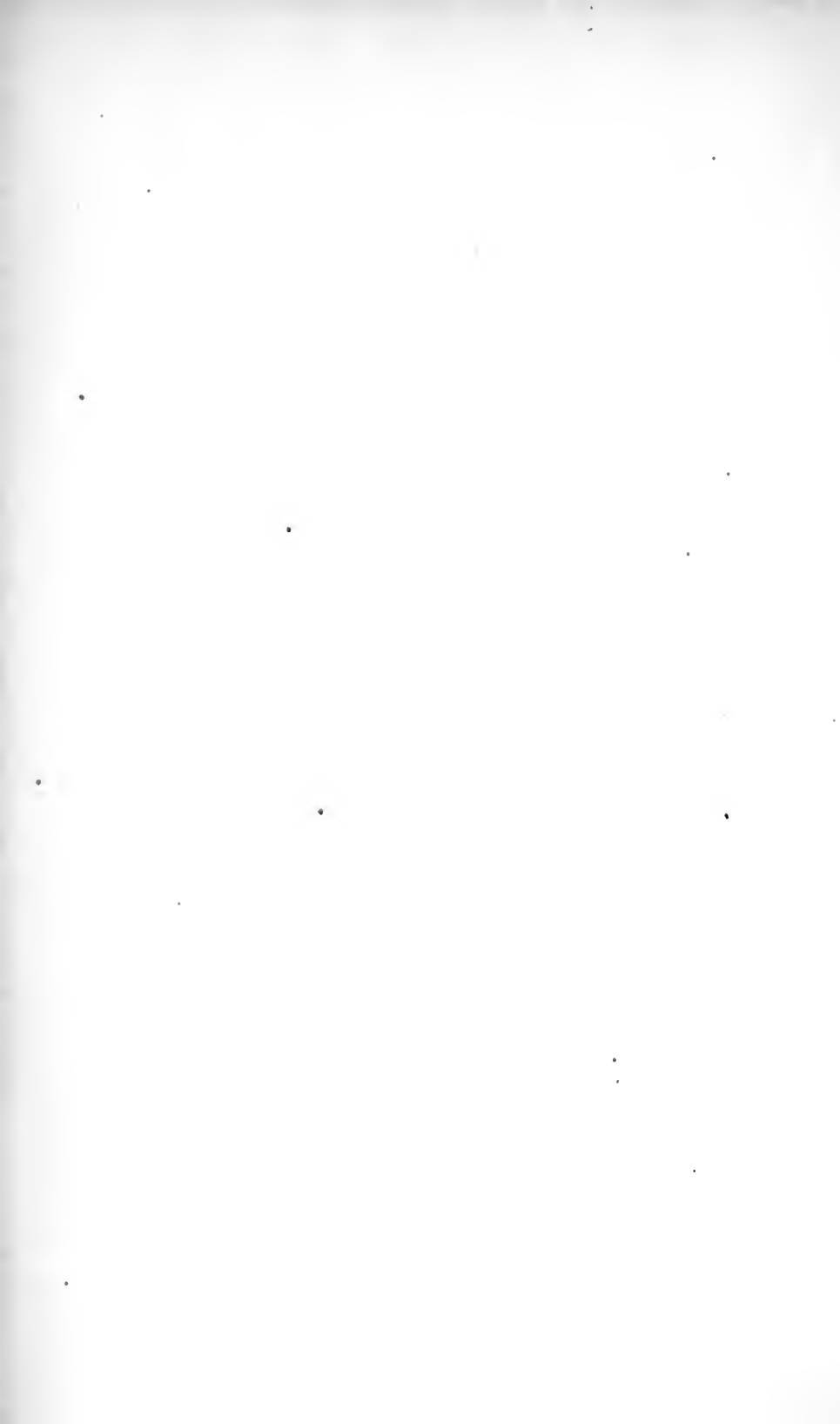
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THE LAW  
OF  
UNFAIR TRADE

INCLUDING

TRADE-MARKS, TRADE SECRETS,  
AND GOOD-WILL.

BY  
JAMES L. HOPKINS,  
OF THE  
SAN FRANCISCO BAR.

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This book is inscribed to  
my friend,

ADOLPH L. PINCOFFS, J. U. D.,

of the Bar of the City of  
New York.



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# LAW OF UNFAIR TRADE.

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## CHAPTER I.

### PREFATORY.

§ 1. **The need of legal restraint of unfair trade.**—From the early days of commerce, probably from its beginning, the keen rivalry of competing merchants has led to the use of unfair and dishonest methods of diverting custom. With the growth of commerce has come a corresponding increase of fraudulent competition and its attendant evils. The English-speaking people were slow to realize that some legal restraint should be imposed upon the dealer who seeks to secure patronage by dressing his goods in a manner calculated to deceive the public into a belief that they are the goods of another. There are a few unimportant unfair trade cases in the English reports of the eighteenth century; the first reported American decision was rendered in 1825.<sup>1</sup> The law as it is administered by the courts of the United States to-day is almost wholly the product of the last half-century.

The purpose of this treatise is to discuss the law of unfair trade in its broadest sense, including not only the law of trade-marks, but also the principles applicable to the restraint of fraudulent competition in cases where no trade-mark is involved. "The law of trade-marks is but part of the law of unfair competition in trade."<sup>2</sup>

<sup>1</sup>Snowden v. Noah, Hopkins' Ch. 347.

<sup>2</sup>Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-659.

**§ 2. Trade-mark defined.**<sup>1</sup>—A trade-mark is a distinctive<sup>2</sup> name, word, mark, emblem, design, symbol or

<sup>1</sup>*Judicial definitions.*—"A trade-mark may consist of a name, symbol, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity." Mr. Justice Clifford in *McLean v. Fleming*, 96 U. S. 245-254, and in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51-60.

"A trade-mark, properly so called, may be described as a particular mark or symbol, used by a person for the purpose of denoting that the article to which it is affixed is sold or manufactured by him or by his authority, or that he carries on business at a particular place." Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*, 35 L. J. Ch. 61.

"A trade-mark is a mere notice, an arbitrary mark or sign put on an artificial product, whereby any person interested in the information may be assured as to the origin of said product." Showalter, J., in *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-380.

"A trade-mark is a peculiar name or device, by which a person dealing in an article designates it as of a peculiar kind, character or quality, or as manufactured by or for him, or dealt in by him, and of which he is entitled to the exclusive use." Devens, J., in *Weener v. Brayton*, 152 Mass. 101, 102.

"It is a mode of designating goods as being the goods which have been, in some way or other, dealt with by A. B., the person who owns the trade-mark." Kay, J., in *Re The Australian Wine Importers, (Ltd.)*, L. R. 41 Ch. D. 278-281.

"Symbols or devices used by a manufacturer or merchant to distinguish the products, manufactures, or merchandise which he pro-

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<sup>2</sup>By the word "distinctive," as used in our definition, is meant that the mark must be something which "shall be capable of distinguishing the particular goods in relation to which it is to be used from other goods of a like character belonging to other people." Lord Chief Justice Russell, in *Rowland v. Mitchell*, L. R. (1897) 1 Ch. D. 71-74. *Wood v. Lambert*, L. R. 32 Ch. D. 247; 54 L. T. N. S. 314; 3 P. R. 81; (Court of Appeals) L. R. 32 Ch. D. 257; 55 L. J. Ch. 277; 54 L. T. N. S. 317; 3 P. R. 88; *Re Perry Davis & Son*, 58 L. T. N. S. 695; 5 P. R. 333, and many similar English cases treat of the word "distinctive" as used in the English Patents, Designs and Trade-marks Act of 1883, section 64, sub-section 1, c. But the word is used with the same significance by our own leading jurists, as for example, by Justice Holmes, in *North-Eastern Awl Co. v. Marlborough Awl Co.*, 168 Mass. 147; 60 Am. St. Rep. 373; and by Judge Lacombe in *National Biscuit Co. v. Baker*, 95 Fed. Rep. 136. For this reason the word is incorporated in the definition given in the text.



device, used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed, the chattel upon or to which it is affixed.<sup>1</sup>

duces, manufactures or sells, from that of others, are called and known by the name of trade-marks. They are used in order that such products, manufactures or merchandise may be known as belonging to the owner of the symbol or device, and that he may secure the profits from its reputation or superiority." Mr. Justice Clifford in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51-56.

"Any name, symbol, letter, figure or device adopted by the persons manufacturing or selling goods, and used and put upon such goods to distinguish them from those manufactured or sold by others, and employed so often and for such a length of time, as to raise the presumption that the public would know that it was used to indicate ownership of the goods in the person manufacturing or selling them, constitutes his trade-mark." Rhodes, J., in *Derringer v. Plate*, 29 Cal. 292; Cox, 324.

"A trade-mark is a symbol arbitrarily selected by a manufacturer or dealer, and attached to his wares to indicate that they are his wares." Douglas, J., in *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763-765.

"It is a sign or mark by which the manufactured articles produced by one person, or firm, or maker are distinguishable from those produced by rival manufacturers." Williams, J., in *Hoyt v. Hoyt*, 143 Pa. St. 623; 24 Am. St. Rep. 575.

"A trade-mark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his productions from other productions of the same article." Gilfillan, C. J., in *Cigarmakers' Protective Union v. Conhaim*, 40 Minn. 243; 12 Am. St. Rep. 726.

"A trade-mark is a name, sign, symbol, mark, brand, or device of any kind, used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods." Beck, J., in *Shaver v. Shaver*, 54 Iowa, 208; Price & Steuart, 395.

"A trade-mark may consist of anything, marks, forms, symbols, which designate the true origin or ownership of the article." Monell, J., in *Godillot v. Hazard*, 44 N. Y. Sup. Ct. 427.

"A trade-mark is . . . the name, symbol, figure, letter, form, or device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the

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<sup>1</sup>The mode in which the mark is affixed is immaterial. It may be water-marked in translucent fabrics. *Price v. Goodall*, L. R. (1891) 1 Ch. D. 35. It has been held to be a sufficient method of affixing the mark, to use it in advertising, and to place a lithographed fac-simile of it on a card, in a box containing a quantity of the goods. *Hay & Todd Mfg. Co. v. Querns Brothers*, 86 Off. Gaz. 1323.

§ 3. **Earliest recognition of trade-marks.**—While the reports of the first English trade-mark case are not harmonious, it is probable that the report of Popham is substantially correct. It is as follows: “An action upon

market as his, and to secure such profits as result from a reputation for superior skill, industry or enterprise.” Crawford, J., in *Larabee v. Lewis*, 67 Ga. 562.

“A trade-mark is an arbitrary character or characters without special meaning, adopted by persons, firms or corporations for the purpose of identifying the goods manufactured by them or of which they have the sale.” Marble, Commissioner, in *Ex parte Frieberg*, 20 Off. Gaz. 1164.

“Broadly defined, a trade-mark is a mark by which the wares of the owner are known in trade. Its object is two-fold: First, to protect the party using it from competition with inferior articles; and second, to protect the public from imposition. . . . Anything which can serve to distinguish one man’s productions from those of another may be used. The trade-mark brands the goods as genuine, just as the signature to a letter stamps it as authentic.” Coxe, J., in *Shaw Stocking Co. v. Mack*, 12 Fed. Rep. 707-710.

“A trade-mark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade. Courts of equity have two objects in view in granting injunctions against their imitation: 1. To secure to the individual adopting one the profits of his skill, industry, and enterprise; (2) to protect the public against fraud.” Nixon, J., in *Humphreys’ Specific Med. Co. v. Wenz*, 14 Fed. Rep. 250-252.

“A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these, which will serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth.” Hargis, J., in *Avery v. Meikle*, 81 Ky. 73.

“A trade-mark consists of a word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article.” Wallace, J., in *Hostetter v. Fries*, 17 Fed. Rep. 620-622.

“A trade-mark, as defined by Bouvier, is a sign, writing or ticket put on manufactured goods, to distinguish them from others. It has, by a commentator on trade-marks, been more fully explained as a name, symbol, figure, letter, form, or device, adopted and used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from the goods of another.” Allison, P. J., in *Ferguson v. Davol Mills*, 2 Brewst. 314.

“A trade-mark is some arbitrary or representative device attached to or sold with merchandise and serving to designate the origin or

the case was brought into the common pleas by a clothier that whereas he had gained great reputation for his making of his cloth by reason of which he had great utterance to his great benefit and profit, and that he used to

manufacture of that merchandise." Carpenter, J., in *Davis v. Davis*, 27 Fed. Rep. 490-491.

"What is a trade-mark? A 'mark' means to make a visible sign upon something; to affix a significant mark to; to draw, cut, fasten, brand; a token upon, indicating or intimating something; to affix an indication to; to attach one's name or initials to. A trade-mark, therefore, consists of the use in trade of such a mark, placed upon goods manufactured by a particular person and placed in market with such marks, for sale and trade." Welker, J., in *Adams v. Heisel*, 31 Fed. Rep. 279-280.

"A trade-mark is properly defined by Upton (Upton's Trade-marks, 9) as 'the name, symbol, figure, letter, form or device adopted and used by a manufacturer or merchant, in order to designate the goods that he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise.' The trade-mark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, symbol, word or words, which others have not an equal right to employ for the same purpose." Earl, Commissioner of Appeals, in *Newman v. Alvord*, 51 N. Y. 189-193.

"Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the courts will protect him in its exclusive use." Mr. Justice Field in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51-53.

"*Trade-mark*.—An arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity. The principal purpose of a trade-mark is to guarantee the genuineness of a product. It is, in fact, the commercial substitute for one's autograph. In all ages it has been used to denote origin, and thus protect the purchaser as well as the vendor. All countries protect the integrity of trade-marks, and nearly all civilized nations have treaties or conventions securing

set his mark to his cloth whereby it should be known to be his cloth; and another clothier perceiving it used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie."<sup>1</sup>

§ 4. **The evolution of the law of trade-marks.**—This decision, rendered in 1590, was the first legal recognition of trade-marks. The growth of that recognition was very gradual, however, for as late as 1742 we find Lord Hardwicke saying that he "knew no instance of restraining one trader from making use of the same mark with another,"<sup>2</sup> although the learned chancellor takes judicial cognizance of the wide-spread use of trade-marks, observing that "every particular trader had some particular mark or stamp." And a century later<sup>3</sup> Lord Langdale said: "It does not seem to me that a man can acquire property merely in a name or mark."

reciprocity of protection. The tests of a trade-mark are: 1. Universality; that is, commonly recognized as such. 2. Exclusiveness; in the possession of the owner. 3. Individuality; must indicate origin and ownership. 4. Must be for merchandise. 5. Must be in a lawful business. 6. Must be distinct and invariable." Knight's Mechanical Dictionary, title "Trade-mark," p. 2609.

"Our word 'trade-mark' comprehends both the *marque de fabrique* and *marque de commerce* of France." Townsend, J., in *La Republique Francaise v. Schultz*, 57 Fed. Rep. 37-41.

<sup>1</sup>*Southern (or Southerne) v. How*, 2 Popham, 144; Cro. Jac. 471; 2 Rolle, 28; Cox, 633; Seb. Dig. 1.

<sup>2</sup>*Blanchard v. Hill*, 2 Atk. 484; Cox, 633; Seb. Dig. 2. Mr. Sebastian observes of this decision: "The decision seems in a great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trade-mark and a patent not being clearly present to his lordship's mind." Sebastian, Trade-marks (4th ed.), p. 6.

<sup>3</sup>1842. *Perry v. Truefitt*, 6 Beav. 66; 1 L. T. O. S. 384; Seb. 73; Cox, 644-646. It is now clearly established that the right to a trade-mark is a property right. *Hall v. Barrows*, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; Cox, Manual, Case No. 215. Opinion of Westbury, L. C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 141; Lord Cranworth, in House of Lords, s. c., 11 H. L. C. 533; Lord Kingsdown, in House of Lords, s. c., 11 H. L. C. 544; *Messerole v. Tynberg*, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; *Gilman v. Hunnewell*, 122 Mass. 139; Cox, Manual, Case No. 541; *Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co.*, 95 Fed. Rep. 457-461.

§ 5. **Trade-marks distinguished from patents and copyrights.**—While trade-marks to a degree partake of the nature of both patents and copyrights, and the three have many governing legal principles in common, there are wide differences separating each from the others. As stated by Mr. Justice Miller in *Trade-mark Cases*,<sup>1</sup> “the ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of congress it is sought to establish it by registration, neither originality, invention, discovery, science or art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original*, and are founded in the creative powers of the mind.” And in the House of Lords, in 1882, Lord Blackburn said,<sup>2</sup> “trade-marks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects. And I think, to borrow a phrase used by Lord Ellenborough in *Waring v. Cox*,<sup>3</sup> with reference to a different branch of the law, ‘much confusion has arisen from similitudinary reasoning on the subject.’”

§ 6. **Function.**—The function of a trade-mark is to convey to the purchaser knowledge of the origin, source, ownership\* or manufacture of the article to which it is applied.<sup>4</sup> As will be shown hereinafter, the trade-mark

<sup>1</sup>100 U. S. 82-94. See also *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; *Cox*, 45; *Cox*, Manual, Case No. 84; *Levy v. Waitt*, 21 U. S. App. 394; *Hoyt v. Hoyt*, 143 Pa. St. 623; 24 Am. St. Rep. 575; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624-626.

<sup>2</sup>*Johnston v. Orr Ewing*, 7 App. Cas. 219-228.

<sup>3</sup>1 Camp. 369.

<sup>4</sup>“The function of a trade-mark is to indicate to the public the origin, manufacture or ownership of articles to which it is applied, and

need neither indicate the manufacturer or the place of the article's manufacture, but may indicate either the natural product of the earth, or the handling or selection of the goods, or some labor that has been performed in connection therewith. It serves solely to guide the public to the goods it wants to buy, acting as a perpetual means of identification and advertisement of goods of repute.

**§ 7. Nature of the right to a trade-mark.**—The right to a trade-mark is a right of property,<sup>1</sup> which the state may, in the exercise of its police power, protect by appropriate penal legislation. This right of property is, in the United States, treated as a common-law right, and in no wise dependent upon written law for its inception.<sup>2</sup>

thereby secure to its owner all benefit resulting from his identification by the public with the articles bearing it. No person other than the owner of a trade-mark has a right, without the consent of such owner, to use the same on like articles, because by so doing he would in substance falsely represent to the public that his goods were of the manufacture or selection of the owner of the trade-mark, and thereby would or might deprive the latter of the profit he otherwise might make by the sale of the goods which the purchaser intended to buy. Where a trade-mark is infringed the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and it is on this ground that a court of equity protects trade-marks. It is not necessary that a trade-mark should on its face show the origin, manufacture or ownership of the articles to which it is applied. It is sufficient that by association with such articles in trade it has acquired with the public an understood reference to such origin, etc." *Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-656.

"The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source." *Lurton, J., in Deering Harvester Co. v. Whitman & Barnes Mfg. Co.*, 91 Fed. Rep. 376-380.

<sup>1</sup> *Derringer v. Plate*, 29 Cal. 292; 87 Amer. Dec. 170; *R. Cox*, 324; *Seb.* 249; *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206-212; *Boston Diatite Co. v. Florence Mfg. Co.*, 114 Mass. 69; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537-548; *Liggett & Myer Tobacco Co. v. Hynes*, 20 Fed. Rep. 883; *G. G. White Co. v. Miller*, 50 Fed. Rep. 277-279.

<sup>2</sup> *Trade-mark Cases*, 100 U. S. 82; *Derringer v. Plate*, *supra*; *Moorman v. Hoge*, 2 Sawyer, 78-85; *L. H. Harris Drug Co. v. Stucky*,

Much legislation has taken place tending to aid the common-law remedies and afford more effective redress against trade-mark piracy, but with the solitary exception of California<sup>1</sup> it has nowhere been held in the United States that compliance with a statute is a prerequisite to the acquisition of a trade-mark. The contrary rule obtains in England; registration being necessary to entitle the owner to sue for infringement.<sup>2</sup> A peculiar element of the trade-mark right is that it must be used as an entirety.<sup>3</sup> The owner of a trade-mark cannot convey to others territorial rights to its use,<sup>4</sup> and a partner's interest in the trade-marks owned by the partnership cannot be levied upon by or subjected to the payment of claims of his personal creditors.<sup>5</sup>

**§ 8. Requisites of a valid trade-mark.**—As seen in our definition, a trade-mark must

(a) Be used in lawful commerce;

(b) Be in some way affixed to a subject of lawful commerce;

(c) Be distinctive, identifying the character of the article to which it is so affixed.

As comprehensive and concise a statement of the requisites of a valid trade-mark as can be found in the books is as follows: "The trade-mark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, sym-

46 Fed. Rep. 624-626; *Battle v. Finlay*, 50 Fed. Rep. 106; *Hennessy v. Braunschweiler*, 89 Fed. Rep. 664; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624-627.

<sup>1</sup>*Whittier v. Dietz*, 66 Cal. 78. The evil effect of this decision has since been obviated by the enactment of the present section 3199 of the Political Code of California, which provides that "any person who has first adopted and used a trade-mark or name, whether within or beyond the limits of this state, is its original owner."

<sup>2</sup>The Merchandise Marks Acts, 1887-1894 (50 and 51 Vict., c. 28).

<sup>3</sup>*Manhattan Med. Co. v. Wood*, Fed. Case No. 9026; 4 Cliff. 461.

<sup>4</sup>*Snodgrass v. Wells*, 11 Mo. App. 590. *Per contra*, as to the title of a periodical publication (not a technical trade-mark), see *Estes v. Williams*, 21 Fed. Rep. 189.

<sup>5</sup>*Taylor v. Bemis*, 4 Biss. 406; *Cox*, Manual, 132; Fed. Case No. 13779.

bol, word or words, which others have not an equal right to employ for the same purpose.”<sup>1</sup>

These are fundamental conditions which are never varied, and to which there can be no exception. There are further conditions which we will examine in detail in a subsequent chapter.

**§ 9. Perpetual existence.**—The life of a trade-mark is as long as its continuous use by the owner or his assignees. It is only terminated by abandonment, which we will deal with later. The act of 1881 provides (§ 5) that a certificate of registry shall in the case of articles manufactured in this country remain in force for thirty years from its date, subject to renewal for a like period at any time during the six months prior to the expiration of the term of thirty years; so that all protection and benefit of that act will be lost by failure to renew within the period stated. But congress was careful to provide further (§ 11) that nothing in the act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired.

**§ 10. Territorial limitation.**—Unlike a patent, a trade-mark knows no territorial limitation. The courts of the United States, and those of the several states, are open to the owners of trade-marks of whatever citizenship or nationality who may seek to protect their trade-marks against piracy.<sup>2</sup> The act of congress of 1881 provided for the registration of trade-marks owned by aliens

<sup>1</sup>Earl, Commissioner of Appeals, in *Newman v. Alvord*, 51 N. Y. 189-193.

<sup>2</sup>*State v. Gibbs*, 56 Mo. 133; *Taylor v. Carpenter* (1), 3 Story, 458; *Cox*, 14 Seb. 78; *Coats v. Holbrook*, 2 Sandf. 586; *Cox*, 20; Seb. 79; *Taylor v. Carpenter* (2), 2 Wood. & M. 1; *Cox*, 32; 9 L. T. 514; Seb. 83; *Taylor v. Carpenter* (3), 2 Sandf. 603; 11 Paige, 292; *Cox*, 45; Seb. 84; *Lemoine v. Ganton*, 2 E. D. Smith, 343; *Cox*, 142; Seb. 125; *Derringer v. Plate*, 29 Cal. 292; *Cox*, 324; Seb. 249; *Collins Co. v. Brown*, 3 K. & J. 423; 2 Jur. N. S. 929; 30 L. T. 62; Seb. 151; *Collins Co. v. Cohen*, 3 K. & J. 428; 3 Jur. N. S. 929; 29 L. T. 245; 30 L. T. 62 5 W. R. 676; Seb. 152; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; 4 Jur. N. S. 865; 33 L. T. 101; 6 W. R. 717; Seb. 164; *Collins Co. v. Walker*, 7 W. R. 22; Seb. 171.



“located in any foreign country or tribe, which, by treaty, convention, or law, affords similar privileges to citizens of the United States.”<sup>1</sup> The acquisition of a valid trade-mark in any place carries with it the right to use the mark everywhere.<sup>2</sup> This is subject to the exception that a foreigner doing business in his own country under a trade-mark has no common-law right to that trade-mark in the United States, as against a domestic firm which had established business under a similar trade-mark, adopted in good faith, before the alien had sold any goods in this country.<sup>3</sup>

§ 11. **The necessity of user.**—There can, finally, be no right in or to a trade-mark apart from its use. “The mere sale of a trade-mark apart from the business in which it has been used confers no right of ownership, because no one can claim the right to sell his goods as goods manufactured by another. To permit this to be done would be a fraud upon the public.”<sup>4</sup> To quote from a New York court, “There is no such thing as a trade-mark ‘in gross,’ to use that term by analogy. It must be ‘appendant’ of some particular business in which it is actually used upon, or in regard to, specific articles.”<sup>5</sup> It follows, therefore, that the owner of a trade-mark can-

<sup>1</sup> Act of 1881, sec. 1.

<sup>2</sup> Except that an alien who abandons his trade-mark in this country is not re-vested with the right to use it, by the force of subsequent legislation in his own country. *Saxlehner v. Eisner & Mendelson Co.*, 91 Fed. Rep. 536-539. And one who takes out a foreign patent on the product known by the mark, will lose his trade-mark rights in such foreign country on the expiration of such patent, without impairing his right to the use of the mark in the United States. *Rahtjen Co. v. Holzappel Co.*, 101 Fed. Rep. 257; reversing s. c., 97 Fed. Rep. 949.

<sup>3</sup> *Richter v. Anchor Remedy Co.*, 52 Fed. Rep. 455; affirmed in *Richter v. Reynolds*, 59 Fed. Rep. 577.

<sup>4</sup> *Witthaus v. Braun*, 44 Md. 303; 22 Amer. Rep. 44.

<sup>5</sup> *Weston v. Ketcham* (2), 51 How. Pr. 455; Seb. 487; *Pinto v. Badman*, 8 R. P. C. 181; *Cartmell*, 270; *Dixon Crucible Co. v. Guggenheim*, 7 Phila. 408; 2 Brewst. 321; 3 Am. L. T. 288; Cox, 559; Seb. 331; *Cotton v. Gillard*, 44 L. J. Ch. 90; Seb. 447; *McAndrew v. Bassett*, 4 DeG. J. & S. 380; 33 L. J. Ch. 506; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; 4 N. R. 123; Seb. 234; *Kidd v. Johnston*, 100 U. S. 617; *Weston v. Ketcham* (1), 39 N. Y. 54; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 137; 11 H. L. C. 523. *The Fair v. Jose Morales & Co.*, 82 Ill. App. 499.

not sell territorial rights in a trade-mark to different persons, so as to enable them to make and sell goods as being made by him.<sup>1</sup> "It goes without saying that a trade-mark or trade-name can only be acquired by adoption accompanied with actual use."<sup>2</sup> The inventor of a system of manufacturing garments, who has never engaged in their actual manufacture and sale, has no trade-mark right in a mark to be applied to such garments.<sup>3</sup>

A mere casual use, interrupted, or for a brief period, will not suffice to establish a trade-mark right in the mark;<sup>4</sup> there must be such a user, as to its length and publicity, as will show an intention to adopt the mark as a trade-mark for a specific article.<sup>5</sup>

**§ 12. Trade-marks as subjects of sale, assignment or bequest.**—In the early adjudications the assignability of trade-marks was not clearly established.<sup>6</sup>

<sup>1</sup>*Snodgrass v. Wells*, 11 Mo. App. 590. But in another case the assignment by the English publisher of "Chatterbox" of the right to publish a "Chatterbox" in the United States was sustained. *Estes v. Williams*, 21 Fed. Rep. 189. The name, being that of a periodical publication, was not a technical trade-mark.

<sup>2</sup>*Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co.*, 82 Fed. Rep. 321-325, per Jenkins, J.

<sup>3</sup>*Jaeger's Sanitary W. S. Co. v. Le Boutillier*, 47 Hun, 521. Thus under the English statutes a registrant is not entitled to register a mark for goods in which he does not deal and in which he does not actually intend to deal. *John Batt & Co. v. Dunnett*, L. R. (1899) A. C. 428.

<sup>4</sup>*Menendez v. Holt*, 128 U. S. 514; *Levy v. Waitt* (1), 56 Fed. Rep. 1016; *Levy v. Waitt* (2), 61 Fed. Rep. 1008.

<sup>5</sup>*Kohler Mfg. Co. v. Beeshore*, 59 Fed. Rep. 572-576; *Richter v. Reynolds*, 59 Fed. Rep. 577-579.

<sup>6</sup>*See Corwin v. Daly*, 7 Bos. 222; *Cox*, 265, where the court says, referring to a name used as a trade-mark: "The employer of it can neither give any special right to another, nor abandon it to the community so as forever to take away the right of employing it to designate his wares." In another case it has been held that one can "so sell his name as to deprive himself of the right to use it for his own manufacture, and give the right to another." *Probasco v. Bouyon*, 1 Mo. App. 241. In a later case before the same court, however, the court said: "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public," and concluded that if the public would be led to believe the assignor was still manufacturing the goods, when they were the manufacture of another, the transaction would be a fraud upon the public and the use of the assigned

It can now be said, however, that trade-marks are generally assignable during the life-time of the owner of the mark, and capable of transmission at his death. Indeed, this rule is the necessary and indispensable correlative of the rule that trade-marks have perpetual existence. But there is the necessary qualification that with the trade-mark must go the good-will of the business, the right to select or manufacture the article to which the former owner has been in the habit of affixing the trade-mark in use.<sup>1</sup> Any other course would tend to mislead the public. It is provided by section 70 of the English Patents, Designs and Trade-marks Act of 1883 that "A trade-mark, when registered, shall be assigned and transmitted only in connection with the good-will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with the good-will." No corresponding provision exists in the act of congress of 1881.

Inasmuch as there can be no title in a trade-mark apart from the good-will of the business in which it is used, it follows that, in an assignment of the business and good-will of the owner of the mark, the title to the trade-mark, without being specially mentioned, passes to the

name would not be protected. *Skinner v. Oakes*, 10 Mo. App. 45; *Cox, Manual*, 680. This dictum was quoted with approval in *Oakes v. Tonsmierre*, 4 Woods, 547; *Price & Steuart*, 817.

<sup>1</sup>*Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217; *Massam v. Cattle Food Co.*, L. R. 14 Ch. D. 748; *Ex parte Lawrence*, 44 L. T. N. S. 98; *Seb.* 630; *Re Wellcome*, L. R. 32 Ch. D. 213; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 137; 33 L. J. Ch. 199; *Seb.* 223; *Goodman v. Meriden Britannia Co.*, 50 Conn. 139; *Witthaus v. Braun*, 44 Md. 303; 22 Am. Rep. 44; *Seb.* 492; *Skinner v. Oakes*, 10 Mo. App. 45; *Taylor v. Bemis*, 4 Biss. 406; *McVeagh v. Valencia Cigar Factory*, 32 Off. Gaz. 1124; *Price & Steuart*, 970; *Oakes v. Tonsmierre*, 4 Woods, 547; *Price & Steuart*, 817; *Baldwin v. Von Micheroux*, 25 N. Y. Supp. 857; *Morgan v. Rogers*, 19 Fed. Rep. 596; 12 Off. Gaz. 1113; *Smith v. Imus*, 32 Alb. L. J. 455; *Cotton v. Gillard*, 44 L. J. Ch. 90; *Smith v. Fair*, 14 Ont. Rep. 729; *Burton v. Stratton*, 12 Fed. Rep. 696; *Price & Steuart*, 668; *Pepper v. Labrot*, 8 Fed. Rep. 29; *Chadwick v. Covell*, 151 Mass. 190; *Cox, Manual*, 716; *Cooper v. Hood*, 26 Beav. 293; *Churton v. Douglas*, Johns. 174; *Shipwright v. Clements*, 19 W. R. 599; *Sohier v. Johnson*, 111 Mass. 238.

assignee.<sup>1</sup> It is not so clear, however, that the purchaser acquires the right to use the name of the vendor, this right being affirmed in some cases<sup>2</sup> and negatived in others.<sup>3</sup> It would seem to be the law that a territorial right to use a trade-mark cannot be assigned,<sup>4</sup> though in the case of the name of a periodical publication the contrary rule has been announced.<sup>5</sup>

The fact of a trade-mark containing the name or initials of a former owner of a business will not disentitle an assignee of the business from its use, because the proper name is treated as indicative of the business rather than the present owner of the business.<sup>6</sup> But the

<sup>1</sup>Shipwright v. Clements, 19 W. R. 599; Seb. 350; Congress & Empire Spring Co. v. High Rock Congress Spring Co., 57 Barb. 526; Cox, 599; 45 N. Y. 291; 10 Abb. Pr. N. S. 348; 6 Amer. Rep. 82; 4 Am. L. T. 168; Cox, 624; Seb. 354; Witthaus v. Braun, 44 Md. 303; 22 Amer. Rep. 44; Seb. 492; Morgan v. Rogers, 19 Fed. Rep. 596; 26 Off. Gaz. 1113; Cox, Manual, 692; Merry v. Hoopes, 111 N.Y. 420; Churton v. Douglas, Johns. 174; Fulton v. Sellers, 4 Brewst. 42; Thompson v. Mackinnon, 2 Steph. Dig. 726; Lippincott v. Hubbard, 28 Pitts. L. J. 303; Burkhardt v. Burkhardt Co., 4 Ohio N. P. 358; Listman Mill Co. v. Wm. Listman Mill Co., 88 Wis. 334; Prince Mfg. Co. v. Prince's Metallic Paint Co., 39 N. Y. S. R. 488; Menendez v. Holt, 128 U. S. 514; Hegeman v. Hegeman, 8 Daly, 1; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624.

<sup>2</sup>Banks v. Gibson, 34 Beav. 566; Levy v. Walker, L. R. 10 Ch. D. 463; Webster v. Webster, 3 Swanst. 490; Clark v. Leach, 32 Beav. 14; Bond v. Milbourn, 20 W. R. 197; Tussaud v. Tussaud, 38 W. R. 440; Phelan v. Collender, 13 N. Y. Sup. Ct. 244; Hoff v. Tarrant & Co., 71 Fed. Rep. 163; affirmed in Tarrant & Co. v. Hoff, 76 Fed. Rep. 959; J. G. Mattingly Co. v. Mattingly, 96 Ky. 430.

<sup>3</sup>Scott v. Rowland, 20 W. R. 208; Lewis v. Langdon, 7 Sim. 421; Turner v. Major, 3 Giff. 442; Dence v. Mason, 41 L. T. N. S. 573; Dickson v. McMaster, 18 Ir. Jur. 202; Reeves v. Denicke, 12 Abb. Pr. N. S. 92; Howe v. Searing, 10 Abb. Pr. 264; Cox, 244; Petersen v. Humphrey, 4 Abb. Pr. 394; Cox, 212; Thynne v. Shove, 89 L. T. Jour. 84; Mayer v. Flanagan, 12 Tex. Civ. App. 405; Sherwood v. Andrews, 5 Am. L. Rep. N. S. 588; Seb. 263.

<sup>4</sup>Snodgrass v. Wells, 11 Mo. App. 590.

<sup>5</sup>Estes v. Williams, 21 Fed. Rep. 189.

<sup>6</sup>Pepper v. Labrot, 8 Fed. Rep. 29; LePage Co. v. Russia Cement Co., 51 Fed. Rep. 941; Jennings v. Johnson, 37 Fed. Rep. 364; Frazer v. Frazer Lubricating Co., 121 Ill. 147; McLean v. Fleming, 96 U. S. 245; Symonds v. Jones, 82 Me. 302; 8 L. R. A. 570; Filkins v. Blackman, 13 Blatchf. 440; Weed v. Peterson, 12 Abb. Pr. N. S. 178;

courts of the United States are inclined to insist that the public be notified of the change of ownership, and this is now the safer rule,<sup>1</sup> particularly where the trade-mark is a mark of special qualities, due to superior material, processes, care and skill exercised by the originator thereof, or the mark bearing his name "would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trade-mark should be used by other persons, and for this reason such a trade-mark would be held to be unassignable. . . . But, on the other hand, the usages of trade may be such that no such inference would naturally be drawn from the use of a trade-mark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trade-mark are of a certain standard, kind or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is on the trade-mark."<sup>2</sup> In the sale of a business, then, the general rule is that the trade-marks connected with the business will pass to the purchaser without being specified in the bill of sale,<sup>3</sup> and in case of a general assignment

*Young v. Jones*, 3 Hughes, 274; *Fulton v. Sellers*, 4 Brewst. 42; *Weston v. Ketcham* (1), 39 N. Y. 54; *Clark v. Ins. Co.*, 7 Mo. App. 71; *Frank v. Sleeper*, 150 Mass. 583; *Hoxie v. Chaney*, 143 Mass. 592; *Russia Cement Co. v. LePage*, 147 Mass. 206; *Brown Chemical Co. v. Meyer*, 139 U. S. 540. The fact that a trade-mark includes the name and portrait of the first owner does not render it unassignable to another. *Richmond Nervine Co. v. Richmond*, 159 U. S. 293-302.

<sup>1</sup>*Manhattan Med. Co. v. Wood*, 108 U. S. 218; *Horton Mfg. Co. v. Horton Mfg. Co.*, 18 Fed. Rep. 816; *Alaska Packers' Ass'n v. Alaska Imp. Co.*, 60 Fed. Rep. 103; *Siegert v. Abbott* (1), 61 Md. 276; *Sherwood v. Andrews*, 5 Am. L. Reg. N. S. 588; Seb. 263; *Carmichael v. Latimer*, 11 R. I. 395; Seb. 521; *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841; 12 C. C. A. 432; *People v. Molins*, 10 N. Y. Supp. 130.

<sup>2</sup>*Charles Allen, J., in Hoxie v. Chaney*, 143 Mass. 592.

<sup>3</sup>*Shipwright v. Clements*, 19 W. R. 599; *Wilmer v. Thomas*, 74 Md. 485; 13 L. R. A. 380; *Solis Cigar Co. v. Pozo*, 16 Colo. 388; 25 Am. St. Rep. 279.

or bankruptcy the trade-marks also pass, to inure to the benefit of the creditors.<sup>1</sup> The exception to each of these rules arises where the trade-mark depends upon the secret processes or individual skill of its owner for its value.<sup>2</sup>

Trade-marks may, in connection with the good-will of the business wherewith they are connected, be transmitted by bequest.<sup>3</sup> This naturally leads to the result that several persons may by bequest (as they may upon dissolution of copartnership) become possessed of the right to use the same trade-mark. As where a decedent, a watchmaker using "Dent, London" as his trade-mark on watches which he manufactured at three several shops in London, bequeathed the business of two of these shops to one person and the third shop to another. It appears to have been held here that each legatee had a several right to the use of the trade-mark.<sup>4</sup> While this decision has been unfavorably criticised, an analogous ruling has been made by Judge Hughes in the United States Circuit Court for the Eastern District of Virginia. He said, "Rights in trade-mark are analogous to rights in the good-will of a partnership. In the absence of express stipulation at the time of dissolution, each partner may go on and use the trade-mark of the firm."<sup>5</sup> It is

<sup>1</sup>Hegeman v. Hegeman, 8 Daly, 1; Rogers v. Taintor, 97 Mass. 291; Warren v. Warren Thread Co., 134 Mass. 247; Hudson v. Osborne, 39 L. J. Ch. 79; Cotton v. Gillard, 44 L. J. Ch. 90; Ex parte Foss, 2 DeG. & J. 230; Bury v. Bedford, 4 DeG. J. & S. 352; Ex parte Young, Seb. 537; Longman v. Tripp, 2 Bos. & P. N. R. 67; Hammond v. Brunker, 9 R. P. C. 301; Cartmell, 142; Lippincott v. Hubbard, 28 Pitts. L. J. 303; Burkhardt v. Buckhardt Co., 4 Ohio N. P. 358; Batchellor v. Thomas, 86 Fed. Rep. 630; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624-626.

<sup>2</sup>Re Swezey, 62 How. Pr. 215.

<sup>3</sup>McLean v. Fleming, 96 U. S. 245.

<sup>4</sup>Dent v. Turpin, 2 J. & H. 139; 30 L. J. Ch. 495; 7 Jur. N. S. 673; 4 L. T. N. S. 673; 9 W. R. 548. Mr. Cox observes, "This case is to be taken as of an exceptional character; it is not in accord with settled principles." Cox, Manual, 196.

<sup>5</sup>Young v. Jones, 3 Hughes, 274; Price & Steuart, 150. And to the same effect, see Banks v. Gibson, 34 Beav. 566; 34 L. J. Ch. 591; 6 N. R. 373; 13 W. R. 1012; 11 Jur. N. S. 680; Seb. 248; Condry v. Mitchell, 37 L. T. N. S. 268; 37 L. T. N. S. 766; 26 W. R. 269; Seb. 561; Wright v.

clear, however, that where a mark is a common design for the purpose of a common adventure used by several independent dealers or manufacturers in a joint enterprise, a mark belonging to neither individually, but representing the enterprise of all concerned, for the purposes of their joint adventure, the trade-mark can be used only so long as all the parties remain interested in the enterprise; when it terminates, the function and life of the trade-mark also terminate.<sup>1</sup> If the business and good-will of a partnership are sold upon dissolution the trade-mark goes with the other assets.<sup>2</sup> Another question is presented where one partner retires from the firm. If the retiring partner re-engages in business and continues to use the trade-mark, it has been held that that fact, even if the mark is applied by him to a spurious article, is evidence of his intention to retain his interest in the trade-mark.<sup>3</sup> If upon dissolution one partner takes the whole business by agreement, the valuation of the retiring partner's interest must include

Simpson, 15 Off. Gaz. 968; Price & Steuart, 165. In this connection Mr. Justice Bradley said: "In holding that it is necessary to the validity of a trade-mark that the claimant of it must be entitled to an exclusive right to it, or property in it, we do not mean to say that it may not belong to more than one person, to be enjoyed jointly or severally. Copartners, upon a dissolution of partnership, may stipulate that each of them may use the trade-marks of the firm, and there may be many other cases of joint and several ownership; but such co-owners will together be entitled to the exclusive use of the trade-mark, and perhaps each of them will be entitled to such exclusive use as to all other persons except their associates in ownership." *New York Cement Co. v. Coplay Cement Co.*, 45 Fed. Rep. 212.

<sup>1</sup>Re Jones, 53 L. T. 1; Cartmell, 189; Robinson v. Finlay, and Ward v. Robinson, L. R. 9 Ch. D. 487; 39 L. T. 398; 27 W. R. 294; Cartmell, 295. These cases arose between merchants in Manchester and corresponding houses in Manilla and Rangoon. The trade-marks were composite marks, containing crests, names of the individuals written in Chinese characters, coats of arms, and other personal *indicia* of the parties interested.

<sup>2</sup>*Armistead v. Blackwell*, 1 Off. Gaz. 603; Seb. 399; *Rogers v. Taintor*, 97 Mass. 291; Seb. 283; *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54; Seb. 173; *Banks v. Gibson*, 34 Beav. 566; 11 Jur. N. S. 680, 34 L. J. Ch. 591; 13 W. R. 1012; 6 N. R. 273.

<sup>3</sup>*Wright v. Simpson*, 15 Off. Gaz. 968; Price & Steuart, 165.

his interest in the trade-marks of the partnership, which pass with the good-will.<sup>1</sup>

Trade-marks upon the death of their owner pass with his other personalty to his personal representatives.<sup>2</sup> There should, of course, be a conveyance of the decedent's title by administration; and where, as in *Hovenden v. Lloyd*, there is no administration, and a relation simply continues business and uses the trade-mark, he probably acquires no title to the trade-mark thereby. At all events, in that case, where the deceased's son so used the trade-mark and subsequently sold his business with its good-will to a third party, it was held that the son had acquired no title capable of being transferred to such third party.<sup>3</sup> The supreme court of Pennsylvania, however, has distinctly held that where a man's sons continued to use his trade-mark after his death (there having been no evidence of administration upon his estate) and subsequently separated, each continuing in business and using the trade-mark, they were entitled to an injunction against a stranger imitating that trade-mark, upon a bill in equity in which they joined as complainants. The subject is not as fully discussed by the court as it should have been. The language of Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*<sup>4</sup> is quoted in the opinion, as follows: "Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark, and they would be protected against any

<sup>1</sup>*Banks v. Gibson*, 34 Beav. 566; 11 Jur. N. S. 680; 34 L. J. Ch. 591; 13 W. R. 1012; 6 N. R. 373; Seb. 248; *Gage v. Canada Pub. Co.*, 11 Can. S. C. R. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

<sup>2</sup>*Croft v. Day*, 7 Beav. 84; *Re Farina*, 44 L. T. N. S. 99; *Giblett v. Read*, 9 Mod. 459.

<sup>3</sup>*Hovenden v. Lloyd*, 18 W. R. 1132; Seb. 337. There was substantially the same state of facts and the same holding in *Singleton v. Bolton*, 3 Doug. 293; *Cox*, 634; Seb. 4.

<sup>4</sup>11 H. L. C. 523.



infringement of the exclusive right to that name. They would be so protected, because according to the usage of trade they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him." In the course of its opinion the Pennsylvania court observes: "It was urged, however, that conceding this symbol to have been a valid trade-mark in the hands of Jesse Darlington (grandfather of complainants), or even of Jared (his son), that upon the death of the latter it ceased to be the property of any one, and that its use by several members of the family of the latter destroyed its distinctive features and left it open to the public to appropriate it. We cannot assent to this proposition."<sup>1</sup> It might be suggested that in cases of this character (*i. e.*, where no administration is had upon the estate of a deceased owner of a trade-mark) its use by relatives in a similar business is practically an adoption *de novo* of the mark, left open to the world for appropriation by its owner's death.

Where the owner of a trade-mark takes partners into the business in which it is employed, the title to the trade-mark ordinarily is merged into the partnership assets.<sup>2</sup> The supreme court of the United States has apparently held to the contrary,<sup>3</sup> but the facts were that the owner of the mark owned the premises in which the

<sup>1</sup>Paxon, J., in Pratt's Appeal, 117 Pa. St. 401-412. "The reason why a trade-mark may pass 'without administration,' as suggested by Paxon, J., in Pratt's Appeal, 117 Pa. St. 401, seems to be that a trade-mark can have no value except in connection with the business to which it attaches; and as creditors are not usually in condition to realize the value of the trade-mark, either by carrying on the business themselves or by selling to one who will, its chief element as an asset is wanting. But it seems, also, that cases may arise in which the trade-mark of a deceased testator or intestate is of value to creditors, or a subject of contention among heirs, when administration may become necessary." Woerner, Administration, 635, note 8.

<sup>2</sup>Weston v. Ketcham (2), 51 How. Pr. 455; Filkins v. Blackman, 13 Blatchf. 440-446; Sohler v. Johnson, 111 Mass. 238-242; Bury v. Bedford, 4 DeG. J. & S. 352-371; Condry v. Mitchell, 37 L. T. N. S. 268.

<sup>3</sup>Kidd v. Johnson, 100 U. S. 617-619.

business was conducted, and took two of his clerks into partnership. He did not convey the realty to the firm, and upon dissolution there was correspondence between him and the withdrawing partners which, in the language of Mr. Justice Field, "discloses beyond question their knowledge of the transfer and recognition of his power to make it;" referring to his subsequent sale of his business and his trade-mark to another. It would seem from this decision, then, that the partner who originally owns the mark may by agreement permit the use of the trade-mark by the firm during its existence, reserving the title to the trade-mark to himself in the event of dissolution.

The federal supreme court has also held that when a partner retires from a firm, assenting to or acquiescing in the retention by the other partners of the old place of business and the future conduct of the business by them under the old name, the good-will (including the title to the firm's trade-marks) remains with the latter as a matter of course.<sup>1</sup>

It is important to note, in considering the assignability of trade-marks, the doctrine first announced by Judge Shipman, that "The right to use a trade-mark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached."<sup>2</sup> And where the trade-mark involved the use of the assignor's name, it was said: "Where an individual parts with a right to the use of his own name in any given connection, the courts should not extend the contract by which he does so beyond its necessary scope. It certainly will not be held that a man has tied himself up so as to prevent the use of his own name any further than the clear terms of the agreement show his intention to do so."<sup>3</sup>

<sup>1</sup>Menendez v. Holt, 128 U. S. 514-522.

<sup>2</sup>Filkins v. Blackman, 13 Blatchf. 440-444. This rule is again laid down in *Chattanooga Medicine Co. v. Thedford* (1), 49 Fed. Rep. 949-952; *Chattanooga Medicine Co. v. Thedford* (2), 58 Fed. Rep. 347.

<sup>3</sup>Newman, J., in *Chattanooga Medicine Co. v. Thedford* (2), 58 Fed. Rep. 347-349.

One who has assigned either his trade-mark<sup>1</sup> or trade-name<sup>2</sup> will be enjoined from again using the mark or name itself; if he makes such an assignment to a corporation with a reversion to him if the corporation ceases to exist, he cannot make a valid assignment of the mark to another during the life of the corporation.<sup>3</sup>

The assignee of a trade-mark does not, merely by virtue of the assignment, obtain a right to enjoin infringers of the mark. He must show that he has actually applied it, commercially, to goods of the class for which it is claimed as a trade-mark.<sup>4</sup>

While, as we have seen, a trade-mark is assignable only in connection with the good-will of the business in which it is used, it does not follow that both must be conveyed by the same instrument or at the same time; and under the English Patents, Trade-marks and Copyright Act of 1883 it has been held that the registration of an assignment of a trade-mark need not be contemporaneous with the assignment of the good-will.<sup>5</sup> It is possible that the originator of a manufacturing business and the person who purchases that business may each thereafter have a right to the limited use of the trade-name and trade-mark used in connection with that business.<sup>6</sup> Where such a state of facts arises, either the vendor or purchaser can assign his right to the use of the trade-name and trade-mark, and either will be enjoined upon the application of the other from using the words "only genuine" in connection with the name and mark.<sup>7</sup>

<sup>1</sup>Bury v. Bedford, 4 DeG. J. & S. 352; Burkhardt v. Burkhardt Co., 4 Ohio N. P. 358.

<sup>2</sup>Churton v. Douglas, Johnson (Eng.), 174.

<sup>3</sup>Petrolia Mfg. Co. v. Bell & Bogart Soap Co., 97 Fed. Rep. 781-784.

<sup>4</sup>Walton v. Crowley, 3 Blatchf. 440-448; Filkins v. Blackman, 13 Blatchf. 440-445.

<sup>5</sup>Re Wellcome, L. R. 32 Ch. D. 213; 3 R. P. C. 76; 55 L. J. Ch. 542; 54 L. T. 493; 34 W. R. 453; Cartmell, 342.

<sup>6</sup>Fish Bros. Wagon Co. v. La Belle Wagon Works, 82 Wis. 546; Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 87 Fed. Rep. 201; affirmed, 95 Fed. Rep. 457.

<sup>7</sup>Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 87 Fed. Rep. 203.

In a case where a trade-mark was used by a manufacturer in England and also by a firm in the United States in which he was a partner, the use of the trade-mark having begun in both places about the same time, and it having become a distinctive mark, identifying the article manufactured in the United States, the English manufacturer retired from the American house. Upon his subsequently attempting to use it in a separate business of the same kind in this country, it was held that his successors in the old firm had, upon his retirement, succeeded to the exclusive right to use the trade-mark, as part of the business, and he was enjoined from using the mark in his new establishment in the United States.<sup>1</sup> This case is but a practical application of the doctrines we have just considered, to an unusual state of facts.

Whenever the alien owner of a trade-mark has abandoned its use in the United States by neglecting to assert his rights as against infringers in this country, the public has a right to use that mark, of which it will not be divested by the operation of a law subsequently enacted by the country of which the former owner is a citizen.<sup>2</sup> A trade-mark applied to mineral paint produced from a deposit on a particular piece of land will pass to a purchaser of the land as an incident to the realty,<sup>3</sup> as will a trade-mark applied to the water of a particular spring,<sup>4</sup> or the right to use words designating a particular building rather than the business conducted therein,<sup>5</sup> or the right to use a mark which has come to designate the product of a mill or factory rather than of the proprietor.<sup>6</sup>

In a case where the plaintiff had assigned the right to use his trade-mark to the defendant for a term of years, for a share of the profits of defendant's business, and

<sup>1</sup> Batchellor v. Thompson, 86 Fed. Rep. 630.

<sup>2</sup> Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536.

<sup>3</sup> Prince Mfg. Co. v. Prince's Metallic Paint Co., 15 N. Y. Supp. 249; Cox, Manual, 721.

<sup>4</sup> Hill v. Lockwood, 32 Fed. Rep. 389.

<sup>5</sup> Armstrong v. Kleinhaus, 82 Ky. 303.

<sup>6</sup> Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217.

during the term re-engaged in the use of the mark, in an action by the plaintiff upon the contract it was held that the plaintiff could recover the profits due him under the contract, and the defendant was allowed damages for the breach of the contract. The validity of the assignment appears not to have been questioned.<sup>1</sup>

§ 13. **Unfair competition.**—In 1877, the American writer, Mr. Charles E. Coddington, in his excellent digest of trade-mark cases, remarked that “The interference of courts of equity, instead of being founded upon the theory of protection to the owner of trade-marks, is now supported mainly to prevent frauds upon the public.”<sup>2</sup> If the use of any words, numerals or symbols is adopted for the purpose of defrauding the public, the courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the court may not have the exclusive right to the use of these words, numerals or symbols.”<sup>3</sup> He added that this rule was fully supported by four cases, two English and two American, which he cited.<sup>4</sup> Since that time, the recognition of the doctrine so expressed has grown steadily and certainly, so that it now demands treatment as a specific branch of the law, separate, apart from, but including the narrower and strictly technical law of trade-marks.<sup>5</sup> “The tendency of the courts at the pres-

<sup>1</sup>Coe v. Bradley, 9 Off. Gaz. 541.

<sup>2</sup>The writer erred in ascribing this as the only reason. The prevention of fraud upon the person whose goods are pirated is equally important and cogent. *Humphrey's Specific Med. Co. v. Wenz*, 14 Fed. Rep. 250; *Skinner v. Oakes*, 10 Mo. App. 45.

<sup>3</sup>Coddington, Digest, sec. 36.

<sup>4</sup>1869. *Lee v. Haley*, 21 L. T. N. S. 546; 18 W. R. 181; L. R. 5 Ch. 155; 39 L. J. Ch. 284; 22 L. T. N. S. 251; 18 W. R. 242; Seb. 325.

1872. *Wotherspoon v. Currie*, 22 L. T. N. S. 260; 18 W. R. 562; 42 L. J. Ch. 130; 23 L. T. N. S. 443; 18 W. R. 942; L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. N. S. 393; Seb. 329.

1872. *Newman v. Alvord*, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; 51 N. Y. 189; 10 Am. Rep. 588; Seb. 282.

1877. *Kinney v. Basch*, Seb. 542.

<sup>5</sup>“The law of unfair competition is well settled. It is only the application of that law to individual cases which requires discussion.” *Lacombe, J., in Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889-891.

ent time seems to be to restrict the scope of the law applicable to technical trade-marks, and to extend its scope in cases of unfair competition."<sup>1</sup>

§ 14. **Historical.**—In 1742, in *Blanchard v. Hill*, a decision of no authority and of no particular use except to illustrate the slow growth of the law of trade-marks, Lord Hardwicke observed, referring to *Southern v. How*:<sup>2</sup> "It was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away business from the other clothier."<sup>3</sup> The chancellor so crudely expressed (but disapprovingly) the first reported judicial reference to the law of unfair competition. In 1896, Lord Chancellor Halsbury, addressing the House of Lords, said: "For myself, I believe the principle of the law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else."<sup>4</sup> This sentence is a terse statement of the fundamental maxim of unfair competition. The English courts have long recognized the rule, and it may be found repeated in various phraseology by all the English courts within whose jurisdiction trade-mark and analogous cases have come.

It is more difficult to trace the growth of this doctrine in the American decisions. Chancellor Sandford in 1825, in an action concerning the right to the name of a periodical, observed, "The injury for which redress is given . . . results from the imposture practiced upon the customers of an existing establishment, or upon the public,"<sup>5</sup> so recognizing the rule which Mr. Coddington failed to recognize.

Twelve years later, in Massachusetts, it was said that "Imposition, falsehood and fraud, on the part of the de-

<sup>1</sup>Baker, J., in *Church & Dwight Co. v. Russ*, 99 Fed. Rep. 276-278.

<sup>2</sup>*Southern v. How*, Popham, 144; Cro. Jac. 471; 2 Rolle, 28; Seb. 1.

<sup>3</sup>*Blanchard v. Hill*, 2 Atk. 484; Seb. 2.

<sup>4</sup>*Reddaway v. Banham*, L. R. (1896) Appeal Cases, 199-204.

<sup>5</sup>*Snowden v. Noah*, Hopkins' Ch. R. 347; Cox, 1; Seb. 41.

fendant, in passing off his own medicines as those of the plaintiff, would be a ground of action.”<sup>1</sup>

In 1840 Chancellor Walworth was presented with an application for an injunction to restrain the use of the words “New Era” as the name of a newspaper, the complainant being the proprietor of a rival periodical denominated “Democratic Republican New Era.” He denied the application, and in the course of his opinion said: “The allegation in the complainant’s bill of complaint is that the defendant has assumed the name of the complainant’s newspaper for the fraudulent purpose of imposing upon the public, and supplanting him in the good-will of his established paper, by simulating the name and dress thereof; with the intent to cause it to be understood, and believed by the community, that the defendant’s newspaper was the same as the complainant’s, and thereby to injure the circulation of the latter. If this were in fact so, I should have no difficulty in making this order absolute. For although the business of publishing newspapers ought, in a free country, to be always open to the most unlimited competition, fraud and deception certainly are not essential to the most perfect freedom of the press. . . . As the names of party newspapers, in these days, have no necessary connection with the principles which they advocate, and are manufactured as readily as the new names if not the new principles of political parties, there could be very little excuse for the editor of a newspaper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons.”<sup>2</sup>

Not until 1888 did the United States supreme court give distinct recognition to the law of unfair competition,<sup>3</sup> and three years later Mr. Chief Justice Fuller an-

<sup>1</sup>Thomson v. Winchester, 19 Pick. 214; Seb. 59.

<sup>2</sup>Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

<sup>3</sup>Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 123 U. S. 598; Cox, Manual, 705. In this case Mr. Justice Field said (123 U. S. at p. 604), “The case at bar cannot be sustained as one to restrain unfair trade. Relief in such cases is granted only where the defend-

nounced the doctrine clearly and unequivocally, in these terms: "The jurisdiction to restrain the use of a trade-mark rests upon the grounds of the plaintiff's property in it, and of the defendant's unlawful use thereof. If the absolute right belonged to plaintiff, then, if an infringement were clearly shown, the fraudulent intent would be inferred, and, if allowed to be rebutted in exemption of damages, the further violation of the right of property would nevertheless be restrained. It seems, however, to be contended that plaintiff was entitled at least to an injunction, upon the principles applicable to cases analogous to trade-marks; that is to say, on the ground of fraud on the public and on the plaintiff, perpetrated by defendant by intentionally and fraudulently selling its goods as those of the plaintiff. Undoubtedly an unfair and fraudulent competition against the business of the plaintiff—conduct with the intent, on the part of the defendant, to avail itself of the reputation of the plaintiff to palm off its goods as plaintiff's—would, in a proper case, constitute ground for relief."<sup>1</sup>

With this decision the doctrine of unfair competition may be regarded as being finally established in the United States; and as based not only on fraud on the public, but on the plaintiff.<sup>2</sup>

ant, by his mark, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacturer, to the injury of the plaintiff." Citing *McLean v. Fleming*, 96 U. S. 245; *Sawyer v. Horn*, 4 Hughes, 239; *Perry v. Truefit*, 6 Beavan, 66; *Croft v. Day*, 7 Beavan, 84.

Indeed, *McLean v. Fleming* may be properly regarded as the first case in which the federal supreme court made any mention of the doctrine. This sentence occurs in the opinion: "Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant." *McLean v. Fleming*, 96 U. S. 245.

<sup>1</sup> *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537; *Cox, Manual*, 720.

<sup>2</sup> "The law relating to this subject is well understood. No man has a right to use names, symbols, signs or marks which are intended, or calculated, to represent that his business is that of an-



§ 15. **Unfair competition distinguished from trademark infringement.**—It can hardly be doubted that at its inception the doctrine of unfair competition was devised to protect the public, rather than to recognize any vested right in the complainant. He had adopted a geo-

other. No man should in this way be permitted to appropriate the fruits of another's industry, or impose his goods upon the public by inducing it to believe that they are the goods of some one else. If A presents his goods in such a way that a customer who is acquainted with the goods of B and intends to purchase them is induced to take the goods of A instead, believing them to be the goods of B, A is guilty of a fraud which deceives the public and injures his competitor. Where the goods of a manufacturer have become popular not only because of their intrinsic worth, but also by reason of the ingenious, attractive and persistent manner in which they have been advertised, the good-will thus created is entitled to protection. The money invested in advertising is as much a part of the business as if invested in buildings, or machinery, and a rival in business has no more right to use the one than the other,—no more right to use the machinery by which the goods are placed on the market than the machinery which originally created them. No one should be permitted to step in at the eleventh hour and appropriate advantages resulting from years of toil on the part of another."

"The action is based upon deception, unfairness and fraud, and when these are established the court should not hesitate to act. Fraud should be clearly proved; it should not be inferred from remote and trivial similarities. Judicial paternalism should be avoided; there should be no officious meddling by the court with the petty details of trade; but, on the other hand, its process should be promptly used to prevent an honest business from being destroyed or invaded by dishonest means." Coxe, J., in *Hilson Co. v. Foster*, 80 Fed. Rep. 896-897.

"The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader; and he cannot, therefore (in the language of Lord Langdale in the case of *Perry v. Truefit*, 6 Beavan, 66-73), 'be allowed to use names, marks, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.' " Lord Kingsdown in *Leather Cloth Co. (Ltd.) v. American Leather Cloth Co. (Ltd.)*, 11 H. L. C. 358; followed in *Johnston v. Orr-Ewing*, 7 App. Cas. 219-229.

"The gradual but progressive judicial development of the doctrine of unfair competition in trade has shed lustre on that branch of our jurisprudence as an embodiment, to a marked degree, of the principles of high business morality, involving the nicest discrimination between those things which may, and those which may not, be done

graphical name, a generic term, or words otherwise *publici juris*, to designate his wares. Perhaps he had no device, symbol or mark whatsoever, but relied upon the shape, form or color of his packages. He had, at all events, none of those methods of distinguishing his goods from those of other merchants which the law recognizes as a right of property and denominates "trade-mark." Yet his goods had a fixed quality and were sought for by the public. When his competitor endeavored to palm off other goods as his upon the public, the chancellor would say as Lord Langdale said: "My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact

in the course of honorable rivalry in business. This doctrine rests on the broad proposition that equity will not permit any one to palm off his goods on the public as those of another. The law of trade-marks is only one branch of the doctrine. But while the law of trade-marks is but part of the law of unfair competition in trade, yet when the two are viewed in contradistinction to each other an essential difference is to be observed. The infringement of trade-marks is the violation by one person of an exclusive right of another person to the use of a word, mark or symbol. Unfair competition in trade, as distinguished from infringement of trade-marks, does not involve the violation of any exclusive right to the use of a word, mark or symbol. The word may be purely generic or descriptive, and the mark or symbol indicative only of style, size, shape or quality, and as such open to public use 'like the adjectives of the language,' yet there may be unfair competition in trade by an improper use of such word, mark or symbol. Two rivals in business competing with each other in the same line of goods may have an equal right to use the same words, marks or symbols on similar articles produced or sold by them respectively, yet if such words, marks or symbols were used by one of them before the other and by association have come to indicate to the public that the goods to which they are applied are of the production of the former, the latter will not be permitted, with intent to mislead the public, to use such words, marks or symbols in such a manner, by trade dress or otherwise, as to deceive or be capable of deceiving the public as to the origin, manufacture or ownership of the articles to which they are applied; and the latter may be required, when using such words, marks or symbols, to place on articles of his own production or the packages in which they are usually sold something clearly denoting the origin, manufacture or ownership of such articles, or negating any idea that they were produced or sold by the former." Bradford, J., in *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-659.

of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not in fair and honest dealing entitled."<sup>1</sup>

The true theory of unfair competition has not always been as clearly stated by the courts as it should be. One line of decisions bases this doctrine and the right to injunctive relief upon the protection of the public from fraud. On the other hand, Judge Thayer has stated that relief is granted "To restrain the defendants from perpetrating a fraud which injures the complainant's business, and occasions him a pecuniary loss."<sup>2</sup>

It is very clear that equity intervenes in the protection from fraud of both the complainant whose business is or may be injured by the unfair and fraudulent competition, and the public who are the consumers of his merchandise.<sup>3</sup>

In a sense it is not exact to separate the doctrines of trade-mark infringement and unfair competition.<sup>4</sup> The underlying doctrine is the same—the control of fraud, great or petty, by the intervention of equity; and yet, without a clear understanding of the doctrines of unfair competition, it is impossible to read intelligently the trade-name cases which have so long been treated either as being "trade-mark" cases, or cases "analogous to" trade-mark cases. We have discussed elsewhere the use of proper names as trade-marks, and from an examination of the cases the careful student will conclude that proper names are not trade-marks, and that there should not be such a thing as a technical trade-name. A name which is not a trade-mark is not entitled to protection as a trade-mark. It is only entitled to protection when it

<sup>1</sup>Croft v. Day, 7 Beav. 84; Seb. 76.

<sup>2</sup>Carson v. Ury, 39 Fed. Rep. 777; Cox, Manual, 709; following Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; Cox, Manual, 705. And to the same effect see Pierce v. Guittard, 68 Cal. 68-71.

<sup>3</sup>Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537.

<sup>4</sup>See note to Scheuer v. Muller, 20 C. C. A. 165.

is fraudulently used by another. Thus, in the case of "Dent, London,"<sup>1</sup> which we have before referred to, Dent is a proper name and London a geographical word. They are entitled to protection against fraudulent use, but only for the same reasons and in the same sense that the size, shape, color and design of labels or packages are entitled to protection against such fraudulent use. This is true of many cases which have been decided by the courts as trade-mark cases.

The fact is that there has always existed the willingness of equity to keep the zeal of competing traders within the bounds of fairness.<sup>2</sup> In the very early case of *Singleton v. Bolton*, where both parties made and sold a compound which they styled "Dr. Johnson's Yellow Ointment," Lord Mansfield said: "If the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie. But here both the plaintiff and defendant use the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff."<sup>3</sup> So that even at the early date of the rendition of that opinion (1783) the remedy for unfair competition would have been applied upon a proper state of facts; *i. e.*, if the defendant had sold his goods as the goods of the plaintiff.

In 1810 Lord Eldon said: "There can be no doubt that this court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same place, under the same sign or name, the party giving himself out as the same person."<sup>4</sup> It was

<sup>1</sup>Dent v. Turpin, 30 L. J. Ch. 495; Seb. 196; *Ante*, p. 16.

<sup>2</sup>This branch of the law is a most interesting illustration of the unlimited adaptability of equity to cope with fraud in every form. Judge Townsend has accurately observed that "A court of equity keeps pace with the rapid strides of the sharp competitors for the prize of public favor, and insists that it shall be won only by fair trade." *R. Heinisch's Sons Co. v. Boker*, 86 Fed. Rep. 765-768.

<sup>3</sup>*Singleton v. Bolton*, 3 Doug. 293; Cox, 624; Seb. 4.

<sup>4</sup>*Crutwell v. Lye*, 17 Ves. 335; 1 Rose, 123; Seb. 17.

by analogous reasoning that the same learned judge, six years later, enjoined the piracy of Lord Byron's name, applied to poems not of his composition.<sup>1</sup>

In 1836 Lord Langdale enjoined a defendant from using omnibuses painted like the plaintiff's, and driven and managed by servants dressed in livery like that of the plaintiff's servants.<sup>2</sup>

So that the doctrine was old when Mr. Justice Clifford said from the bench of the federal supreme court, "Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the court is satisfied that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant."<sup>3</sup>

The whole question of fairness in trade is peculiarly within the province of equitable jurisdiction; trade-mark infringement is but one form of unfair competition. Unfair competition is the equivalent term for the "passing off" of the English<sup>4</sup> and the "concurrence deloyale" of the French decisions.<sup>5</sup>

It must be borne in mind, however, that there is this practical distinction between the issues in cases of technical trade-mark infringement and cases of unfair competition where no technical trade-mark is involved: the court is to be guided to its conclusions not by reference to any arbitrary, fanciful and distinctive device to which the plaintiff has a property right. But it is for him to determine, in the light of all the facts, whether or not an unfair competition has been instituted by the respondent. Judge Kirkpatrick, in referring to this question, has said: "Recognizing the principle, I am of the opinion that the similarity (of the competing articles) which will warrant the interference of the court must be determined by the

<sup>1</sup>Lord Byron v. Johnston, 2 Mer. 29; Seb. 23.

<sup>2</sup>Knott v. Morgan, 2 Keen. 213; Seb. 57.

<sup>3</sup>McLean v. Fleming, 96 U. S. 245.

<sup>4</sup>Lever Bros. (Ltd.) v. Bedingfield, 80 L. T. 100.

<sup>5</sup>Pouillet, *Marques de Fabrique et de la Concurrence Deloyale* (4th ed.), secs. 459 *et seq.*

circumstance of each case."<sup>1</sup> While fraud is presumed from the wrongful use of a trade-mark it must be proven, directly or by inference, in all cases of unfair competition which do not involve a technical trade-mark.<sup>2</sup>

This rule is exemplified by reference to the cases cited in the foot-note, where such comparisons have been made by the courts, resulting in a finding that the competition of the respondent was fair,<sup>3</sup> and others where the facts have led the court to the contrary conclusion.<sup>4</sup>

With the exception of this feature, the same general rules of law and procedure prevail in this class of cases as obtain in proceedings to restrain trade-mark infringement. Thus, an injunction to restrain an unfair competition has been expressly denied upon the ground that the complainant was guilty of laches and acquiescence.<sup>5</sup>

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts cannot entertain such an action arising between citizens of the same state except in so far as the respondent's wrongful act affects commerce with foreign nations or the Indian tribes.<sup>6</sup>

<sup>1</sup>Kroppf v. Furst, 94 Fed. Rep. 150.

<sup>2</sup>Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-279. "The deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances." Mr. Chief Justice Fuller, in Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-551.

<sup>3</sup>Kroppf v. Furst, 94 Fed. Rep. 150; Putnam Nail Co. v. Ausable Horsenail Co., 53 Fed. Rep. 390; Sterling Remedy Co. v. Eureka Mfg. Co., 70 Fed. Rep. 704; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 88 Fed. Rep. 694; Klotz v. Hecht, 73 Fed. Rep. 822; Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; C. F. Simmons Med. Co. v. Simmons, 81 Fed. Rep. 162; La Republique Francaise v. Schultz, 94 Fed. Rep. 500; Vitascope Co. v. United States Phonograph Co., 83 Fed. Rep. 30; Brown v. Doscher, 147 N. Y. 647; Mumm v. Kirk, 40 Fed. Rep. 589.

<sup>4</sup>Draper v. Skerrett, 94 Fed. Rep. 912; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Block v. Standard Distilling Co., 95 Fed. Rep. 978; Allegratti Chocolate Cream Co. v. Keller, 85 Fed. Rep. 643.

<sup>5</sup>La Republique Francaise v. Schultz, 94 Fed. Rep. 500, 501.

<sup>6</sup>Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667-672. And see Air-Brush Mfg. Co. v. Thayer, 84 Fed. Rep. 640.

§ 16. **Trade slander and libel.**—The question whether equity will enjoin competing traders from publishing libelous or slanderous matter concerning their competitors' business has been frequently presented to the courts. In an early case Lord Eldon said: "The publication of a libel is a crime, and I have no jurisdiction to prevent the commission of crimes, except, of course, such cases as belong to the protection of infants, where a dealing with an infant may amount to a crime,—an exception arising from that peculiar jurisdiction of this court."<sup>1</sup> How far this doctrine—which extended to all forms of libel—has been modified by the federal courts of the United States is an involved question, the discussion of which would not be relevant in this book.

But at an early date Lord Cottenham, in refusing to enjoin libelous statements uttered of the plaintiff's literary work, said that the proper remedy lay in an action at law.<sup>2</sup> And the English courts have subsequently held that where matter has been held libelous in an action at law, the repetition of the libel would be enjoined in equity.<sup>3</sup> In one case where the court refused to enjoin a defendant from circulating an advertisement among the plaintiff's customers which charged the plaintiff with infringing his trade-marks, the court intimated that the injunction might have been granted if malice had been shown.<sup>4</sup> It may now be regarded, however, as the

<sup>1</sup>Gee v. Pritchard, 2 Swanst. 402. To the same effect see (refusing an injunction against the exhibition of a painting falsely purporting to be a copy of a picture by the plaintiff) Martin v. Wright, 6 Sim. 297; refusing to enjoin a publication by defendant of a statement disparaging the plaintiff's literary work, Seely v. Fisher, 11 Sim. 581; 10 L. J. Ch. N. S. 274. And see Clark v. Freeman, 11 Beavan, 112; Fleming v. Newton, L. R. 1 H. L. C. 363; Bullock v. Chapman, 2 DeG. & Sm. 211; Browne v. Freeman (2), Cox, Manual, 424; Prudential Assurance Co. v. Knott, L. R. 10 Ch. D. 142; Fisher & Co. v. The Apollinaris Co., L. R. 10 Ch. D. 297-299; Ward v. Drat, Cox, Manual, 607.

<sup>2</sup>Seely v. Fisher, 11 Sim. 581; 10 L. J. Ch. N. S. 274.

<sup>3</sup>Saxby v. Easterbrook, Cox, Manual, 606; Hinrichs v. Berndes, Cox, Manual, 594; Thornley's Cattle Food Co. v. Massam, L. R. 46 L. J. Ch. 713.

<sup>4</sup>Colley v. Hart, 7 R. P. C. 101.

settled law in England that "the court will interfere by injunction where statements are made with reference to the infringement of a patent, or the invasion of a trade-mark and the like, if it is proved to the satisfaction of the court that these statements are untrue."<sup>1</sup>

The same doctrine would seem to obtain in this country. It is libelous to publish of a dealer in school books that he deals in "antiquated books" and books which are "disgraceful trash."<sup>2</sup> And it has been held libelous *per se* to publish of another dealer of the same name (Davey) "that an unscrupulous grocer of the same name, in the immediate vicinity, advertises 'Davey's teas and coffees,' with a view to deceive the public, and may sell an inferior article."<sup>3</sup> Judge Lacombe has laid down the broad proposition that "every legal occupation from which pecuniary benefit may be derived creates such special susceptibility to injury by language charging unfitness or improper conduct of such occupation that such language is actionable, without proof of special damage."<sup>4</sup> It is the necessary corollary of this rule that a disparaging statement concerning the goods sold by another, whether under a trade-mark or not, must be of a character to charge him with business incapacity or improper conduct of his business before it can come within the class of matter that is slanderous or libelous *per se*. For if the words used apply to the plaintiff's merchandise in such a manner as to constitute an imputation of his improper conduct in or want of capacity for his business, they will be libelous or slanderous *per se*.<sup>5</sup>

<sup>1</sup>Chitty, J., in *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757-758; and to the same effect, *Halsey v. Brotherhood*, 45 L. T. N. S. 640; *Empire Typesetting Machine Co. v. Linotype Co.*, 79 L. T. N. S. 8.

<sup>2</sup>*American Book Co. v. Gates*, 85 Fed. Rep. 729-734.

<sup>3</sup>*Davey v. Davey*, 50 N. Y. Supp. 161.

<sup>4</sup>*Ohio & Miss. Ry. Co. v. Press Pub. Co.*, 48 Fed. Rep. 206.

<sup>5</sup>So where in a criminal prosecution under the Oregon Code the words applied to the property of the prosecuting witness in such a manner as to expose him to hatred, contempt or ridicule, they were held to be a libel upon him. *State v. Mason (Oregon)*, 38 Pac. Rep. 130.



The truth is always a defense in actions of this character. Thus where the plaintiff had bought the goods in question from the defendant and advertised them for sale, the publication of an advertisement by the defendant that read as follows: "An opinion of Shawknit hose should not be formed from the navy blue stockings advertised as first quality by (plaintiff), since we sold (plaintiff) some lots which were damaged in the dye-house," was held not libelous, in the absence of a showing of its untruth.<sup>1</sup> And a wide latitude is allowed in criticism of chattels where the facts are not misstated. So it is not libelous to attack the theories advanced in a book even with sarcasm and ridicule, if there is no misrepresentation of what is set forth in the book;<sup>2</sup> and a criticism of one of the pictures of an artist stating that it is not good of its kind is not libelous, where it does not attack him in his professional character generally.<sup>3</sup> So, it has been held in England that no action will lie against a defendant trader for stating falsely and maliciously that his goods are superior to those of the plaintiff, even though the plaintiff suffers special damage therefrom,<sup>4</sup> and no false statement directly disparaging the plaintiff's goods is actionable in the absence of proof of special damage.<sup>5</sup>

Where an alleged libel consisted of a charge that the plaintiff had no right to use a certain trade-mark, it was held to be a slander of title and not a libel upon the plaintiff; that the burden was upon the plaintiff to prove malice, falsity and special damage, and that the cause of action survived the plaintiff's death.<sup>6</sup>

<sup>1</sup>Boynton v. Shaw Stocking Co., 146 Mass. 219; 15 N. E. Rep. 507.

<sup>2</sup>Dowling v. Livingstone, 108 Mich. 321; 66 N. W. Rep. 225.

<sup>3</sup>Battersby v. Collier, 54 N. Y. Supp. 363.

<sup>4</sup>Hubbuck v. Wilkinson (C. A.), L. R. (1898) 1 Q. B. 86.

<sup>5</sup>Mellin v. White, L. R. (1895) A. C. 154.

<sup>6</sup>Hatchard v. Mege, L. R. 18 Q. B. D. 771-775.

## CHAPTER II.

### THE ACQUISITION OF A TRADE-MARK.

§ 17. **Who may acquire.**—Generally speaking, any person<sup>1</sup> capable of holding title to personal property may acquire the right to a trade-mark. In practice, by far the greater portion of all trade-marks are held by manufacturers. There are, however, many persons, not manufacturers, who use trade-marks as a means of identifying the subject-matter of their commerce. First among these, in their natural order, are those who apply geographical names as trade-marks, to the natural products of the earth. This may be done, of course, only by the owner of its sole place of production,<sup>2</sup> as, if the product were accessible to others, there could be no exclusive right to a trade-mark, except to identify the person who handled the product on its way to the consumer.

This leads us to the second, and larger, class of those

<sup>1</sup>“A corporation is entitled to have its trade-mark as well as a private individual, and may sue for its infringement.” Fenner, J., in *Insurance Oil Tank Co. v. Scott*, 33 La. Ann. 946

<sup>2</sup>*Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y. 291-302; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; Cox, 599; *Dunbar v. Glenn*, 42 Wis. 118; Seb. 529; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; *Radde v. Norman*, L. R. 14 Eq. 348; *Braham v. Beachim*, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; Seb. 589; *Hill v. Lockwood*, 32 Fed. Rep. 389; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469; *City of Carlsbad v. Kutnow*, 71 Fed. Rep. 167; affirming 68 Fed. Rep. 794; *Northcutt v. Turney*, 101 Ky. 314; 41 S. W. Rep. 21.

It has been held that where a locality has taken its name from the use of a word used as a trade-mark for coal mined by the owner of part of the locality, he will still be entitled to the exclusive use of the word as a trade-mark, as against others mining in the locality which has so derived its name. *Atwater v. Castner*, 88 Fed. Rep. 642. But the contrary has been held in *Coffman v. Castner*, 87 Fed. Rep. 457.

who can acquire trade-mark rights, though they are not manufacturers. Many mercantile houses who merely select merchandise, use trade-marks upon the goods they so select, and these are valid, because, in the language of Mr. Chief Justice Fuller, the marks so used are equivalent to a certificate that the goods so marked are the genuine article which has been determined by the selectors to possess a certain degree of excellence, evidencing that the skill, knowledge and judgment of the selectors have been exercised in ascertaining that the particular goods so marked are possessed of a merit rendered definite by their examination and of a uniformity rendered certain by their selection.<sup>1</sup> Slightly analogous to this class of cases are those where the members of a trades union adopt a label to be used by the workmen who compose the union, upon the goods manufactured by them. In a number of cases their right to the protection of this label, as a trade-mark, has been denied,<sup>2</sup> while in others the right is affirmed.<sup>3</sup>

<sup>1</sup>Menendez v. Holt, 128 U. S. 514-520; Levy v. Waitt (1), 56 Fed. Rep. 1016; Levy v. Waitt (2), 61 Fed. Rep. 1008; Hirsch v. Jonas, L. R. 3 Ch. D. 584-586; Re Australian Wine Importers (Ltd.), 41 Ch. D. 278-281; Thompson & Co. v. Robertson, Ct. Sess. Cas. (4th ser.) XV, 880; 25 Scot. L. Rep. 649; Yale Cigar Mfg. Co. v. Yale, 30 Off. Gaz. 1183; Wood v. Lambert, L. R. 32 Ch. D. 247.

<sup>2</sup>Ex parte Cigar Makers' Ass'n, 16 Off. Gaz. 958; Schneider v. Williams, 44 N. J. Eq. 391; Cigar Makers' Union v. Conhaim, 40 Minn. 726 (the last case by a divided court, three denying the right of trade-mark and two affirming it); McVey v. Brendel, 144 Pa. St. 235; Cox, Manual, Case No. 730; Weener v. Brayton, 152 Mass. 101; Cox, Manual, Case No. 712.

<sup>3</sup>Allen v. McCarthy, 37 Minn. 349, affirming the decision of the lower court by an equally divided bench; Bloete v. Simon, 19 Abb. N. C. 88; People v. Fisher, 57 N. Y. Sup. Ct. 552; Cigar Makers' Protective Union v. Lindner, 3 Ohio St. Dec. 244; Strasser v. Moonelis, 108 N. Y. 611; Tracy v. Banker, 170 Mass. 266. In Carson v. Ury, Judge Thayer remarks: "It is no doubt true that the union label does not answer to the definition ordinarily given of a technical trade-mark, because it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer,

Importers<sup>1</sup> or exporters<sup>2</sup> may have trade-marks to identify the goods passing through their hands, and it has been held that a bleacher who finishes goods manufactured by another has a right to a trade-mark applied to goods so treated by him.<sup>3</sup>

§ 18. **User.**—There can be no right in a trade-mark until it has been used. Under the English act<sup>4</sup> an application for registration of a trade-mark is deemed to be equivalent to public use of the trade-mark. But even this is merely to supply a constructive instead of the actual user required at common law,<sup>5</sup> and the general rule is not affected by that statute.<sup>6</sup> The exclusive right to the use of a trade-mark is acquired only by priority of appropriation. The claimant of a trade-mark must have been the first to use or employ the same on like articles of production.<sup>7</sup> A single instance of user, with accompanying circumstances evidencing an intent to continue that use, is sufficient to establish the right to a trade-

and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long and only so long as he remains a member of the union. In each of these respects the label lacks the characteristics of a valid trade-mark." In the case at bar, the complainant being a manufacturer of cigars, he was granted equitable relief on the ground of unfair competition. *Carson v. Ury*, 39 Fed. Rep. 777; *Cox*, Manual, Case No. 709. As to criminal prosecution for infringement of union label see *State v. Bishop*, 128 Mo. 373.

<sup>1</sup>*Godillot v. Hazard*, 44 N. Y. Super. Ct. 427.

<sup>2</sup>*Robinson v. Finlay*, L. R. 9 Ch. D. 487.

<sup>3</sup>*Re Sykes*, 43 L. T. N. S. 626.

<sup>4</sup>Sec. 75, Patents, Designs and Trade-mark Act, 1883, amended 1888, 51 and 52 Vict., c. 50; *Re Hudson's Trade-mark*, 3 R. P. C. 155; 32 Ch. D. 311; 55 L. J. Ch. 531; 55 L. T. 228; 32 W. R. 616; *Cartmell*, 168; *Edwards v. Dennis*, 30 Ch. D. 454.

<sup>5</sup>Under the act of 1870 it was held that registration was equivalent to public use of a trade-mark. *Re Dutcher Temple Co.*, Comr. Dec. 1871, p. 248. See sections 7 and 11 of the Act of 1881; *Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co.*, 11 Fed. Rep. 495.

<sup>6</sup>*Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-440; *Lowell Mfg. Co. v. Larned*, *Cox*, Manual, No. 428.

<sup>7</sup>*Columbia Mill Co. v. Alcorn*, 150 U. S. 460; *Tetlow v. Tappan*, 85 Fed. Rep. 774; *Hyman v. Solis Cigar Co.*, 4 Colo. App. 475.

mark; there is no requirement that the use shall continue for any prescribed or definite length of time.<sup>1</sup>

§ 19. **Affixing the mark.**—As stated in our definition, the mark must be affixed to the subject it serves to identify. "It may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods."<sup>2</sup> It has been held in England that a trade-mark may be water-marked,<sup>3</sup> and a measuring stick with an octagonal head, used as a core for rolls of carpet, has been held to be of itself a valid trade-mark.<sup>4</sup> The question of the mode of affixing is purely practical, and one package, parcel or bottle of merchandise may bear a number of trade-marks. A very large percentage of the liquors imported into the United States from Europe bear not only the trade-mark of the producer, but also that of the bottler; and in many cases another trade-mark, that of the capsule manufacturer, is to be found impressed in the metallic capsule. In like manner a complicated machine may bear many trade-marks, indicating the manufacturers of the wheels, axles, oil-cups, bearings, etc., and the machine as a whole bear the comprehensive trade-mark of the maker who has selected these several parts and assembled them.

<sup>1</sup>Shaver v. Shaver, 54 Iowa, 208; 37 Am. Rep. 194; Hall v. Barrows, 32 L. J. Ch. 548; Seb. 215.

*The length of time required to establish the right of trade-mark.*—"The interference of a court of equity cannot depend on the length of time the manufacturer has used the trade-mark." Romilly, M. R., in Hall v. Barrows, 32 L. J. Ch. 548.

The right exists "the moment the article goes into the market so stamped." Westbury, L. C., in McAndrew v. Bassett, 4 DeG. J. & S. 380-386.

The right dates from the time when the actual occupation of the market with goods bearing the mark began. Levy v. Waitt (C. C. A.), 61 Fed. Rep. 1008-1011.

<sup>2</sup>Sir G. Jessel, M. R., in Singer Mfg. Co. v. Wilson, *supra*.

<sup>3</sup>Alexander Pirie & Sons v. Goodall, L. R. (1891) 1 Ch. D. 35-41; holding a water-mark to be a "brand" within the meaning of sec. 64, subsec. 2 (c) of the Patents, Designs and Trade-marks Act, 1883.

<sup>4</sup>Lowell Mfg. Co. v. Larned, Cox, Manual, No. 428; Fed. Case No. 8570.

§ 20. **Registration not a means of acquiring.**—With the solitary exception of the California case of *Whittier v. Dietz*,<sup>1</sup> it has nowhere been held in the United States that the right to a trade-mark is created by registration.<sup>2</sup> Section 1 of the act of 1881 provides that owners of trade-marks used in commerce may obtain registration of such trade-marks by complying with the requirements stipulated in the act. The applicant must show that he, and no one else, has a right to use the mark; that he is actually using it in commerce with foreign nations or with Indian tribes; and that it is not too similar to the registered or known mark of another.<sup>3</sup> So that registration under the act of congress is in no sense a means of acquiring the right to a trade-mark;<sup>4</sup> and indeed the actual application of the trade-mark in commerce is so essential a prerequisite to registration under the act, that as between two applicants for registration of the same mark, one of whom had in fact used his mark in trade, while the other had the assignment of the mark, acquired by transfer from its inventor, but had never

<sup>1</sup>66 Cal. 78. This decision led to the enactment of the present section 3199 of the Political Code of California (March 12, 1885), providing that "Any person who has first adopted and used a trade-mark or name, whether within or beyond the limits of this state, is its original owner."

<sup>2</sup>The recording of a name as a trade-mark cannot give it the quality of a trade-mark, if it was not theretofore a valid trade-mark. *Oakes v. St. Louis Candy Co.*, 146 Mo. 391; 48 S. W. Rep. 467.

<sup>3</sup>Ex parte Leon Dupuy & Co., 28 Off. Gaz. 191.

<sup>4</sup>"Property in trade-marks does not derive its existence from an act of congress." *La Croix v. May*, 15 Fed. Rep. 236.

"Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts." *Hawley, J.*, in *Hennessy v. Braunschweiger & Co.*, 89 Fed. Rep. 665-668; quoted and followed in *Sleepy Eye Milling Co. v. C. F. Blanke Tea and Coffee Co.*, 85 Off. Gaz. 1905. It does not create a trade-mark. *United States v. Braun*, 39 Fed. Rep. 775; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624-627; *Brower v. Boulton*, 53 Fed. Rep. 389, 390; *Brower v. Boulton* (2), 58 Fed. Rep. 888-890; *Einstein v. Sawhill*, 65 Off. Gaz. 1918; *Sherwood v. Horton, Cato & Co.*, 84 Off. Gaz. 2018; *La Croix v. May*, 15 Fed. Rep. 236.

actually applied it, the commissioner of patents held that the actual prior use determined the right to the mark.<sup>1</sup> But registration under the laws of the United States and under the laws of several of the states, while creating no new rights, confers remedies and special protection to the owner of a trade-mark which we will examine in another chapter.

**§ 21. Acquisition by assignment.**—The assignment of trade-marks is a subject of some difficulty and is discussed elsewhere in this book. It is sufficient in this connection to say that trade-mark rights are generally assignable, that quality being indispensable to the striking characteristic of perpetual existence possessed by trade-marks, and that a proper assignment conveys to the assignee all the property rights in and to the trade-mark possessed by his assignor.<sup>2</sup> By section 12 of the act of 1881 the commissioner of patents was authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office. We need note at this time only the general restriction on the assignability of trade-marks—that they cannot be assigned save in connection with the good-will of the business with which they are identified.<sup>3</sup>

**§ 22. Acquisition by an alien.**—In 1844 Chancellor Walworth announced that in the interposition of equity for the protection of trade-mark rights “there is no difference between citizens and aliens.”<sup>4</sup> This is also the

<sup>1</sup>Schrauder v. Beresford & Co., Browne, Trade-marks, 661.

<sup>2</sup>Walton v. Crowley, 3 Blatch. 440; Cox, 166.

<sup>3</sup>Field, J., in Kidd v. Johnson, 100 U. S. 617-620.

<sup>4</sup>Taylor v. Carpenter (3), 11 Paige Ch., 292-296; 3 Story, 458; 2 Wood. & M. 1; Cox, 45. This is the general rule in the United States. Lacroix v. May, 15 Fed. Rep. 236; Lemoine v. Ganton, 2 E. D. Smith, 343; Cox, 142; Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Coffeen v. Brunton, 4 McLean, 516; Cox, 82; and under a criminal act against counterfeiting trade-marks, a conviction was sustained by the Missouri supreme court where the defendant counterfeited the mark of an English manufacturer. State v. Gibbs, 56 Mo. 133.

rule in England,<sup>1</sup> Scotland,<sup>2</sup> Canada,<sup>3</sup> and India.<sup>4</sup> But it has been held that a foreigner has no common-law right to a trade-mark in the United States as against a citizen who has adopted a similar mark, in good faith, before the alien has sold any goods in this country.<sup>5</sup>

§ 23. **Priority of appropriation.**—In order to acquire a trade-mark, its claimant must be its first appropriator, as we have seen; for, as said by Finletter, J., “in no other way can a mark or device indicate ‘true origin or ownership.’”<sup>6</sup> Indeed, Bouvier has defined the right of trade-mark in these terms: “The right of trade-mark is said to be best termed an exclusive right arising from first use;”<sup>7</sup> and it has been said by the United States supreme court that “The exclusive right to the use of a mark or device claimed as a trade-mark is founded on priority of appropriation; that is to say, the claimant of a trade-mark must have been the first to use or employ the same on like articles of production.”<sup>8</sup> There must necessarily be such a use as qualifies the mark as an indication of the origin and ownership of the goods to which it is applied. If the same mark had been in prior use by another at the same place or another locality near enough to start a similar right, the second user could have no trade-mark right to it.<sup>9</sup> “In order that the claimant of the trade-mark may primarily acquire the

<sup>1</sup>Collins Co. v. Cowen, 3 K. & J. 423; Collins Co. v. Brown, 3 K. & J. 423; Collins Co. v. Walker, 7 W. R. 222; Collins Co. v. Reeves, 28 L. J. Ch. 56; Howe v. McKernan, 30 Beav. 547.

<sup>2</sup>Singer Mfg. Co. v. Kimball & Morton, Ct. Sess. Cas. (3d ser.) XI, 267.

<sup>3</sup>Davis v. Kennedy, 13 Grant, Up. Can. Ch. 523.

<sup>4</sup>Orr-Ewing v. Chooneeloll Mullick, Cor. 150; Orr-Ewing v. Grant, Smith & Co., 2 Hyde, 185.

<sup>5</sup>Richter v. Anchor Remedy Co., 52 Fed. Rep. 455.

<sup>6</sup>Sheppard v. Stuart, 13 Phil. 117; Price & Steuart, 193-200.

<sup>7</sup>Bouvier, Dict., title “Trade-marks.”

<sup>8</sup>Columbia Mill Co. v. Alcorn, 150 U. S. 460. See also Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721.

<sup>9</sup>Tetlow v. Tappan, 85 Fed. Rep. 774; Hyman v. Solis Cigar Co., 4 Colo. App. 475.



right of property in it, it must have been originally adopted and used by him—that is, the assumed name or designation must not be one that was then in actual use by others; and such adoption and use confer upon him the right of property in the trade-mark.”<sup>1</sup> A trade-mark having no necessary relation to invention or discovery,<sup>2</sup> it is the party who first actually uses a mark, and not the one who first thought of or designed it, that is entitled to protection in its use as a trade-mark.<sup>3</sup> A mere declaration of intention to use a certain mark in the future does not create a right to its use as a trade-mark, for such right can only originate with the actual use of the mark in commerce.<sup>4</sup> And it has been held in England, by Lord Justice Cairns, that there can be no right of trade-mark until the goods bearing the mark are actually upon the market, and that it cannot be protected before that time, even though the goods to which it is to be applied are in the course of manufacture, and the claimants of the mark have made expenditures in advertising it.<sup>5</sup> The right to the mark must relate back to its first use. One cannot unlawfully appropriate a trade-mark belonging to another, and subsequently acquire a good title thereto by the abandonment thereof by the first proprietor.<sup>6</sup>

<sup>1</sup>Derringer v. Plate, 29 Cal. 292; Cox, 324.

<sup>2</sup>Trade-mark Cases, 100 U. S. 82.

<sup>3</sup>George v. Smith, 52 Fed. Rep. 830; Trisdorfer & Co. v. Estate of Bassett, 60 MSS. D. Sept. 1896.

<sup>4</sup>Schneider v. Williams, 44 N. J. Eq. 391; 14 Atl. Rep. 812; 44 Off. Gaz. 1400.

<sup>5</sup>Maxwell v. Hogg, L. R. 2 Ch. 307; 36 L. J. Ch. 433; 16 L. T. N. S. 130; Seb. 264.

<sup>6</sup>O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576-578.

## CHAPTER III.

### WHAT CONSTITUTES A VALID TRADE-MARK.

§ 24. **The general rule.**—Having seen in the preceding chapters something of the general requisites of a valid trade-mark, we now approach the subject of the more exact tests to be applied in determining its validity. It is the general rule that a mark must be truthful and unobjectionable on the ground of being a generic term.

§ 25. **It must be truthful.**—This rule is apparently simple, yet it has given rise to much discussion and some apparent conflicts in the decisions. Honest competition is the requirement of the chancellor, and he is just as ready to dismiss the bill of a complainant whose trade-mark is calculated to deceive the public into a belief that his goods are something other than they actually are, as he is to enjoin the defendant where he has infringed an honest trade-mark. The modern law of unfair trade is a perfect superstructure of ethical principles, founded upon the basis of all ethics—honesty. In no class of cases is the rule that he who comes into a court of equity must do so with clean hands more rigidly applied.<sup>1</sup> It is not material whether the words or symbols used as trade-mark contain the deceptive or untruthful statement. Indeed the dishonest matter is usually foreign to the mark itself, and contained in other matter used in advertising or describing the goods sold under the mark.

§ 26. **A dishonest label will invalidate.**—We find that where a distiller mixed nearly thirty-six per cent. of other whiskies with his own brand, and sold the blend under a label formerly used upon whisky of his own distillation, with cautions to avoid imitations and asserting that the mixture was “bottled at the distillery ware-

<sup>1</sup>Dadirrian v. Yacubian, 98 Fed. Rep. 872-876.

house and is warranted perfectly pure and unadulterated," an injunction was refused because of this misrepresentation. This decision, whose tendency is more far-reaching than that of *Manhattan Medicine Co. v. Wood*,<sup>1</sup> seems on the reading of the facts to impose a hardship on the owners of the mark, Jas. E. Pepper & Co. The interest of the complainant was derived under a contract with that firm giving him the entire control of their trade in bottled whisky. The proof showed that up to and including the year 1891 the Pepper Company bottled nothing under the gold trade label partially described above used by them but "Old Pepper" whisky distilled by them, but that after November, 1891, the demand for the distillery bottling became so great that they could not supply it with the output of their own distillery and therefore bought other whiskies shown to be more expensive, older and made by the same formula as their own, and blended these whiskies with their own, and bottled the resulting blend under the same label and trade-mark. Here, if ever, one would think equity would relax its rule, and, as the public had not suffered by the complainant's acts, would continue to protect the trade-mark. But the learned court thus tersely applies the principles: "Pepper offers as an excuse for bottling a mixture that the demand for his goods had so increased that he could not supply it with Pepper whisky. What was this demand for? Plainly for pure and unadulterated Pepper whisky, bottled at the distillery. If this could not be honestly supplied, then it could not be supplied at all in such a way as to keep the business within the protection of a court of equity. Relief is refused to Pepper and his privies because of his misrepresentations to the public."<sup>2</sup> Thus is emphasized the statement of Mr. Justice Field that the protection of equity is extended to the owner of a trade-mark "not only as a mat-

<sup>1</sup>108 U. S. 218.

<sup>2</sup>*Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 584-596. An English case resembling this as to the facts is *Starey v. Chilworth Gunpowder Co.*, L. R. 24 Q. B. D. 90.

ter of justice to him, but to prevent imposition upon the public."<sup>1</sup> There are a number of cases in which the misrepresentation has been held to be so slight and immaterial as not to disentitle the complainant to relief.<sup>2</sup> Thus, a claim by the manufacturer of a patent medicine that it permanently overcomes habitual constipation, will not, even if untrue, disentitle the plaintiff from relief in equity, the court taking judicial notice of the fact that the effect of any medicine for constipation is largely dependent upon the constitution and habits of the person treated.<sup>3</sup>

**§ 27. The cases of false representation in connection with trade-marks.**— In 1837 the English High Court of Chancery in *Pidding v. How*, announced that it could not interfere in behalf of a plaintiff who had "thought fit to mix up that which may be true with that which is false" in his labels and advertisements.<sup>4</sup> The Court of Appeals of New York in a similar case in 1848, by Gardiner, J., observed laconically, "The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce; and at all events, if the maxim that he who asks equity must come with pure hands is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly."<sup>5</sup> Prior to this, an injunction was refused where the mark in question was applied by the complainant to a "quack" medicine.<sup>6</sup> "Balm of Thousand Flowers," the name of a cosmetic, being deceptive, its infringement by a defend-

<sup>1</sup> *Manhattan Medicine Co. v. Wood*, 108 U. S. 218-223; citing *Amoskeag Manufacturing Co. v. Trainer*, 101 U. S. 51.

<sup>2</sup> *Tarrant & Co. v. Hoff*, 71 Fed. Rep. 163; affirmed, 76 Fed. Rep. 959; *Centaur Co. v. Robinson*, 91 Fed. Rep. 889; *Ransom v. Ball*, 7 N. Y. Supp. 238.

<sup>3</sup> *California Fig Syrup Co. v. Worden*, 95 Fed. Rep. 132-134.

<sup>4</sup> *Pidding v. How*, 8 Sim. 477; *Cox*, 640; followed in *Perry v. Truefit*, 6 Beav. 66; *Cox*, 644.

<sup>5</sup> *Partridge v. Menck*, 2 Sandf. Ch. R. 622; 2 Barb. Ch. R. 101; 1 How. App. Cas. 558; *Cox*, 72.

<sup>6</sup> *Towle v. Spear*, 7 Penn. L. J. 176; *Cox*, 67; followed in *Heath v. Wright*, 3 Wall. Jr., 1; *Cox*, 154.

ant assuming the name "Balm of Ten Thousand Flowers" was not enjoined,<sup>1</sup> although the same mark was held valid and the rule announced that "the public should be left to its own guardianship" in *Fetridge v. Merchant*.<sup>2</sup> But the doctrine generally is that of *Pidding v. How*.<sup>3</sup>

For the reasons we have been considering in this chapter, the patent office has refused to admit to registration as a trade-mark for powdered soap "the picture of a bag having the open end thereof closed by a tie," the commissioner holding that such a mark was necessarily deceptive or descriptive, and in either event not a valid trade-mark.<sup>4</sup>

<sup>1</sup> *Fetridge v. Wells*, 4 Abb. Pr. 144; 13 How. Pr. 385; Cox, 180.

<sup>2</sup> 4 Abb. Pr. 156; Cox, 194.

<sup>3</sup> *Supra*, 8 Sim. 477; Cox, 640. The rule is conceded, announced or followed in *Hobbs v. Francais*, 19 How. Pr. 567; Cox, 287; *Phalon v. Wright*, 5 Phila. 464; Cox, 307; *Smith v. Woodruff*, 48 Barb. 438; Cox, 373; *Curtis v. Bryan*, 2 Daly, 212; 36 How. Pr. 33; Cox, 434; *Palmer v. Harris*, 60 Pa. St. 156; 8 Am. L. Reg. N. S. 137; Cox, 523; *Dixon Crucible Co. v. Guggenheim*, 3 Am. Law T. 228; 2 Brewster, 321; Cox, 559; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 Jur. N. S. 513; Cox, 688; 11 H. L. C. 543; *Flavel v. Harrison*, 10 Hare, 467; *Morgan v. McAdam*, 36 L. J. Ch. 228; *Ford v. Foster*, L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; *Re Saunion & Co.*, Cox, Manual, No. 625; *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. N. S. 567; L. R. 10 Ch. D. 276; 44 L. J. Ch. 223; 32 L. T. N. S. 80; 23 W. R. 213; *Joseph v. Macowsky*, 96 Cal. 518; *Meriden Britannia Co. v. Parker*, 39 Conn. 454-460; *Laird v. Wilder*, 2 Bush (Ky.), 131; 15 Am. Rep. 707; *Connell v. Reed*, 128 Mass. 477; 35 Am. Rep. 299; *Wolfe v. Burke*, 7 N. Y. Sup. Ct. 151; 56 N. Y. 115; 2 Off. Gaz. 441; *Seabury v. Grosvenor*, 53 How. Pr. 192; 14 Off. Gaz. 679; *Hennessy v. Wheeler*, 69 N. Y. 271; *Piso Co. v. Voight*, 4 Ohio N. P. 347; *California Syrup of Figs Co. v. Stearns* (1), 67 Fed. Rep. 1008; *Wood v. Butler*, 3 R. P. C. 81; L. R. 32 Ch. D. 247; 55 L. J. Ch. 377; 54 L. T. 314; *Cartmell*, 349; *Re Heaton's Trade-mark*, L. R. 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. 220; 32 W. R. 951; *Cartmell*, 160; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31; *Cartmell*, 242; *Kenny v. Gillet*, 70 Md. 574; *Siebert v. Abbott* (1), 61 Md. 276; *Parlett v. Guggenheimer*, 67 Md. 542; *Palmer v. Harris*, 60 Pa. St. 156; *Hoxie v. Cheney*, 143 Mass. 592; *Clotworthy v. Schepp*, 42 Fed. Rep. 62; *California Syrup of Figs Co. v. Stearns* (2), 73 Fed. Rep. 812; *Buckland v. Rice*, 40 Ohio St. 526; *Burton v. Stratton*, 12 Fed. Rep. 696-699; *Ginter v. Kinney Tobacco Co.*, 12 Fed. Rep. 782.

<sup>4</sup> *Ex parte Martin*, 89 Off. Gaz. 2259. "A word to be used as a trade-mark must obviously be meaningless as applied to the goods, so as to be neither descriptive nor deceptive." Buell, Commissioner, in *Ex parte Pearson Tobacco Co.*, 85 Off. Gaz. 287.

§ 28. **Manhattan Medicine Co. v. Wood.**—This decision, the language of whose opinion has been more often cited in support of the proposition under consideration than any other, was based on this statement of facts. The complainant derived all its trade rights in and to a proprietary medicine styled “Atwood’s Genuine Physical Jaundice Bitters” from its original manufacturer, Moses Atwood, who lived at Georgetown, Massachusetts, and manufactured it there. The court says: “It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company, in the city of New York.”<sup>1</sup> On these facts the protection of their mark was refused complainants.

§ 29. **The similar cases — Assignment must be made public in conjunction with the trade-mark, when.**—Following *Manhattan Medicine Co. v. Wood*, the Court of Appeals of Maryland held<sup>2</sup> that where the label used by the manufacturers of Angostura Bitters did not disclose the death of Dr. J. G. B. Siegert, their originator, that the label was not truthful and its infringement would not be enjoined. And the same rule has been applied as against one continuing to use the name of a predecessor in business, whose label does not announce the change.<sup>3</sup> The rule in this regard is held by McKenna, J., to be that where a trade-mark is a mark of special qualities, due to superior material, processes, skill and care exercised by the originator thereof, an assignee of the business who continues to use labels which contain the false statement that the goods are being prepared by the originator is not entitled to equitable relief against an infringer.<sup>4</sup>

<sup>1</sup> *Manhattan Medicine Co. v. Wood*, 108 U. S. 218.

<sup>2</sup> *Seigert v. Abbott* (1), 61 Md. 276. The same doctrine is followed in *Sherwood v. Andrews*, 5 Am. L. Reg. N. S. 588; Seb. 263; *Stachelberg v. Ponce*, 23 Fed. Rep. 430; *Price & Steuart*, 967.

<sup>3</sup> *Helmbold v. H. T. Helmbold Mfg. Co.*, 53 How. Pr. 453.

<sup>4</sup> *Alaska Packers’ Association v. Alaska Imp. Co.*, 60 Fed. Rep. 103. The supreme court of Pennsylvania has held the contrary, saying that an assignee is entitled to relief, even though he has not designated himself as assignee in making use of the mark. *Fulton*

§ 30. **Unauthorized use of words "patent" or "patented."**—The use of the words "patent" or "patented," in connection with or as part of a trade-mark, where the article identified by the mark is in fact not covered by letters patent, has given rise to many interesting decisions. All of these matters of untruthful representation are to be tested by the question of whether or not they are direct, or "purely collateral" misrepresentations.<sup>1</sup> Where the letters patent of the United States covering an alleged improvement in jars had been declared invalid by judicial decision, but the manufacturer continued to designate the jars "Mason's Patent" jars, it was held that the fact deprived the manufacturer of equitable relief against an infringement.<sup>2</sup> In England a plaintiff used on his label the words "Royal letters patent," and supported the use of the words by showing that for many years he had paid the stamp duty on "patent medicines," and was only using the labels remaining on hand at the time he discovered his medicines did not belong to that class. He was denied an injunction against an infringer of his label.<sup>3</sup>

The reason for the particular disfavor with which equity regards this class of cases is that, by using words indicating that an article is patented where it is not, the owner of the mark is seeking to obtain the benefits of a

v. Sellers, 4 Brewst. 42. The tendency of the later rulings is to uphold the use of the mark by the assignee, except where his failure to disclose the fact of the assignment is equivalent to misrepresentation and falsehood. See Pillsbury v. Flour-mills Co., 64 Fed. Rep. 841-850.

<sup>1</sup>Ford v. Foster, L. R. 7 Ch. D. 611; 27 L. T. N. S. 220; 20 W. R. 311; Cox, Manual, 384. In this case the false use of the word "patentee," used by the complainant in advertisements, was held to be a collateral misrepresentation which did not disentitle him to a remedy in equity against an infringer.

<sup>2</sup>Consolidated Fruit Jar Co. v. Dorflinger, Fed. Case No. 3129; 6 Fed. Cas. 339; 2 Am. Law T. Rep. N. S. 511; Cox, Manual, 444. The same rule is announced in England in Leather Cloth Co. v. Lorsche, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. N. S. 661; 18 W. R. 572; Cox, Manual, Case No. 324; Nixey v. Roffey, W. N. 1870, p. 227; Cox, Manual, Case No. 343.

<sup>3</sup>Lamplough v. Balmer, W. N. 1867, p. 293.

monopoly, where he has none. As stated by Vice-Chancellor Wood, in *Morgan v. McAdam*:<sup>1</sup> "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiff under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorized to sell it; and further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of license or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation."

And although in another English case<sup>2</sup> a plaintiff was held entitled to recover in an action at law in a case of this kind, where his father had held a patent held to be invalid (as in *Consolidated Fruit Jar Co. v. Dorflinger*, *supra*, where the contrary rule is announced), the rule is generally that, where no valid patent has ever existed, the use of words indicating the contrary will debar the plaintiff from relief in equity.<sup>3</sup>

But where there has been a valid patent upon the subject-matter of the trade-mark, different issues arise.

In England it has been held that the fact that a plaintiff put a mark upon his goods with the addition of the words "trade-mark," when his mark was not registered, did not amount to such a misrepresentation as to deprive him of the right to an injunction, because the use of the

<sup>1</sup>36 L. J. Ch. 228; Cox, Manual, Case No. 267. Other arguments are used by the same judge in *Flavel v. Harrison*, 10 Hare, 467; 22 L. J. Ch. 866; 17 Jur. 368; 1 W. R. 213; Cox, Manual, Case No. 116.

<sup>2</sup>*Sykes v. Sykes*, 3 B. & Cr. 541.

<sup>3</sup>*Leather Cloth Co. v. American Leather Cloth Co.*, 11 Jur. N. S. 513; Cox, 688; 11 H. L. C. 543; Cox, Manual, Case No. 223. See, *per contra*, *Stewart v. Smithson*, 1 Hilt. 119; Cox, 175. This case cannot be regarded as of authority.



words "trade-mark" did not necessarily carry with it the implication that the mark had been registered.<sup>1</sup>

**§ 31. Use of such word or a trade-mark where there has been a patent.**—In *Cheavin v. Walker*,<sup>2</sup> Jessel, M. R., observes with regard to the effect of the use of the word "patent" by the plaintiff: "The question was fully discussed in the case in the House of Lords, *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 543,<sup>3</sup> and I have nothing to add to what was there said. No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that which was a patent, but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade-mark. Protection only extends to the time allowed by the statute for the patent, and if the court were afterwards to protect the use of the word as a trade-mark, it would be in fact extending the time for protection given by the statute. It is therefore impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark."<sup>4</sup>

"But, further, no man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still subsisting."

<sup>1</sup>*Sen Sen Co. v. Britten*, L. R. (1899) 1 Ch. D. 692.

<sup>2</sup>L. R. 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. 938; *Cartmell*, 92; *Seb.* 528. See also *Nixey v. Roffey*, W. N. 1870, p. 227; *Seb.* 343.

<sup>3</sup>*Ante*, § 30.

<sup>4</sup>The rule is well settled that (after the patent has expired) there is no trade-mark in the name applied to a patented article during the life of a patent, to distinguish it as a patented article from others of a like nature. *Fairbanks v. Jacobus*, 14 Blatchf. 337; *Singer Mfg. Co. v. Stanage*, 6 Fed. Rep. 279; *Adee v. Peck Bros. & Co.*, 37 Fed. Rep. 209; *Singer Mfg. Co. v. June*, 163 U. S. 169; *Wilcox & Gibbs S. M. Co. v. The Gibbens Frame*, 17 Fed. Rep. 623; *Singer Mfg. Co. v. Bent*, 163 U. S. 205; *Centaur Co. v. Killenberger*, 87 Fed. Rep. 725; *Singer Mfg. Co. v. Larsen*, 8 Biss. 151; *Burton v. Stratton*, 12 Fed. Rep. 696-700; *Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44;

And Kekewich, J., said, in *Re Adams' Trade-marks*:<sup>1</sup> "The word 'patent' means not necessarily that there is now current a patent of protection, but that the article in question is one of those articles which had the merits of utility and novelty, and therefore received the protection of the crown by letters patent."

There are other decisions, however, not so clear as to facts, and apparently not in harmony with *Cheavin v.*

*Singer Mfg. Co. v. Riley*, 11 Fed. Rep. 706; *Wheeler & Wilson Mfg. Co. v. Shakespear*, 39 L. J. Ch. 36; *Tucker Mfg. Co. v. Boyington*, Fed. Cas. No. 14229; 9 Off. Gaz. 455; *Filley v. Child*, 16 Blatchf. 376; *Ralph v. Taylor*, L. R. 25 Ch. D. 194; *Linoleum Mfg. Co. v. Nairn*, 7 Ch. D. 834; *Young v. Macrae*, 9 Jur. N. S. 322; *Re Palmer's Trade-mark*, 24 Ch. D. 504; *Re Leonard & Ellis' Trade-mark*, 26 Ch. D. 288; *Singer Mfg. Co. v. June*, 41 Fed. Rep. 208; *Brill v. Singer Mfg. Co.*, 41 Ohio St. 127; 52 Am. Rep. 74; *Hiram Holt Co. v. Wadsworth*, 41 Fed. Rep. 34; *Coats v. Merrick Thread Co.*, 36 Fed. Rep. 324; *Centaur Co. v. Heinsfurter*, 84 Fed. Rep. 955; 28 C. C. A. 581; *Lorillard v. Pride*, 28 Fed. Rep. 434; *Gally v. Colt's Patent Fire Arms Mfg. Co.*, 30 Fed. Rep. 118; *Dover Stamping Co. v. Fellows*, 163 Mass. 191; 47 Am. St. Rep. 448; *Centaur Co. v. Robinson*, 91 Fed. Rep. 889; *Centaur Co. v. Neathery*, 91 Fed. Rep. 891; *Centaur Co. v. Hughes Bros. Mfg. Co.*, 91 Fed. Rep. 901; *Centaur Co. v. Marshall*, 97 Fed. Rep. 785. (Although the name may remain a valid trade-mark in another country where the article was not patented. *Rahtjen Co. v. Holzappel Co.*, 101 Fed. Rep. 257; reversing s. c., 97 Fed. Rep. 949.

But this rule does not apply when the use of the trade-mark antedates the patent. *Batchellor v. Thomson*, 93 Fed. Rep. 660-665.

But where some special word, device, or symbol is added to the general name of the article covered by the patent, it is possible that a trade-mark right may exist in the combination of the word and the device or symbol, notwithstanding the patent. *Dover Stamping Co. v. Fellows*, 163 Mass. 191; 47 Am. St. Rep. 448; *Waterman v. Shipman*, 130 N. Y. 301; reversing same case, 8 N. Y. Supp. 814.

One who adopts a trade-mark for an article, and also applies unsuccessfully for a patent upon that article, has a valid subsisting right to the trade-mark when his application for the patent is rejected. "His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trade-mark." *Bradley*, Circuit Justice, in *Sawyer v. Kellogg*, 7 Fed. Rep. 720-723.

But there may be a valid trade-mark upon a patented article during the life of the patent, and if the patent is reissued the trade-mark will be valid during the life of the reissued patent. *Hiram Holt Co. v. Wadsworth*, 41 Fed. Rep. 34.

<sup>1</sup> 9 R. P. C. 174; 66 L. T. 610; *Cartmell*, 43.

*Walker, supra.* Five years after that case, Bacon, V. C., in a case where the plaintiffs had stamped the word "patent" on plowshares manufactured by them after their patent had expired, said "(they) make their shares according to the invention in the expired patent, as everybody else may; but to suggest that they have in any manner claimed anything under or in respect to that patent, and that they have done this fraudulently and to deceive the public, is merely desperate, and opposed to the truth of the case."<sup>1</sup> Yet it does not appear in the report wherein this differed from the use of the word "patent" as criticised in *Cheavin v. Walker*. In another case<sup>2</sup> Vice-Chancellor Wood said: "It does not follow, because upon the expiration of the patent the article and its known description become known to all, that therefore all would become entitled to use the label by which the patentees had been accustomed to distinguish their goods." This he held in regard to a label used on packages of pins marked "Taylor & Co.'s Patent Solid-headed Pins;" the manufacturer continuing to use the label after the expiration of his patent. The conclusion of the learned Vice-Chancellor was that "The public may have acquired confidence in that particular label, and that confidence may have given a value to it which the patentees may be entitled to have after the expiration of their patent."

In another case it was held that where plaintiffs labeled their thread "Patent Thread," they would not be denied relief against an infringer, because the word "patent" by long usage had come to denote the char-

<sup>1</sup>*Ransome v. Graham*, 51 L. J. Ch. 897; 47 L. T. 218; *Cartmell*, 279. Same rule in *Stewart v. Smithson*, 1 Hilt. 119; *Cox*, 175; *Leather Cloth Co. v. Hirschfeld*, 1 N. R. 551; *Cox*, Manual, Case No. 214. And even where no letters patent have ever issued, but the exclusive right of manufacture of baskets has been secured by registration of their design. *Cave v. Myers*, Seton (5th ed.), 539; *Cox*, Manual, Case No. 304.

<sup>2</sup>*Edelsten v. Vick*, 11 Hare, 78; 1 Eq. Rep. 413; 18 Jur. 7; *Cox*, Manual, Case No. 119.

acter of the thread, and did not imply the existence of any patent.<sup>1</sup>

Of course the holder of letters patent may describe himself as "patentee" and his goods as "patented" even where he doubts the validity of the patent, and its validity has been questioned by others.<sup>2</sup> And it has been held in New York that one who applies for letters patent is not disentitled from relief against an infringer by reason of his describing the goods as "patented" after his application had been filed, but before the issuance of letters patent.<sup>3</sup> Where the plaintiffs used their label bearing the words "specially registered trade-mark" after application, but before registration, the English Court of Appeals granted an interlocutory injunction against an infringer, but expressly said in their opinion that they refrained from finally deciding the question whether that misrepresentation *prima facie* destroyed plaintiffs' right to protection.<sup>4</sup>

It will be seen, therefore, that the cases discussed in this and the next preceding section are for the greater part English, and their reasoning is rather confused. The surest conclusion to be reached by an examination of the cases in this section is that of Lord Kingsdown, in *Morgan v. McAdam*:<sup>5</sup> "Of course it would be better, and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty, upon the articles which they designate as patented."

§ 32. **Generic term, defined.**—By "generic term" (Latin, *genus, gener*; French, *genre*) is meant a term which may not be appropriated as a trade-mark because it is too general and comprehensive in its meaning to become

<sup>1</sup>Marshall v. Ross, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086; Cox, Manual, Case No. 316.

<sup>2</sup>Blakey v. Latham, 85 L. T. (Journal), 47.

<sup>3</sup>Lauferty v. Wheeler, 16 How. Pr. 488; 11 Daly, 194.

<sup>4</sup>Read v. Richardson, 45 L. T. 54; Cartmell, 281.

<sup>5</sup>36 L. J. Ch. 228; Cox, Manual, No. 267.

the monopoly of an individual in application to merchandise. The word in its proper signification includes the use of geographical names, proper names, and descriptive words, used in commerce. It is a matter of regret that the courts have not defined these several phrases in their relations to each other, but such is the fact. The correctness of the author's definition is clearly established by analysis of the three classes of words and the reasons why they are not sustained as trade marks. We will examine them in their order.

(a) *Geographical names*.—Mr. Justice Strong has said, "It must be considered as a sound doctrine that no one can apply the name of a district or country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation."<sup>1</sup> In our further examination of the use of geographical names in trade, we will find that they are never properly sustained as technical trade-marks except where they are used by one who is the sole owner of the entire locality to which the name is applied. In such a case the geographical name has ceased to be generic, because one person has the sole and exclusive right of trade or manufacture in the locality. Thus the author reasons that geographical names are ordinarily generic, and whenever they are held not to be valid trade-marks it is because they are generic.

(b) *Proper names*.—The eminent English barrister, Mr. Sebastian, has said in his work on trade-marks that "a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate."<sup>2</sup>

(c) *Descriptive words* have always been understood to come within the category of generic terms; indeed, Mr. Browne in his treatise upon the subject has defined

<sup>1</sup> Delaware & Hudson Canal Co. v. Clark, 13 Wall. (80 U. S.) 311-327.

<sup>2</sup> Sebastian on Trade-marks (4th ed.), p. 23.

“generic names” to be “names merely descriptive of an article of trade, of its qualities, ingredients or characteristics.”<sup>1</sup> The United States supreme court has held that there can be no technical trade-mark right in words used to denote class, grade, style, quality, ingredients or characteristics.<sup>2</sup>

It is apparent, therefore, that the definition of generic terms which we have adopted is scientifically exact, including nothing more nor less than the words which are not subject to exclusive appropriation as trade-mark, because they cannot be so appropriated “to the advancement of the business interests of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that, on account of their general or popular use, every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any person.”<sup>3</sup>

A generic or descriptive word cannot be made a valid trade-mark by misspelling it (as, for example, “Kid Nee Kure,” applied to a medicine),<sup>4</sup> or by printing it in letters from the alphabet of a foreign language.<sup>5</sup>

It must not be inferred, however, that words in common use cannot be appropriated as trade-marks. They certainly can be so appropriated if used in a new and distinctive sense. If any other rule obtained, no words could be used as trade-marks unless the person adopting them was their original and first inventor. There is no such legal requirement either as to words or devices.<sup>6</sup> “Words in common use may be adopted, if at the time of adoption they were not used to designate the same or similar articles of production.”<sup>7</sup>

<sup>1</sup>Browne on Trade-marks (2d ed.), sec. 134.

<sup>2</sup>Canal Co. vs. Clark, 13 Wall. 311-322; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-548.

<sup>3</sup>Daniels, J., in Newman v. Alvord, 49 Barb. 538; Cox, 404.

<sup>4</sup>Ex parte Henderson, 85 Off. Gaz. 453.

<sup>5</sup>Ex parte Stuhmer, 86 Off. Gaz. 131.

<sup>6</sup>Osgood v. Allen, 1 Holmes, 185.

<sup>7</sup>Osgood v. Allen, *supra*.

While the following is an extract from a judicial argument delivered by a court in a futile attempt to justify its decree sustaining as a trade-mark a geographical word to which the plaintiff had no color of exclusive right, it is still a lucid exposition of the principle under consideration: "Words and names having a known or established signification cannot within the limits of such specification be exclusively appropriated to the advancement of the business purposes of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that on account of their general or popular use every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any one person, firm or company. What alike may be claimed and used by all cannot be exclusively appropriated to advance the interests of any person. Numerous cases have been before the courts in which this limitation upon the use of words and names as trade-marks has been maintained and established, and no good reason can be given for questioning or impeaching their conclusions. But while this limitation is entirely reasonable, there can be no propriety in extending it beyond the circumstance upon which it is founded; and accordingly any member of the community whose interests and business may be promoted by doing so, should be at liberty to apply even names and words in common use to the products of his industry, in such a manner as to indicate their origin or particular manufacture, where such application will not intrench upon and be in no way included in their use by the public. By doing so, the rights of no member of the community can be in any manner infringed, and no public inconvenience whatever can be occasioned by it. The public will still be left at full liberty to use such words or terms as they were used before; while for a special purpose a new office or purpose may be imposed upon them.

"In cases of that description no greater inconvenience or embarrassment can be found in protecting parties in

the enjoyment of the new use or purpose engrafted upon a popular term than has been found in extending that protection to the case of a word created for the occasion."<sup>1</sup>

§ 33. **Illustrations of generic terms.**—In the following instances the words and marks mentioned have been held to be invalid as trade-marks because generic; being geographical or descriptive. The examples are arranged in alphabetical order for convenient reference.

"A. C. A.," cloth;<sup>2</sup> "Acid Phosphate," medicinal preparation;<sup>3</sup> "Allcock's Porous Plasters," medicated plasters;<sup>4</sup> "Ammoniated Bone Superphosphate of Lime," fertilizer;<sup>5</sup> "Anglo-Portugo," oysters;<sup>6</sup> "Angostura," bit-  
ters;<sup>7</sup> "American," sardines;<sup>8</sup> "Antiquarian," book-store;<sup>9</sup> "Apple and Honey," medicine;<sup>10</sup> "Astral," oil.<sup>11</sup>

"Balm of Thousand Flowers," cosmetic;<sup>12</sup> "Barber's Model," razors;<sup>13</sup> "Bazaar," patterns for clothing;<sup>14</sup> "Better Than Mother's," mince meat;<sup>15</sup> "Black Package," tea;<sup>16</sup> "Book," the device of a book, used by a publisher;<sup>17</sup> "Borax," soap;<sup>18</sup> "Braided Fixed Stars," cigar lights.<sup>19</sup>

"Cachemire Milano," fabric;<sup>20</sup> "California Syrup of

<sup>1</sup>Newman v. Alvord, 49 Barb. 588.

<sup>2</sup>Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51.

<sup>3</sup>Rumford Chem. Works v. Muth, 35 Fed. Rep. 524.

<sup>4</sup>Re Brandreth, L. R. 9 Ch. D. 618.

<sup>5</sup>Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115.

<sup>6</sup>Re Saunion & Co., Seb. 625; Cox, Manual, 625.

<sup>7</sup>Siegert v. Findlater, L. R. 7 Ch. D. 801; Siegert v. Abbott (2), 79 N. Y. Sup. Ct. 243.

<sup>8</sup>Re American Sardine Co., 3 Off. Gaz. 495.

<sup>9</sup>Choynski v. Cohen, 39 Cal. 501.

<sup>10</sup>Ex parte G. F. Heublein & Bro., 87 Off. Gaz. 179.

<sup>11</sup>Pratt's Mfg. Co. v. Astral Refining Co., 27 Fed. Rep. 492-494.

<sup>12</sup>Petridge v. Wells, Cox, Am. Tr. Cas. 180.

<sup>13</sup>Ex parte Krusius Bros., 82 Off. Gaz. 1687.

<sup>14</sup>McCall v. Theal, 23 Grant (Up. Can.) Ch. 48.

<sup>15</sup>Ex parte Ervin A. Rice Co., 83 Off. Gaz. 1207.

<sup>16</sup>Fischer v. Blank, 138 N. Y. 244.

<sup>17</sup>Merriam v. Famous Shoe & Clothing Co., 47 Fed. Rep. 411.

<sup>18</sup>Dreydoppel v. Young, 14 Phila. 226.

<sup>19</sup>Re Palmer, L. R. 24 Ch. D. 504.

<sup>20</sup>Re Warburg, 13 Off. Gaz. 44.



Figs," laxative medicine;<sup>1</sup> "Castoria," medicine;<sup>2</sup> "Celebrated Stomach Bitters," bitters;<sup>3</sup> "Cellular," cloth of cellular construction;<sup>4</sup> "Cherry Pectoral," medicine;<sup>5</sup> "Chill Stop," medicine;<sup>6</sup> "Chlorodyne," medicinal compound;<sup>7</sup> "Club House," gin;<sup>8</sup> "Continental," sought to be protected from infringement as the name of a fire insurance corporation;<sup>9</sup> "Cough Remedy," cough medicine;<sup>10</sup> "Crack Proof," rubber;<sup>11</sup> "Cramp Cure," medicine;<sup>12</sup> "Cresylic," ointment;<sup>13</sup> "Croup Tincture," medicine;<sup>14</sup> "Crystallized Egg," for a preparation of eggmeat;<sup>15</sup> "Cylinder," glass products.<sup>16</sup>

"Desiccated," codfish;<sup>17</sup> "Druggists' Sundries," cigars;<sup>18</sup> "Dry Monopole," champagne;<sup>19</sup> "Durham," tobacco.<sup>20</sup>

"Egg," macaroni;<sup>21</sup> "Elgin," watches;<sup>22</sup> "Emolli-

<sup>1</sup>California Fig Syrup Co. v. Putnam, 66 Fed. Rep. 50; California Fig Syrup Co. v. Stearns, 67 Fed. Rep. 1008; s. c. on appeal, 73 Fed. Rep. 812; Re California Fig Syrup Co., L. R. 40 Ch. D. 620. *Contra*, see California Fig Syrup Co. v. Improved Fig Syrup Co., 51 Fed. Rep. 296; Improved Fig Syrup Co. v. California Fig Syrup Co., 54 Fed. Rep. 175; California Fig Syrup Co. v. Worden, 86 Fed. Rep. 212; s. c., 95 Fed. Rep. 132.

<sup>2</sup>Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 91 Fed. Rep. 891; Centaur Co. v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901.

<sup>3</sup>Hostetter v. Adams, 20 Blatchf. 326.

<sup>4</sup>Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

<sup>5</sup>Ayer v. Rushton, 7 Daly, 9.

<sup>6</sup>Ex parte Hance Bros. & White, 87 Off. Gaz. 698.

<sup>7</sup>Browne v. Freeman (1), 12 W. R. 305; Seb. 230; Cox, Manual, 230; Browne v. Freeman (2), Seb. 424; Cox, Manual, 424.

<sup>8</sup>Corwin v. Daly, 7 Bos. 222.

<sup>9</sup>Continental Ins. Co. v. Continental Fire Ass'n, 96 Fed. Rep. 846.

<sup>10</sup>Gilman v. Hunnewell, 122 Mass. 139.

<sup>11</sup>Re Goodyear Rubber Co., 11 Off. Gaz. 1062.

<sup>12</sup>L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624.

<sup>13</sup>Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625.

<sup>14</sup>Re Roach, 10 Off. Gaz. 333.

<sup>15</sup>Lamont v. Leedy, 88 Fed. Rep. 72.

<sup>16</sup>Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

<sup>17</sup>Town v. Stetson, 4 Abb. Pr. N. S. 218; 3 Daly, 53; Cox, Am. Tr. Cas. 514.

<sup>18</sup>Ex parte Cohn (2), 16 Off. Gaz. 680.

<sup>19</sup>Richards v. Butcher, L. R. (1891) 2 Ch. 522.

<sup>20</sup>Blackwell v. Wright, 73 N. C. 310.

<sup>21</sup>Re Dole Bros., 12 Off. Gaz. 939.

<sup>22</sup>Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667; reversing s. c., 89 Fed. Rep. 487.

orum," waterproof dressing for leather;<sup>1</sup> "Encyclopedia Britannica," title of an encyclopedia;<sup>2</sup> "Evaporated," food products;<sup>3</sup> "Ever Ready," coffee mills;<sup>4</sup> "Extract of Night-Blooming Cereus," perfume.<sup>5</sup>

"Fairbank's Patent," scales;<sup>6</sup> "Famous," stoves;<sup>7</sup> "Ferro-phosphorated Elixir of Calisaya Bark," medicine;<sup>8</sup> "Fire-proof," oil;<sup>9</sup> "French," paints;<sup>10</sup> "Fruit," vinegar.<sup>11</sup>

"Galen," manufactured glass;<sup>12</sup> "Gibraltar," lamp chimneys;<sup>13</sup> "Glendon," iron;<sup>14</sup> "Golden," ointment;<sup>15</sup> "Gold Label," bread;<sup>16</sup> "Gold Medal," saleratus;<sup>17</sup> "Good-year Rubber Co.," as name for rubber manufacturing house;<sup>18</sup> "Granite," enameled kitchen utensils;<sup>19</sup> "Granolithic," artificial stone;<sup>20</sup> "Granulated Dirt-Killer," soap;<sup>21</sup> "Greatest value for the money," shoes;<sup>22</sup> "Green Mountain," grapes;<sup>23</sup> "Guaranteed," corset;<sup>24</sup> "Guenther's Best," flour;<sup>25</sup> "Gyrator," bolting machines.<sup>26</sup>

<sup>1</sup> *Re Talbot*, 8 R. P. C. 149.

<sup>2</sup> *Black v. Ehrich*, 44 Fed. Rep. 793.

<sup>3</sup> *Re Alden*, 15 Off. Gaz. 389.

<sup>4</sup> *Ex parte Bronson Co.*, 87 Off. Gaz. 1782.

<sup>5</sup> *Phalon v. Wright*, 5 Phila. 464; *Cox*, Manual, 232.

<sup>6</sup> *Fairbanks v. Jacobus*, 14 Blatch. 337.

<sup>7</sup> *Ex parte Brand Stove Co.*, 62 Off. Gaz. 588.

<sup>8</sup> *Caswell v. Davis*, 58 N. Y. 223; 17 Amer. Rep. 233.

<sup>9</sup> *Scott v. Standard Oil Co.*, 106 Ala. 475; 31 L. R. A. 374; 19 So. Rep. 71.

<sup>10</sup> *Ex parte Marsching & Co.*, 15 Off. Gaz. 294.

<sup>11</sup> *Alden v. Gross*, 25 Mo. App. 123.

<sup>12</sup> *Stokes v. Landgraff*, 17 Barb. 608; *Cox*, Am. Tr. Cas. 137.

<sup>13</sup> *Ex parte Nave & McCord Merc. Co.*, 86 Off. Gaz. 1985.

<sup>14</sup> *Glendon Iron Co. v. Uhler*, 75 Pa. St. 467; 15 Amer. Rep. 599.

<sup>15</sup> *Green v. Rooke*, W. N. 1872, p. 49.

<sup>16</sup> *Ex parte Stuhmer*, 86 Off. Gaz. 181.

<sup>17</sup> *Taylor v. Gillies*, 59 N. Y. 331.

<sup>18</sup> *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598; reversing s. c., 21 Fed. Rep. 276.

<sup>19</sup> *St. Louis Stamping Co. v. Piper*, 33 N. Y. Supp. 443.

<sup>20</sup> *Stuart & Co. v. Scottish Val de Travers Paving Co.*, Ct. Sess. Cas. (4th ser.) 13, 1.

<sup>21</sup> *Ex parte Waeflerling*, 16 Off. Gaz. 764.

<sup>22</sup> *Ex parte Parker*, Holmes & Co., 85 Off. Gaz. 287.

<sup>23</sup> *Hoyt v. J. T. Lovett Co.*, 71 Fed. Rep. 173; 17 C. C. A. 652; 31 L. R. A. 44; 39 U. S. App. 1.

<sup>24</sup> *Symington v. Footman*, 56 L. T. N. S. 696.

<sup>25</sup> *Ex parte Guenther Milling Co.*, 86 Off. Gaz. 1936.

<sup>26</sup> *Ex parte Wolf*, 80 Off. Gaz. 1271.

"Hand Grenade," fire extinguisher;<sup>1</sup> "Hamburg," tea;<sup>2</sup> "Harvey's Sauce," condiment;<sup>3</sup> "Headache Wafers," medicinal compound;<sup>4</sup> "Health Food," cereal products and prepared foods;<sup>5</sup> "Health Preserving," corsets;<sup>6</sup> "Highly Concentrated Compound Fluid Extract of Buchu," medicine;<sup>7</sup> "Holbrook's," school apparatus;<sup>8</sup> "Homœopathic Medicines," description of articles so called;<sup>9</sup> "Hydro-Bromo Soda Mint," medicine;<sup>10</sup> "Hygienic," underwear.<sup>11</sup>

"Imperial," beer;<sup>12</sup> "Indurated Fibre," wood-pulp products;<sup>13</sup> "Instantaneous," tapioca prepared for speedy cooking;<sup>14</sup> "International Banking Co.," as name of banking concern;<sup>15</sup> "Iron Bitters," bitters containing iron;<sup>16</sup> "Ironstone," water pipe.<sup>17</sup>

"Johnson's American Anodyne," liniment;<sup>18</sup> "Julienne," soup.<sup>19</sup>

"Kaiser," beer;<sup>20</sup> "Kid Nee Kure," medicine;<sup>21</sup> "Kidney & Liver," bitters.<sup>22</sup>

<sup>1</sup> Re Harden Fire Extinguisher Co.'s Trade-mark, 55 L.J. Ch. 596.

<sup>2</sup> Frese v. Bachof, 14 Blatchf. 432.

<sup>3</sup> Lazenburg v. White, 41 L. J. Ch. 354.

<sup>4</sup> Gessler v. Grieb, 80 Wis. 21; 27 Am. St. Rep. 20.

<sup>5</sup> Fuller v. Huff, 99 Fed. Rep. 439.

<sup>6</sup> Ball v. Siegel, 166 Ill. 137.

<sup>7</sup> Helmbold v. Helmbold Mfg. Co., 53 How. Pr. 453.

<sup>8</sup> Sherwood v. Andrews, 3 Am. Law Reg. N. S. 588.

<sup>9</sup> Humphrey's Spec. Homœopathic Med. Co. v. Wenz, 14 Fed. Rep. 250.

<sup>10</sup> Ex parte Spayd, 86 Off. Gaz. 631.

<sup>11</sup> Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 Fed. Rep. 622; s. c., 65 Fed. Rep. 424.

<sup>12</sup> Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405; 74 Fed. Rep. 229.

<sup>13</sup> Industrial Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 Fed. Rep. 695.

<sup>14</sup> Bennet v. McKinley, 65 Fed. Rep. 505; 13 C. C. A. 25.

<sup>15</sup> Kohler v. Sanders, 122 N. Y. 65; affirming s. c., 48 Hun, 48.

<sup>16</sup> Brown Chem. Co. v. Stearns, 37 Fed. Rep. 360; Brown Chem. Co. v. Meyer, 139 U. S. 591; Cox, Manual, 726.

<sup>17</sup> Re Rader, 13 Off. Gaz. 596.

<sup>18</sup> Re Johnson, 2 Off. Gaz. 315.

<sup>19</sup> Godillot v. Hazard, 81 N. Y. 263.

<sup>20</sup> Luyties v. Hollender, 30 Fed. Rep. 632. *Per contra*, see Kaiserbrauerei v. Baltz Brewing Co., 11 Fed. Rep. 695.

<sup>21</sup> Ex parte Henderson, 85 Off. Gaz. 453.

<sup>22</sup> Spieker v. Lash, 102 Cal. 38; 36 Pac. Rep. 362.

"Lackawanna," coal;<sup>1</sup> "Lake," glass product;<sup>2</sup> "La Normandie," cigars;<sup>3</sup> "Liebig's Extract of Meat," meat extract made under Liebig's formula;<sup>4</sup> "Lieutenant James' Horse Blister," ointment;<sup>5</sup> "Linoleum," floor-cloth;<sup>6</sup> "Loch Katrine," whisky.<sup>7</sup>

"Magnolia," alloy metal;<sup>8</sup> "Malted Milk," infants' food;<sup>9</sup> "Marshall's Celebrated," liniment;<sup>10</sup> "Maryland Club Rye," whisky;<sup>11</sup> "Masonic," cigars;<sup>12</sup> "Matzoon," fermented milk;<sup>13</sup> "Medicated Prunes," medicine;<sup>14</sup> "Metallic Clinton," paint;<sup>15</sup> "Microbe Killer," antiseptic;<sup>16</sup> "Moline," plows;<sup>17</sup> "Montserrat," lime juice.<sup>18</sup>

"National Sperm," candles;<sup>19</sup> "Native Guano," fertilizer;<sup>20</sup> "New Manny," harvester;<sup>21</sup> "New York," glass products;<sup>22</sup> "Nourishing London," stout.<sup>23</sup>

<sup>1</sup> Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311.

<sup>2</sup> Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

<sup>3</sup> Stachelberg v. Ponce, 128 U. S. 686.

<sup>4</sup> Liebig's Extract of Meat Co. (Ltd.) v. Hanbury, 17 L. T. N. S. 298; Anderson v. Liebig's Extract of Meat Co. (Ltd.), 45 L. T. 757; Cartmell, 47.

<sup>5</sup> James v. James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388.

<sup>6</sup> Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

<sup>7</sup> Bulloch, Lade & Co. v. Gray, 19 Jour. Juris. 218; Seb. 452.

<sup>8</sup> Magnolia Metal Co.'s Trade-marks, 66 L. J. Ch. N. S. 312.

<sup>9</sup> Ex parte Horlick's Food Co., 84 Off. Gaz. 1870.

<sup>10</sup> Marshall v. Pinkham, 52 Wis. 572.

<sup>11</sup> Cahn v. Hoffman House, 28 N.Y. Supp. 388. *Contra*, see Cahn v. Gottschalk, 2 N. Y. Supp. 13.

<sup>12</sup> Ex parte Smith (3), 16 Off. Gaz. 764.

<sup>13</sup> Dadirrian v. Yacubian, 72 Fed. Rep. 1010; Dadirrian v. Yacubian (2), 90 Fed. Rep. 812.

<sup>14</sup> Ex parte Smith (2), 16 Off. Gaz. 679.

<sup>15</sup> Clinton Metallic Paint Co. v. New York Metallic Paint Co., 50 N. Y. Supp. 437.

<sup>16</sup> Alff v. Radam, 77 Tex. 530.

<sup>17</sup> Candee, Swan & Deere v. Deere & Co., 54 Ill. 439; 5 Amer. Rep. 125.

<sup>18</sup> Evans v. Von Laer, 32 Fed. Rep. 153.

<sup>19</sup> Re Price's Patent Candle Co., L. R. 27 Ch. D. 681.

<sup>20</sup> Native Guano Co. v. Sewage Manure Co., 8 P. R. 125.

<sup>21</sup> Re Graham, 2 Off. Gaz. 618.

<sup>22</sup> Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

<sup>23</sup> Raggett v. Findlater, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. N. S. 448; 22 W. R. 53; Seb. 431.

"Old Bourbon," whisky;<sup>1</sup> "Old Innishowen," whisky;<sup>2</sup> "Old London Dock," gin;<sup>3</sup> "Olive," bicycles having olive-colored frames.<sup>4</sup>

"Paraffin," oil;<sup>5</sup> "Parson's Purgative," pills;<sup>6</sup> "Perfect Face Paste," medicine;<sup>7</sup> "Philadelphia," beer;<sup>8</sup> "Pocahontas," coal;<sup>9</sup> "Post Office," directory;<sup>10</sup> "Porous," medicinal plasters;<sup>11</sup> "Prime Leaf," lard;<sup>12</sup> "Prize Medal, 1862," on goods sold by one awarded a medal at the London International Exhibition of 1862;<sup>13</sup> "Purity," oleomargarine.<sup>14</sup>

"Red," snuff;<sup>15</sup> "Richardson's Patent Union," leather splitting machine;<sup>16</sup> "Rose," vanilla extract;<sup>17</sup> "Rosedale," cement;<sup>18</sup> "Rye and Rock," liquor.<sup>19</sup>

"Safety," explosive powder;<sup>20</sup> "Sanitary," filter;<sup>21</sup> "Sarsaparilla and Iron," tonic;<sup>22</sup> "Satinine," starch and

<sup>1</sup>Hardy v. Cutter, 3 Off. Gaz. 468.

<sup>2</sup>Watt v. O'Hanlon, 4 P. R. 1.

<sup>3</sup>Binninger v. Wattles, 28 How. Pr. 206.

<sup>4</sup>Ex parte Olive Wheel Co., 84 Off. Gaz. 1871.

<sup>5</sup>Young v. Macrae, 9 Jur. N. S. 322.

<sup>6</sup>Re Johnson, 2 Off. Gaz. 315.

<sup>7</sup>Ex parte Rall, 85 Off. Gaz. 453.

<sup>8</sup>Eggers v. Hink, 63 Cal. 445.

<sup>9</sup>Coffman v. Castner, 87 Fed. Rep. 457. *Contra*, Atwater v. Castner, 88 Fed. Rep. 642.

<sup>10</sup>Kelly v. Byles, 40 L. T. 623.

<sup>11</sup>Re Brandreth, Seb. 626.

<sup>12</sup>Popham v. Wilcox, 66 N. Y. 69.

<sup>13</sup>Batty v. Hill, 1 H. & M. 264; 8 L. T. N. S. 791; 11 W. R. 745; 2 N. R. 265; Seb. 218.

<sup>14</sup>Ex parte Capitol City Dairy Co., 83 Off. Gaz. 295.

<sup>15</sup>Ex parte Pearson Tobacco Co., 85 Off. Gaz. 287.

<sup>16</sup>Re Richardson, 3 Off. Gaz. 120.

<sup>17</sup>Clotworthy v. Schepp, 42 Fed. Rep. 62.

<sup>18</sup>New York Cement Co. v. Coplay Cement Co. (1), 44 Fed. Rep. 277; New York Cement Co. v. Coplay Cement Co. (2), 45 Fed. Rep. 212.

<sup>19</sup>Van Beil v. Prescott, 82 N. Y. 630.

<sup>20</sup>Ex parte Safety Powder Co., 16 Off. Gaz. 136.

<sup>21</sup>Re Atkins Filter Co., 3 P. R. 164.

<sup>22</sup>Schmidt v. Brieg, 100 Cal. 672; Same v. McEwen, 35 Pac. Rep. 854; Same v. Crystal Soda Water Co., Id. 855; Same v. Steinke, Id. 855; Same v. Haake, Id. 855; Same v. Liberty Soda Works Co., Id. 856.

soap;<sup>1</sup> "Satin Polish," boots and shoes;<sup>2</sup> "Schiedam Schnapps," liquor;<sup>3</sup> "Selected Shore," mackerel;<sup>4</sup> "Singer," sewing machines, after expiration of the Singer patents;<sup>5</sup> "Snowflake," crackers, the word being descriptive of the quality of flour used;<sup>6</sup> "Somatose," meat extract, from the Greek "*soma*," *Angl.* "body," genitive "somatos;"<sup>7</sup> "Splendid," flour;<sup>8</sup> "Standard A," cigars;<sup>9</sup> "Steel Shod," shoes having soles quilted with steel wire;<sup>10</sup> "Straight-Cut," cigarettes;<sup>11</sup> "Svenska Snusmaganiset," meaning Swedish snuff store;<sup>12</sup> "Sweet Lotus," tobacco;<sup>13</sup> "Swing," scythe-sockets.<sup>14</sup>

"Taffy Tolu," chewing gum;<sup>15</sup> "Tasteless," drugs;<sup>16</sup> "Thomsonian," medicines;<sup>17</sup> "Timekeeper," watches;<sup>18</sup> "Tycoon," tea;<sup>19</sup> "Tucker Spring," bed.<sup>20</sup>

"United States," dental rooms.<sup>21</sup>

"Valvolene," oil;<sup>22</sup> "V-O," medicine;<sup>23</sup> "Vitae-Ore," medicine;<sup>24</sup> "Victoria," lozenges.<sup>25</sup>

<sup>1</sup> Re Meyerstein, 7 R. P. C. 114; L. R. 43 Ch. D. 604; 59 L. J. Ch. 401; 62 L. T. 526; 38 W. R. 440; Cartmell, 225.

<sup>2</sup> Ex parte Brigham, 20 Off. Gaz. 891.

<sup>3</sup> Wolfe v. Goulard, 18 How. Pr. 64; Seb. 179; Cox, Am. Tr. Cas. 226; Burke v. Cassin, 45 Cal. 467; Wolfe v. Hart, 4 V. L. R. Eq. 125; Wolfe v. Alsop, 10 V. L. R. Eq. 41; 12 V. L. R. 421; Wolfe v. Lang, 13 V. L. R. 752.

<sup>4</sup> Trask Fish Co. v. Wooster, 28 Mo. App. 408.

<sup>5</sup> Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169.

<sup>6</sup> Larrabee v. Lewis, 67 Ga. 561; 44 Am. Rep. 735.

<sup>7</sup> Farben-fabriken T. M. K., 7 R. P. C. 439; L. R. (1894) 1 Ch. 645.

<sup>8</sup> Ex parte Stokes, 64 Off. Gaz. 437.

<sup>9</sup> Ex parte Cohn (1), 16 Off. Gaz. 680.

<sup>10</sup> Brennan v. Emery-Bird Thayer Dry Goods Co., 99 Fed. Rep. 971.

<sup>11</sup> Ginter v. Kinney, 12 Fed. Rep. 782.

<sup>12</sup> Bolander v. Peterson, 136 Ill. 215.

<sup>13</sup> Wellman & Dwire Tob. Co. v. Ware Tob. Works, 46 Fed. Rep. 289.

<sup>14</sup> Ex parte Thompson, Derby & Co., 16 Off. Gaz. 137.

<sup>15</sup> Colgan v. Danheiser, 35 Fed. Rep. 150.

<sup>16</sup> Re Dick & Co., 9 Off. Gaz. 538.

<sup>17</sup> Thomson v. Winchester, 36 Mass. 214.

<sup>18</sup> Ex parte Strasburger & Co., 20 Off. Gaz. 155.

<sup>19</sup> Corbin v. Gould, 133 U. S. 308.

<sup>20</sup> Tucker Mfg. Co. v. Boyington, 9 Off. Gaz. 455.

<sup>21</sup> Cady v. Schultz, 19 R. I. 193; 61 Am. St. Rep. 763.

<sup>22</sup> Re Horsburgh, 53 L. J. Ch. 237.

<sup>23</sup> Noel v. Ellis, 89 Fed. Rep. 978-981.

<sup>24</sup> Noel v. Ellis, *supra*.

<sup>25</sup> Witherspoon v. Gray, Ct. Sess. Cas. (3d ser.) 2, 38.

"Water of Ayr," stone;<sup>1</sup> "Webster's Dictionary," applied to the standard lexicon of that name;<sup>2</sup> "Wister's Balsam of White Cherry," medicine;<sup>3</sup> "Worcestershire," sauce;<sup>4</sup> "Yale," locks;<sup>5</sup> "Yucatan," leather and leather goods.<sup>6</sup>

§ 34. **Examples of valid trade-marks, fancy, arbitrary or distinctive words.**—The following instances are illustrative of fancy, arbitrary or distinctive words, which have either been held proper, protected against unfair competition, or their use upheld as trade-marks in application to the classes of merchandise in connection with which the words have respectively been used. In some cases the question of validity was not raised, nor are all of them to be upheld as technical trade-marks. These illustrations are given in their alphabetical order to facilitate reference.

"Ainsworth," thread;<sup>7</sup> "Alderney," oleomargarine;<sup>8</sup> "American Cold Japan," paint;<sup>9</sup> "American Express," sealing wax;<sup>10</sup> "American Volunteer," shoes;<sup>11</sup> "Anatolia," licorice;<sup>12</sup> "A. N. Hoxie's Mineral," soap;<sup>13</sup> "Anchor Brand," wire;<sup>14</sup> "Annihilator," medicine;<sup>15</sup> "Anti-Wash-

<sup>1</sup>Montgomery v. Donald, Ct. Sess. Cas. (4th ser.) 11, 506.

<sup>2</sup>Merriam v. Texas Siftings Pub. Co., 49 Fed. Rep. 944-947.

<sup>3</sup>Towle v. Spear, 7 Penn. L. J. 176; Cox, Am. Tr. Cas. 67; Seb. 90.

<sup>4</sup>Lea v. Deakin, 11 Biss. 23; Lea v. Wolff, 15 Abb. Pr. N. S. 1; 46 How. Pr. 157; Seb. 407; Lea v. Millar, Seton (4th ed.), 242; Seb. 513.

<sup>5</sup>Ex parte Yale & Towne Mfg. Co., 81 Off. Gaz. 801.

<sup>6</sup>Ex parte Weil, 83 Off. Gaz. 1802.

<sup>7</sup>Ainsworth v. Walmesley, 44 L. R. 1 Eq. 518.

<sup>8</sup>Lauferty v. Wheeler, 11 Abb. N. C. 220; 11 Daly, 194; 63 How. Pr. 488.

<sup>9</sup>Reeder v. Brodt, 6 Ohio Dec. 248; 4 Ohio N. P. 265.

<sup>10</sup>Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-653.

<sup>11</sup>Joseph Banigan Rubber Co. v. Bloomingdale, 89 Off. Gaz. 1670.

<sup>12</sup>McAndrews v. Bassett, 4 DeG. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; 4 N. R. 123; Cox, 669. Anatolia is a geographical name, but its use here was protected on the theory of unfair competition.

<sup>13</sup>Hoxie v. Chaney, 143 Mass. 592.

<sup>14</sup>Edelsten v. Edelsten, 1 DeG. J. & S. 185; Cox, 667.

<sup>15</sup>Re N. Jenkins, Cert. No. 746; Fulton v. Sellers, 4 Brewst. 42.

board," soap;<sup>1</sup> "Apollinaris," mineral water;<sup>2</sup> "Arctic," soda apparatus.<sup>3</sup>

"Baco-Curo," remedy for tobacco habit;<sup>4</sup> "B. B. B.," medicine;<sup>5</sup> "B. B. H." with a crown, iron;<sup>6</sup> "Baffle," safes;<sup>7</sup> "Balm of Thousand Flowers," cosmetic;<sup>8</sup> "Beatty's Headline," copy book;<sup>9</sup> "Bell of Moscow," wine;<sup>10</sup> "Benedictine," liqueur;<sup>11</sup> "Bethesda," mineral water;<sup>12</sup> "Bismarck," paper collars;<sup>13</sup> "Blackstone," cigars;<sup>14</sup> "Blood Searcher," medicine;<sup>15</sup> "Blue Lick," water;<sup>16</sup> "Boker's Stomach Bitters," medicine;<sup>17</sup> "Bovilene," po-made;<sup>18</sup> "Bovril," meat extract;<sup>19</sup> "Bromidia," medicine;<sup>20</sup> "Bromo-Caffeine," medicine;<sup>21</sup> "Brown Dick," tobacco.<sup>22</sup>

<sup>1</sup>O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576.

<sup>2</sup>Apollinaris Co. v. Norrish, 33 L. T. N. S. 242; Same v. Edwards, Seton (4th ed.), 237; Same v. Moore, Cox, Manual, Case No. 675; Same v. Herrfeldt, 4 P. R. 478; Same v. Scherer, 27 Fed. Rep. 18.

<sup>3</sup>Re James W. Tufts, Cert. No. 678.

<sup>4</sup>Sterling Remedy Co. v. Eureka Chemical and Mfg. Co., 80 Fed. Rep. 105; 49 U. S. App. 709; 25 C. C. A. 314.

<sup>5</sup>Foster v. Blood Balm Co. (Ga.), 3 S. E. Rep. 284.

<sup>6</sup>Hall v. Barrows, 4 DeG. J. & S. 150; Cox, 668.

<sup>7</sup>Talbot v. Webley, 3 R. P. C. 276; Cartmell, 324.

<sup>8</sup>Fetridge v. Merchant, 4 Abb. Pr. 156.

<sup>9</sup>Gage v. Canada Publ. Co., 11 Can. Sup. Ct. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

<sup>10</sup>Re Charles Narcisse Ferre, Cert. No. 8939.

<sup>11</sup>Société Anonyme v. Western Distilling Co., 43 Fed. Rep. 416.

<sup>12</sup>Dunbar v. Glenn, 42 Wis. 118; Seb. 529.

<sup>13</sup>Messerole v. Tynberg, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; Seb. 300.

<sup>14</sup>Levy v. Waitt, 56 Fed. Rep. 1016.

<sup>15</sup>Fulton v. Sellers, 4 Brewst. 42; Cox, Manual, Case No. 279.

<sup>16</sup>Northcutt v. Turney, 101 Ky. 314; 41 S.W. Rep. 21; Parkland Hill Blue Lick Water Co. v. Hawkins (Ky.), 26 S. W. Rep. 389; 95 Ky. 502; 16 Ky. Law Rep. 210; 44 Am. St. Rep. 254.

<sup>17</sup>Funke v. Dreyfus, 34 La. Ann. 80; 44 Am. Rep. 413.

<sup>18</sup>Lockwood v. Bostwick, 2 Daly, 521.

<sup>19</sup>Re Bovril, L. R. (1896) 2 Ch. D. 600.

<sup>20</sup>Battle v. Finlay (2), 50 Fed. Rep. 106; Battle v. Finlay (1), 45 Fed. Rep. 796.

<sup>21</sup>Keasbey v. Brooklyn Chemical Works, 37 N. E. Rep. 476; 142 N. Y. 467; reversing s. c., 21 N. Y. Supp. 696.

<sup>22</sup>J. W. Carroll, Cert. No. 157.



"Cashmere Bouquet," toilet soap;<sup>1</sup> "Celluloid," compound of pyroxyline;<sup>2</sup> "Centennial," clothing;<sup>3</sup> or alcoholic spirits;<sup>4</sup> "Champion," flour;<sup>5</sup> "Charley's Aunt," name of farce;<sup>6</sup> "Charter Oak," stoves;<sup>7</sup> "Chatterbox," juvenile books, published periodically;<sup>8</sup> "Chicago Waists," corset waists;<sup>9</sup> "Chicken Cock," whisky;<sup>10</sup> "Chinese Liniment;"<sup>11</sup> "Climax," stoves;<sup>12</sup> "Club Soda," carbonated water;<sup>13</sup> "Coal Oil Johnny's Petroleum," soap;<sup>14</sup> "Cocoaine," hair oil;<sup>15</sup> "Compactum," umbrellas;<sup>16</sup> "Congress Water," mineral water;<sup>17</sup> "Cottolene," lard substitute;<sup>18</sup> "Cough Cherries," confectionery;<sup>19</sup> "Cream," baking powder;<sup>20</sup> "Crystal," castor oil;<sup>21</sup> "Cuticura," toilet soap.<sup>22</sup>

"Damascus Blade," scythes;<sup>23</sup> "Daniel," bridle bits

<sup>1</sup> Colgate & Co., Cert. No. 914; Colgate v. Adams, 88 Fed. Rep. 899.

<sup>2</sup> Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

<sup>3</sup> Sternberger v. Thalheimer, 3 Off. Gaz. 120.

<sup>4</sup> Re Bush & Co., 10 Off. Gaz. 164.

<sup>5</sup> Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; 27 Off. Gaz. 1322.

<sup>6</sup> Frohman v. Miller, 29 N. Y. S. 1109; 8 Misc. Rep. 379.

<sup>7</sup> Filley v. Fassett, 44 Mo. 173; 100 Am. Dec. 275; Cox, Am. Tr. Cas. 530; 9 Am. L. Reg. N. S. 402; Seb. 313; Filley v. Child, 16 Blatchf. 376.

<sup>8</sup> Estes v. Leslie, 29 Fed. Rep. 91; Estes v. Worthington, 31 Fed. Rep. 154; Estes v. Leslie, 27 Fed. Rep. 22.

<sup>9</sup> Gage-Downs Co. v. Featherbone Corset Co., 83 Fed. Rep. 213.

<sup>10</sup> G. G. White Co. v. Miller, 50 Fed. Rep. 277.

<sup>11</sup> Coffeen v. Brunton, 4 McLean, 516; 5 McLean, 256.

<sup>12</sup> Filley v. Fassett, 44 Mo. 173.

<sup>13</sup> Cochrane v. Macnish, (P. C.) L. R. (1896) A. C. 225; 65 L. J. P. C. N. S. 20; 74 Law T. R. 109.

<sup>14</sup> Petrolia Mfg. Co. v. Bell & Bogart Soap Co., 97 Fed. Rep. 781.

<sup>15</sup> Burnett v. Phalon, 3 Keyes. 594; 5 Abb. Pr. N. S. 212.

<sup>16</sup> Re Davis Trade-marks, 22 Trade-mark Record, 50.

<sup>17</sup> Congress, etc. Spring Co. v. High Rock Congress Spring Co., 57 Barb. 526; Cox, 599; 45 N. Y. 291; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 4 Am. L. T. 168; Cox, Am. T. R. Cas. 624; Seb. 354.

<sup>18</sup> N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

<sup>19</sup> Stoughton v. Woodard, 39 Fed. Rep. 902.

<sup>20</sup> Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799.

<sup>21</sup> H. J. Baker & Bro., Cert. No. 373.

<sup>22</sup> Potter Drug & Chem. Co. v. Miller, 75 Fed. Rep. 656. Held infringed by word "curative" and imitative devices.

<sup>23</sup> Dunn Edge Tool Co., Cert. No. 563.

and stirrups;<sup>1</sup> "Daylight," oil;<sup>2</sup> "Deer Tongue," tobacco;<sup>3</sup> "Derringer," fire-arms;<sup>4</sup> "Diamond," soap;<sup>5</sup> "Dolly Varden," stationery;<sup>6</sup> "Dr. Lobenthal's Essentia Antiphthisica," medicine;<sup>7</sup> "Dublin," soap;<sup>8</sup> "Durham," smoking tobacco;<sup>9</sup> "Dyspepticure," medicine.<sup>10</sup>

"Edelweiss," perfume;<sup>11</sup> "Electro-Silicon," polishing preparation;<sup>12</sup> "Elk," cigars;<sup>13</sup> "Emollia," toilet cream;<sup>14</sup> "Empire," stoves;<sup>15</sup> "Epicure," canned salmon;<sup>16</sup> "Ethiopian," stockings;<sup>17</sup> "Eureka," fertilizer,<sup>18</sup> or shirts,<sup>19</sup> or steam packing;<sup>20</sup> "Everlasting," pills;<sup>21</sup> "Excelsior," stoves,<sup>22</sup> or soap.<sup>23</sup>

"Faber," pencils;<sup>24</sup> "Falstaff," cigars;<sup>25</sup> "Family,"

<sup>1</sup>Kelita Broadhurst, Cert. No.946.

<sup>2</sup>Bostwick & Tilford, Cert. No. 376.

<sup>3</sup>L. L. Armistead, Cert. No. 512.

<sup>4</sup>Derringer v. Plate, 29 Cal. 292; Cox, Am. Tr. Cas. 324.

<sup>5</sup>J. Buchan & Co., Cert. No. 924.

<sup>6</sup>Bergen & Brainbridge, Cert. No. 833.

<sup>7</sup>Re Rohland, 10 Off. Gaz. 980.

<sup>8</sup>Re Cornwall & Co., 12 Off. Gaz. 312.

<sup>9</sup>Blackwell v. Armistead, 5 Am. L. T. 85; 3 Hughes, 163; Armistead v. Blackwell, 1 Off. Gaz. 603; Blackwell v. Dibrell, 14 Off. Gaz. 633; Blackwell v. Wright, 73 N. C. 310.

<sup>10</sup>Ex parte Foley & Co., 87 Off. Gaz. 1957.

<sup>11</sup>Rosing v. Atkinson, 27 Sol. J. 534.

<sup>12</sup>Electro-Silicon Co. v. Hazard, 29 Hun, 369; 36 N. Y. Sup. Ct. 369.

<sup>13</sup>Lichtenstein v. Goldsmith, 37 Fed. Rep. 359.

<sup>14</sup>Re Grossmith, 60 L. T. N. S. 612.

<sup>15</sup>Filley v. Fassett, 44 Mo. 173; Seb. 313.

<sup>16</sup>George v. Smith, 52 Fed. Rep. 830.

<sup>17</sup>Hine v. Lart, 10 Jur. 106; 7 L. T. O. S. 41; Seb. 80.

<sup>18</sup>Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115; Seb. 364; Fed. Case No. 206.

<sup>19</sup>Ford v. Foster, L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384.

<sup>20</sup>Symonds v. Greene, 28 Fed. Rep. 834.

<sup>21</sup>Dunn & Co., Cert. No. 448.

<sup>22</sup>Filley v. Fassett, 44 Mo. 173; Seb. 313; Sheppard v. Stuart, 13 Phila. 117.

<sup>23</sup>Braham v. Bustard, 1 H. & M. 447.

<sup>24</sup>Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, Am. Tr. Cas. 401.

<sup>25</sup>David Hirsch, Cert. No. 23.

salve;<sup>1</sup> "Favorita," flour;<sup>2</sup> "Fibre Chamois," dress linings;<sup>3</sup> "Filofloss," silk;<sup>4</sup> "Filtre Rapide," filters.<sup>5</sup>

"Gaslight," oil;<sup>6</sup> "German," syrup;<sup>7</sup> "Glenfield," starch;<sup>8</sup> "Gold Dust," whisky,<sup>9</sup> or washing powder;<sup>10</sup> "Golden Crown," cigars;<sup>11</sup> "Gouraud's Oriental Cream," cosmetic;<sup>12</sup> "Grand Master," cigars;<sup>13</sup> "Green Mountain," scythe-stones;<sup>14</sup> "Grenade," syrup;<sup>15</sup> "Gulliver," cigars.<sup>16</sup>

"Hanford's Chestnut Grove," whisky;<sup>17</sup> "Hansa," lard, sausages and bacon;<sup>18</sup> "Harvest Victor," harvester;<sup>19</sup> "Heliotype," prints;<sup>20</sup> "Hero," jars;<sup>21</sup> "Home," sewing machine;<sup>22</sup> "Hoosier," drills;<sup>23</sup> "Howqua's Mixture," tea;<sup>24</sup> "Hunter," shoes;<sup>25</sup> "Hygeia," water;<sup>26</sup> "Hygieniques," suspenders.<sup>27</sup>

<sup>1</sup> Reinhardt v. Spaulding, 49 L. J. Ch. 57.

<sup>2</sup> Menendez v. Holt, 128 U. S. 182; Cox, Manual, Case No. 707.

<sup>3</sup> American Fibre Chamois Co. v. DeLee, 67 Fed. Rep. 329; 71 Off. Gaz. 1458.

<sup>4</sup> Rawlinson v. Brainard & Armstrong Co., 59 N.Y. Supp 880; 28 Misc. Rep. 287.

<sup>5</sup> Re Maignen's Application, 28 W. R. 759; Cartmell, 216.

<sup>6</sup> Bostwick & Tilford, Cert. No. 377.

<sup>7</sup> Re Green, 8 Off. Gaz. 729.

<sup>8</sup> Wotherspoon v. Currie, L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. N. S. 393.

<sup>9</sup> Barkhouse Bros. & Co., Cert. No. 626.

<sup>10</sup> N. K. Fairbank Co. v. Luckel, etc. Soap Co., 88 Fed. Rep. 694.

<sup>11</sup> Palmer v. Harris, 60 Pa. St. 156.

<sup>12</sup> Gouraud v. Trust, 10 N. Y. Sup. Ct. 627.

<sup>13</sup> Yale Cigar Mfg. Co. v. Yale, 30 Off. Gaz. 1183.

<sup>14</sup> Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

<sup>15</sup> Rillet v. Carlier, 61 Barb. 435.

<sup>16</sup> David Hirsch, Cert. No. 24.

<sup>17</sup> Hanford v. Westcott, 16 Off. Gaz. 1181.

<sup>18</sup> Ex parte Tietgens & Robertson, 87 Off. Gaz. 2117.

<sup>19</sup> Samuel B. Forbes, Cert. No. 843.

<sup>20</sup> Osgood v. Rockwood, 11 Blatch. 310.

<sup>21</sup> Rowley v. Houghton, 2 Brewst. 303.

<sup>22</sup> New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.

<sup>23</sup> Julian v. Hoosier Drill Co., 78 Ind. 408.

<sup>24</sup> Pidding v. How, 8 Sim. 477.

<sup>25</sup> Certificate 33863; 89 Off. Gaz. 2256.

<sup>26</sup> Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 63 Fed. Rep. 438; 11 C. C. A. 277.

<sup>27</sup> Bailly v. Nashawannuck Mfg. Co., 51 Off. Gaz. 970; 10 N. Y. Supp. 224.

"Ideal," fountain pens;<sup>1</sup> "Indian Pond," scythe-stones;<sup>2</sup> "Indian Root," pills;<sup>3</sup> "Insectine," insect powder;<sup>4</sup> "Insurance," oil;<sup>5</sup> "Invigorator," spring bed bottoms;<sup>6</sup> "Iron Clad," boots.<sup>7</sup>

"Kaiser," beer;<sup>8</sup> "Kathairon," remedy;<sup>9</sup> "King Bee," smoking tobacco;<sup>10</sup> "King of the Field," agricultural implements;<sup>11</sup> "Kitchen Crystal," soap;<sup>12</sup> "Koffio," cereal coffee.<sup>13</sup>

"La Cronica," newspaper;<sup>14</sup> "Lacto-Peptide," medicine;<sup>15</sup> "La Favorita," flour;<sup>16</sup> "Lamoille," scythe-stones;<sup>17</sup> "La Norma," cigar boxes;<sup>18</sup> "La Normandi," cigars;<sup>19</sup> "Leopold," woolen cloth;<sup>20</sup> "Licensed Victuallers," relish;<sup>21</sup> "Lightning," hay knives;<sup>22</sup> "Lion," merchandise;<sup>23</sup> "Liverpool," woolen cloth;<sup>24</sup> "London Whiffs," cigars;<sup>25</sup> "Lone Jack," smoking tobacco.<sup>26</sup>

<sup>1</sup> *Waterman v. Shipman*, 130 N. Y. 301.

<sup>2</sup> *Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896.

<sup>3</sup> *Comstock v. White*, 18 How. Pr. 421.

<sup>4</sup> *Arthur v. Howard*, 19 Pa. Co. Ct. 81.

<sup>5</sup> *Insurance Oil Tank Co. v. Scott*, 33 La. Ann. 946.

<sup>6</sup> *Ex parte Heyman*, 18 Off. Gaz. 922.

<sup>7</sup> *Hecht v. Porter*, 9 Pac. Coast L. J. 569.

<sup>8</sup> *Kaiserbrauerei v. Blatz Brewing Co.*, 71 Fed. Rep. 695; s. c. affirmed, 74 Fed. Rep. 222.

<sup>9</sup> *Heath v. Wright, Cox, Am. Tr. Cas.* 154.

<sup>10</sup> *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624.

<sup>11</sup> *Greenwoods Scythe Co.*, Cert. No. 749.

<sup>12</sup> *Re Eastman*, W. N. 1880, p. 128.

<sup>13</sup> *Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co.*, 85 Off. Gaz. 1905.

<sup>14</sup> *Stephens v. DeConto*, 4 Abb. Pr. N. S. 47.

<sup>15</sup> *Carnrick v. Morson*, Seb. 543; *Cox, Manual*, 543.

<sup>16</sup> *Menendez v. Holt*, 128 U. S. 514.

<sup>17</sup> *Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896.

<sup>18</sup> *Ex parte Egyptian Cigarette Co.*, 85 Off. Gaz. 1905.

<sup>19</sup> *Stachelberg v. Ponce*, 23 Fed. Rep. 430.

<sup>20</sup> *Hirst v. Denham*, L. R. 14 Eq. 542; 27 L. T. N. S. 56; 41 L. J. Ch. 752.

<sup>21</sup> *Cotton v. Gillard*, 44 L. J. Ch. 90.

<sup>22</sup> *Hiram Holt Co. v. Wadsworth*, 41 Fed. Rep. 34.

<sup>23</sup> *Re Weaver*, 10 Off. Gaz. 1.

<sup>24</sup> *Hirst v. Denham*, L. R. 14 Eq. 542.

<sup>25</sup> *Feder v. Brudno*, 5 Ohio N. P. 275.

<sup>26</sup> *Carrcll v. Ertheiler*, 1 Fed. Rep. 688.

"Magic," scythe-stones;<sup>1</sup> "Magnetic Balm," ointment;<sup>2</sup> "Magnolia," liquor;<sup>3</sup> "Maizena," corn flour;<sup>4</sup> "Marvel," mill products;<sup>5</sup> "Medicated Mexican Balm," medicine;<sup>6</sup> "Menlo Park," watches;<sup>7</sup> "Mojava," blended coffee.<sup>8</sup>

"Napoleon," cigars;<sup>9</sup> "New Era," newspaper;<sup>10</sup> "Nickel," soap;<sup>11</sup> "Nickel-In," cigars;<sup>12</sup> "No-To-Bac," medicine;<sup>13</sup> "O. F. C.," whisky;<sup>14</sup> "Old Crow," whisky;<sup>15</sup> "Osman," towels;<sup>16</sup> "Otaka," biscuits.<sup>17</sup>

"Pain-Killer," medicine;<sup>18</sup> "Parabola," needles;<sup>19</sup> "Pectorine," medicine;<sup>20</sup> "Persian," thread;<sup>21</sup> "Pigs in Clover," puzzle;<sup>22</sup> "Pocahontas," coal;<sup>23</sup> "Portland," stoves;<sup>24</sup> "Pride," cigars;<sup>25</sup> "Puddine," pudding preparation.<sup>26</sup>

"Rising Sun," stove polish;<sup>27</sup> "Roger Williams," cot-

<sup>1</sup>Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

<sup>2</sup>Smith v. Sixbury, 25 Hun, 232; 32 N. Y. Sup. Ct. 232.

<sup>3</sup>Kidd & Co. v. Mills, Johnson & Co., 5 Off. Gaz. 337; Kidd v. Johnson, 100 U. S. 617.

<sup>4</sup>Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823.

<sup>5</sup>Listman Mill Co. v. William Listman Milling Co., 60 N. W. Rep. 261; 88 Wis. 334.

<sup>6</sup>Perry v. Truefit, 6 Beav. 56; 1 L. T. 384; Seb. 73.

<sup>7</sup>Ex parte Hampden Watch Co., 81 Off. Gaz. 1282.

<sup>8</sup>American Grocery Co. v. Sloan, 68 Fed. Rep. 539.

<sup>9</sup>Goldstein v. Whelan, 62 Fed. Rep. 124.

<sup>10</sup>Bell v. Locke, 8 Paige, 75; Cox, Am. Tr. Cas. 11.

<sup>11</sup>Ex parte Butler, 87 Off. Gaz. 1781.

<sup>12</sup>Schendel v. Silver, 18 N. Y. Supp. 1; 63 Hun, 330.

<sup>13</sup>Sterling Remedy Co. v. Eureka, etc. Mfg. Co., 70 Fed. Rep. 704; 80 Fed. Rep. 105.

<sup>14</sup>Geo. T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S.W. Rep. 247.

<sup>15</sup>W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421.

<sup>16</sup>Barlow & Jones v. Johnson, 7 P. R. 395.

<sup>17</sup>Ex parte Lorenz, 89 Off. Gaz. 2067.

<sup>18</sup>Davis v. Kendall, 2 R. I. 566; Davis v. Kennedy, 13 Grant Up. Can. Ch. 523.

<sup>19</sup>Roberts v. Sheldon, Fed. Case No. 11916; 18 Off. Gaz. 1277; 8 Biss. 398.

<sup>20</sup>Smith v. Mason, W. R. (1875) p. 62.

<sup>21</sup>Taylor v. Carpenter (1), 3 Story, 458.

<sup>22</sup>Lyman v. Burns, 47 Off. Gaz. 660.

<sup>23</sup>Atwater v. Castner, 88 Fed. Rep. 642. *Per contra*, Coffman v. Castner, 87 Fed. Rep. 457.

<sup>24</sup>Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788.

<sup>25</sup>Hier v. Abrahams, 82 N. Y. 519; 37 Am. Rep. 589.

<sup>26</sup>Clotworthy v. Schepp, 42 Fed. Rep. 62.

<sup>27</sup>Morse v. Worrell, 10 Phila. 168.

ton cloth;<sup>1</sup> "Rosebud," canned salmon;<sup>2</sup> "Royal," baking powder;<sup>3</sup> "Royal Blue," carpet sweeper.<sup>4</sup>

"Sapolio," scouring brick;<sup>5</sup> "Saponifier," concentrated lye;<sup>6</sup> "Sefton," cloth;<sup>7</sup> "Shawknit," stockings;<sup>8</sup> "Silver Grove," whisky;<sup>9</sup> "Six Little Tailors," tailoring firm's name;<sup>10</sup> "Slate Roofing," paint;<sup>11</sup> "Sliced Animals," toys;<sup>12</sup> "Social Register," directory;<sup>13</sup> "Star," shirts;<sup>14</sup> iron,<sup>15</sup> oil,<sup>16</sup> soap,<sup>17</sup> lead pencils,<sup>18</sup> tobacco;<sup>19</sup> "St. James," newspaper,<sup>20</sup> or cigarettes;<sup>21</sup> "Sunlight," soap;<sup>22</sup> "Swan Down," complexion powder;<sup>23</sup> "Sweet Caporal," cigarettes;<sup>24</sup> "Sweet Opoponax of Mexico," perfume;<sup>25</sup> "Syrup of Red Spruce Gum," medicine.<sup>26</sup>

<sup>1</sup>Barrows v. Knight, 6 R. I. 434; Cox, Am. Tr. Cas. 238.

<sup>2</sup>Ex parte Kinney, 72 Off. Gaz. 1349.

<sup>3</sup>Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376; Raymond v. Royal Baking Powder Co., 85 Fed. Rep. 231.

<sup>4</sup>Ex parte Grand Rapids School Furniture Co., 87 Off. Gaz. 1957.

<sup>5</sup>Enoch Morgan's Sons Co. v. Wendover, 43 Fed. Rep. 420.

<sup>6</sup>Pennsylvania Salt Mfg. Co. v. Meyers, 79 Fed. Rep. 87.

<sup>7</sup>Hirst v. Denham, L. R. 14 Eq. 542.

<sup>8</sup>Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707.

<sup>9</sup>Seltzer v. Powell, 8 Phila. 296.

<sup>10</sup>Mossler v. Jacobs, 65 Ill. App. 571.

<sup>11</sup>Re Glines, 8 Off. Gaz. 435.

<sup>12</sup>Selchow v. Baker, 93 N. Y. 59.

<sup>13</sup>Social Reg. Ass'n v. Howard, 60 Fed. Rep. 270; 67 Off. Gaz. 1448.

<sup>14</sup>Morrison v. Case, 9 Blatchf. 548; 2 Off. Gaz. 544; Fed. Case No. 9845; Hutchinson v. Blumberg, 51 Fed. Rep. 829; Hutchinson v. Covert, 51 Fed. Rep. 832.

<sup>15</sup>Dixon v. Jackson, 2 Scot. L. Rep. 188.

<sup>16</sup>Re American Lubricating Oil Co., 9 Off. Gaz. 687.

<sup>17</sup>Re Cornwall, 12 Off. Gaz. 138.

<sup>18</sup>Faber v. Hovey, Codd. Dig. 79, 242; Seb. 481.

<sup>19</sup>Liggett & Myer Tob. Co. v. Sam Reid Tob. Co., 155 Mo. 843; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883.

<sup>20</sup>Gibblett v. Read, 9 Mod. 459; Seb. 3; Ex parte Foss, Re Baldwin, 30 L. T. 354; 2 DeG. & J. 230; 27 L. J. Bkptcy. 17; 4 Jur. N. S. 522; 21 L. T. 30; Seb. 159.

<sup>21</sup>Kinney v. Basch, Seb. 542.

<sup>22</sup>Lever Bros. (Ltd.) v. Pasfield, 88 Fed. Rep. 484.

<sup>23</sup>Tetlow v. Tappan, 85 Fed. Rep. 774.

<sup>24</sup>Kinney Tob. Co. v. Maller, 53 Hun, 340; 6 N. Y. Supp. 389.

<sup>25</sup>Smith v. Woodruff, 48 Barb. 438.

<sup>26</sup>Kerry v. Toupin, 60 Fed. Rep. 272; Hornbostel v. Kinney, 110 N. Y. 94; 17 N. E. Rep. 665.

"Tamar Indien," lozenges;<sup>1</sup> "The Good Things of Life," periodical;<sup>2</sup> "The Nile," playing cards registered as a print;<sup>3</sup> "Tidal Wave," tobacco;<sup>4</sup> "Tivoli," beer;<sup>5</sup> "Trilby," gloves;<sup>6</sup> "Twin Brothers," yeast.<sup>7</sup>

"Uneeda," biscuit.<sup>8</sup>

"Valvoline," lubricating oil;<sup>9</sup> "Vitascope," machine;<sup>10</sup>

"Vulcan," matches.<sup>11</sup>

"Waverly," bicycles;<sup>12</sup> "Willoughby Lake," scythe-stones;<sup>13</sup> "Wistar's Balsam of Wild Cherry," medicine;<sup>14</sup> "Yankee," soap.<sup>15</sup>

§ 35. **Generic terms judicially defined.**—It is confusing to the student to be told that words indicating quality cannot be a valid trade-mark, and yet to be confronted by the physical fact and judicial dictum that the highest function of the trade-mark is its indication of quality. In a leading case Mr. Justice Field said that a trade-mark is "a sign of the quality of the article;"<sup>16</sup> and in the leading case of *Amoskeag Manufacturing Co. v. Spear*, the learned court says that the trade-mark of a manufacturer "is an assurance to the public of the quality of his goods."<sup>17</sup> In the same opinion, however, the judge (Duer) observes that the manufacturer "has no

<sup>1</sup> *Grillon v. Guenin*, W. N. 1877, p. 14.

<sup>2</sup> *Stokes v. Allen*, 9 N. Y. Supp. 846; 56 Hun, 526.

<sup>3</sup> *Ex parte United States Playing Card Co.*, 82 Off. Gaz. 1209.

<sup>4</sup> *Sorg v. Welsh*, 16 Off. Gaz. 910.

<sup>5</sup> *Berliner Brauerei Gesellschaft v. Knight*, W. N. 1883, p. 70.

<sup>6</sup> *Re Holt & Co.'s Trade-mark (C. A.)*, L. R. (1891) 1 Ch. 711.

<sup>7</sup> *Burton v. Stratton*, 12 Fed. Rep. 696.

<sup>8</sup> *National Biscuit Co. v. Baker*, 95 Fed. Rep. 135.

<sup>9</sup> *Leonard v. White's Golden Lubricator Co.*, 38 Fed. Rep. 922; *Leonard v. Wells*, L. R. 26 Ch. D. 288. *Per contra*, *Re Horsburgh*, 53 L. J. Ch. 237.

<sup>10</sup> *Vitascope Co. v. U. S. Phonograph Co.*, 83 Fed. Rep. 30.

<sup>11</sup> *Taendsticksfabriks Antiebolaget Vulcan v. Myers*, 139 N. Y. 364.

<sup>12</sup> *Ex parte Indiana Bicycle Co.*, 72 Off. Gaz. 654.

<sup>13</sup> *Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896.

<sup>14</sup> *Fowle v. Spear*, 7 Pa. L. J. 176.

<sup>15</sup> *Williams v. Adams*, 8 Biss. 452; Fed. Case No. 17711; *Williams v. Spence*, 25 How. Pr. 366; *Williams v. Johnson*, 2 Bos. 1.

<sup>16</sup> *Manhattan Medicine Co. v. Wood*, 108 U. S. 218-222.

<sup>17</sup> *Amoskeag Mfg. Co. v. Spear* (1849), 2 Sand. S. C. 599; Cox, 87; Seb. 100. In a recent case Judge Bradford has called attention to the use of

right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may

the word "quality" in the cases, and distinguished its two different meanings, in the following language:

"A trade-mark is designed to enable one legitimately to build up or protect his business, but not to deprive others of the right to use necessary or proper means for carrying on an honorable competition in trade. No one has a right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. *Canal Co. v. Clark*, 13 Wall. 311, 324. Hence no one can acquire an exclusive right to the use, as a trade-mark, of a generic name, or word, which is merely descriptive of an article, or a sign, symbol, figure, letter, brand, form or device, which either on its face or by association indicates or denotes merely grade, quality, class, shape, style, size, ingredients or composition of an article, or a word or words in common use designating locality, section or region of country. The word 'quality' is used in different senses in the cases. It is employed in some to denote the grade, ingredients or properties of an article, and in others to indicate generally the merit or excellence of an article as associated with or coming from a certain source. While there can be no valid trade-mark as denoting quality when used merely in the former sense, there may be a valid trade-mark as indicating quality when used in the latter sense. Thus in *McLean v. Fleming*, 96 U. S. 245-253, the court said:

"Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trade-mark adopted and applied by him to the goods to distinguish them as being of a particular manufacture and quality,' etc.

"In *Medicine Co. v. Wood*, 108 U. S. 218, 222; 2 Sup. Ct. 439, the court said:

"He may thus notify the public of the origin of the article and secure to himself the benefits of any particular excellence it may possess from the manner or materials of its manufacture. His trade-mark is both a sign of the quality of the article and an assurance to the public that it is a genuine product of his manufacture."

"In *Menendez v. Holt*, 128 U. S. 514, 520; 9 Sup. Ct. 144, the court, speaking of the words 'La Favorita' as applied to flour, said:

"It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article which had been determined by them to possess a certain degree of excellence. . . . And the fact that flour so marked acquired an extensive sale, because the public discovered that it might be relied on as of a uniformly meritorious quality, demonstrates that the brand deserves protection rather than it should be debarred therefrom, on the ground, as argued, of being indicative of quality only.'"

*Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-657.



employ with equal truth, and therefore have an equal right to employ for the same purpose. Were such an appropriation to be sanctioned by an injunction, the action of a court of equity would be as injurious to the public as it is now beneficial; it would have the effect in many instances of creating a monopoly in the sale of particular goods as exclusive as if secured by a patent, and freed from any limitation of time."

In another early case the chancellor observed: "In respect to words, marks or devices which do not denote the goods or property or particular place of business of a person, but only the nature, kind or quality of the articles in which he deals, . . . no property in such words, marks or devices can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded."<sup>1</sup> And in more recent cases the rule has been explained in somewhat similar terms. "It is true that no one can appropriate as a trade-mark the commercial name of an article which every man has the right to make and sell."<sup>2</sup>

"No manufacturer can acquire a special property in an ordinary term or expression, the use of which as an entirety is essential to the correct and truthful designation of a particular article or compound. The courts have gone a long way, and with plain justice, in protecting the honest and enterprising manufacturer of any good and useful article from the unscrupulous pirating of his special reputation; but they have been equally careful to prevent any attempted monopoly of that which is common to all."<sup>3</sup>

"Nor can a generic name, or a name merely descrip-

<sup>1</sup>Stokes v. Landgraff, 17 Barb. 608; Cox, 137; Seb. 121.

<sup>2</sup>Dreydoppel v. Young, 14 Phila. 226; Price & Steuart, 423, 424.

<sup>3</sup>Town v. Stetson, 5 Abb. Pr. N. S. 218; Cox, 514, 515.

tive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection. No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed."<sup>1</sup>

The fact that the article to which the trade-mark is applied has obtained such a wide sale that the mark has become indicative of quality, as well as of origin and ownership, is not of itself sufficient to render the mark *publici juris* and so deprive its owner of the right to relief against infringers.<sup>2</sup>

**§ 36. Necessary name of product.**—The necessary name of a product, natural or manufactured, cannot be a trade-mark, for the reasons we have discussed. This is true of goods manufactured under a patent. The descriptive name by which they are known during the life of the letters patent becomes their popular name in the trade—the name by which they are necessarily known and distinguished. When, therefore, the protection of the patent has expired the name is *publici juris*, and the manufacturer under the letters patent can claim no trade-mark in it.<sup>3</sup>

Thus the word "Linoleum" as applied to a kind of floor covering,<sup>4</sup> and "Singer" applied to sewing machines,<sup>5</sup> were held to be *publici juris* upon the expiration

<sup>1</sup>Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311-323; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327.

<sup>2</sup>Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547; Burton v. Stratton, 12 Fed. Rep. 696.

<sup>3</sup>Centaur Co. v. Robinson, 91 Fed. Rep. 889; Same v. Neathery, 91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901. The cases are collected, *ante*, p. 51, n. 4.

<sup>4</sup>Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

<sup>5</sup>Singer Mfg. Co. v. Bent, 163 U. S. 205; Singer Mfg. Co. v. June, 163 U. S. 169.

of the letters patent covering the articles to which they were applied.

Analogous to this class of cases is that where new combinations of old elements are found, and it is sought to distinguish such a new compound or combination by joining the descriptive names of its constituent elements. This is best illustrated by a case where the words claimed as trade-mark were "Ferro-phosphorated Elixir of Calisaya Bark," which claim was distinctly negated by the New York Court of Appeals, Folger, J., saying: "They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him."<sup>1</sup> For this reason the name "Acid Phosphate" applied to a medicinal preparation,<sup>2</sup> and "Indurated Fibre" applied to wares made of wood-pulp,<sup>3</sup> are not valid trade-marks; and the word "Bromo-Quinine" was refused registration as a trade-mark for medicines,<sup>4</sup> as was also the word "Ferro-Manganese" as a mark for mineral waters,<sup>5</sup> and the word "Bromo-Celery" for a medicinal preparation.<sup>6</sup>

There are cases, however, where such words or combinations of words have been held not to be descriptive. Thus the word "Cocaine" as applied to a hair wash compounded from cocoanut oil and other ingredients,<sup>7</sup> and "Magnetic Balm" as applied to a medicinal compound,<sup>8</sup> have been upheld as valid trade-marks. The word "Electro-Silicon" applied to a polishing compound has also been upheld;<sup>9</sup> and it appears very clear that the words "Magnetic" or "Electric" as used in the two cases last referred to are purely arbitrary and fanciful.

<sup>1</sup>Caswell v. Davis, 58 N. Y. 223-233.

<sup>2</sup>Rumford Chemical Works v. Muth, 35 Fed. Rep. 524.

<sup>3</sup>Indurated Fibre Co. v. Amoskeag Fibre Co., 37 Fed. Rep. 695.

<sup>4</sup>Re Grove, Newton, Dig. 172; s. c., Ibid. 191; 67 Off. Gaz. 1447.

<sup>5</sup>Re Excelsior Spring Co., Newton, Dig. 153.

<sup>6</sup>Re Bromo-Celery Co., Newton, Dig. 190.

<sup>7</sup>Burnett v. Phalon, 3 Keyes, 594.

<sup>8</sup>Smith v. Sixbury, 25 Hun, 232.

<sup>9</sup>Electro-Silicon Co. v. Trask, 59 How. Pr. 189; Electro-Silicon Co. v. Hazard, 29 Hun, 369.

We have noted that the patent office has refused registration to an applicant offering the word "Bromo-Quinine" as the name of a medicinal preparation. This decision is in hopeless conflict with some of the adjudicated cases. The word "Bromidia," as a trade-mark for a chemical combination of chloral hydrate, bromide of potassium and other substances, was admitted to registration and subsequently upheld as valid, the court upon final hearing saying that the word "has no meaning whatever except as connected with complainants' business, and as associated with and indicative of a soothing or soporific mixture prepared and sold by them."<sup>1</sup> The word "Bromo-Caffeine" was admitted to registration, and upheld judicially, the Court of Appeals of New York saying, per Peckham, J., "We think there is a distinction between the facts in this case and that of *Caswell v. Davis*.<sup>2</sup> In this case the term perhaps suggests that some one among the hundreds of substances that bromine may combine with has been used in such combination together with caffeine. There are, however, some seven different ingredients in the plaintiffs' preparation, and there is no free bromine among them, and there is no evidence as to what the substance is which the bromine (if any) had combined with before being used in the preparation, and so it is plain that the words 'Bromo-Caffeine' do not in fact describe the ingredients or even give any clear general idea as to what they are."<sup>3</sup> It is the general rule that "when an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable."<sup>4</sup>

<sup>1</sup>*Battle & Co. v. Finlay* (preliminary hearing), 45 Fed. Rep. 796, (final hearing) 50 Fed. Rep. 106.

<sup>2</sup>58 N. Y. 223, cited *supra*.

<sup>3</sup>*Keasbey v. Brooklyn Chemical Works*, 142 N. Y. 467-476.

<sup>4</sup>*Wallace, J., in Leclanche Battery Co. v. Western Elec. Co.*, 23 Fed. Rep. 276.

**§ 37. Words taken from the dead languages.—**

Words from the dead languages have frequently been applied to merchandise and sustained as valid trade-marks, as, for example, the Greek "Eureka" as a mark for shirts<sup>1</sup> or for a fertilizing material,<sup>2</sup> and the Latin "Excelsior" for stoves<sup>3</sup> or soap.<sup>4</sup> The Latin phrase "Ne Plus Ultra" was invalid as a trade-mark solely because the plaintiff did not show exclusive user in himself, and the words and an accompanying device were found to be common to the trade.<sup>5</sup> It has been said by the Canadian supreme court that there can be property in a word of a dead language even if it be expressive of quality,<sup>6</sup> but this dictum is incorrect, as appears from the authorities reviewed in the next succeeding section. A descriptive word from a dead language cannot be other than a generic term when used as a mark for goods. Thus, on an application for registration for the word "Sanitas" for medicines, Kay, J., remarked: "The truth is that if this word were applied to medicines, it would mean to any ordinary person that the medicines were health medicines; that is, health-giving medicines; and that is descriptive of the quality or of the effect of the use of these medicines. How is it possible that it is not descriptive?"<sup>7</sup>

**§ 38. Words and phrases from modern foreign languages.—**This topic has been fruitful of conflicting holdings. It is not settled what character of words so taken will be sustained as valid trade-marks.

<sup>1</sup>Ford v. Foster, L. R. 7 Ch. D. 611.

<sup>2</sup>Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115.

<sup>3</sup>Sheppard v. Stuart, 13 Phila. 117; Price & Steuart, 193.

<sup>4</sup>Braham v. Bustard, 1 H. & M. 447. "Excelsior" applied to gun-cotton goods was not upheld. Steinthal v. Samson, Seb. 546.

<sup>5</sup>Beard v. Turner, 13 L. T. N. S. 746; Seb. 251.

<sup>6</sup>Partlo v. Todd, 17 Can. S. C. R. 196.

<sup>7</sup>Re Sanitas Co., 4 R. P. C. 533; 58 L. T. 166; Cartmell, 305.

Similar reasoning forbade the registration of "Somatose" as a trade-mark for a nourishing meat product; the Greek "Soma," genitive "Somatos," being the equivalent of the English "body;" "somat" being the root of many English words and "ose" a common English suffix. Re Farben-fabriken T. M. K., L. R. (1894) 1 Ch. D. 645.

The English courts have consistently adhered to the rule announced by Chitty, J., in *Davis v. Stribolt*: "I am of the opinion that in reference to an article produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy name within the meaning of the act." For these reasons the Norwegian words "Bökel" and "Bokol" (meaning "beer") were held not valid as trade-marks for beer.<sup>1</sup>

A curious case is that of *Re Rotherham*. The house of Rotherham of Coventry had long made and exported watches to Tod & Co. of Alexandria, by whom they were sold, such watches bearing upon their dials the word "Tod" in Arabic characters; "Tod" as an Arabic substantive meaning "A high mountain." The Arabic word was registered as a trade-mark, Vice-Chancellor Bacon holding an order of the commissioners prohibiting registration of words in foreign languages invalid.<sup>2</sup>

The phrase "Flor Fina Prairie Superior Tabac" was held to be a valid trade-mark for cigars,<sup>3</sup> as have been the words "Tamar Indien" for lozenges,<sup>4</sup> "Intimidad" for cigars,<sup>5</sup> "El Destino," also for cigars,<sup>6</sup> "El Cabio" for tobacco,<sup>7</sup> and "La Favorita" for flour.<sup>8</sup> "Mazawattee," a compound of the Hindustani words "Maza," meaning taste or relish, and the Singalese "Wattee," meaning garden or estate, is a valid trade-mark because it conveys no meaning to any class of persons, English, Hindu or Singalese, and has no reference to the quality of the goods.<sup>9</sup>

<sup>1</sup>*Davis v. Stribolt*, 59 L. T. 854; *Cartmell*, 105.

<sup>2</sup>*Re Rotherham*, 29 W. R. 503; *Seb.* 647.

<sup>3</sup>*Cope v. Evans*, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453; *Seb.* 433.

<sup>4</sup>*Grillon v. Guenin*, W. N. 1877, p. 14; *Seb.* 532.

<sup>5</sup>*Caruncho v. Stephenson*, 25 Sol. J. 929.

<sup>6</sup>*Pinto v. Badman*, 8 R. P. C. 181; *Cartmell*, 270.

<sup>7</sup>*Solis Cigar Co. v. Pozo*, 16 Colo. 388; 26 Pac. Rep. 556.

<sup>8</sup>*Holt v. Menendez*, 128 U. S. 182.

<sup>9</sup>*Re Densham*, L. R. (1895) 2 Ch. D. 176.

The rules thus far discussed in this section do not seem to apply to aboriginal words or sounds. The word (or sound) "Oomoo," taken from the language of the Australian aborigines, was admitted to English registration by Chitty, J., after careful consideration;<sup>1</sup> on the other hand, the word "Kokoko," meaning "owl" in the language of the Chippeway Indians, was refused registration as a trade-mark for cotton goods.<sup>2</sup>

It was held in a dictum of the supreme court of Canada, in the very thoroughly considered case of *Partlo v. Todd*, that a descriptive foreign word, or a word in a dead language not known to people in general, because it is not understood, may become the trade-mark of the person who first uses it upon a particular article sold by him.<sup>3</sup> This theory has been affirmed by a New York state court and denied by Judge Showalter in the federal circuit court for the Northern District of Illinois, in two suits of the same complainant, involving the right to the word "Matzoon" as a trade-mark for a food product made of fermented milk. "Matzoon" or "Maadzoon" appears to be the sound of the name which Armenians give to a similar article made of fermented milk in Turkey. The New York court says: "I do not think that such a term can properly be regarded as descriptive in this country. It would be absolutely meaningless to all but a little group of Armenians in the millions of inhabitants of the United States. It would be equally meaningless in most of Europe. A Choctaw word would signify just as much. To the medical profession, among whom the plaintiff sought approval for his product, and to the drug trade, the name 'Matzoon' was practically an arbitrary or fanciful designation. It was not incorporated into the English language. It was derived from a language hardly known here, and to the vast majority of our people it meant nothing. Hence the rule upon which the defendant relies has no applica-

<sup>1</sup>Re Burgoyne, 6 R. P. C. 227; 61 L. T. 39; Cartmell, 85.

<sup>2</sup>Re Jackson Company's Trade-mark, 6 R. P. C. 80; Cartmell, 177.

<sup>3</sup>*Partlo v. Todd*, 17 Can. S. C. R. 196-213.

tion here." It was accordingly held to be a valid trade-mark.<sup>1</sup> That this rule is dangerous to the law of trade-marks is apparent. If it is left to the courts to say when a descriptive word taken from a modern foreign language may or may not be used as a trade-mark, practically endless litigation is opened to future generations. The court forgot the rule that a trade-mark must be capable of universal use, and knows no territorial restriction.<sup>2</sup> As Chitty, J., remarked in *Davis v. Stribolt*: "If the argument were well founded, the importer into this country of any foreign article not previously known in this country could restrain any one else from using the name by which it was called in the country in which it was produced."<sup>3</sup> Upon the application to Judge Shownalter for a preliminary injunction to restrain the use of the same word "Matzoon," that learned court said: "The strong contention is that Dr. Dadirrian introduced into this country a product which was unknown here, and by a name which was equally unknown, and that, since the name has become identified here with the article as made by him, his property in the name should be recognized. But, as already said, the product was in fact old, as was also the name. The ignorance of people in this country touching it, its uses and its name, cannot be treated as property, and be, in a manner, capitalized as an element in the good-will of this complainant. This would be the case if no other dealer was permitted to tell what Matzoon is, and what a considerable portion of the human race has found it useful for, after an experience with it under that name which, according to the record, dates back some eight centuries." The application was accordingly denied, and the ruling of the trial court was followed in the first circuit and subsequently upheld by the United States circuit court of appeals for that circuit.<sup>4</sup>

<sup>1</sup>Dadirrian v. Theodorian, 37 N. Y. Supp. 611.

<sup>2</sup>Subject to the exceptions noted *ante*, § 10, and p. 52, n.

<sup>3</sup>Davis v. Stribolt, 59 L. T. N. S. 854, cited *supra*.

<sup>4</sup>Dadirrian v. Yacubian, 72 Fed. Rep. 1010-1014; 75 Off. Gaz. 1856; followed in Dadirrian v. Yacubian (2), 90 Fed. Rep. 812. Latter case affirmed on appeal, Dadirrian v. Yacubian (3), 98 Fed. Rep. 872.



The German word "Ansatz," meaning "Compound," has been refused registration as a trade-mark for bit-  
ters,<sup>1</sup> as have been the words "Chili Colorow" (meaning  
red pepper in provincial Spanish), as a trade-mark for  
condiments.<sup>2</sup>

Vice-Chancellor Shadwell held a complainant who  
marked watches manufactured by him for the Turkish  
trade with the Turkish word "Pessendede" (meaning  
warranted) in Turkish characters, entitled to the exclu-  
sive right to so mark his watches. This was, however,  
not necessary to the decision of the case, and was a  
mere dictum.<sup>3</sup>

The case of *Broadhurst v. Barlow* was that of plaintiffs  
who used, beside a symbol of a lion in a scroll, the words  
"Exactly 12 Yards," in Turkish, Armenian and Greek,  
upon the rolls of cloth made by them for exportation to  
Greece and Turkey. With other relief, the defendant  
was enjoined from using the words "exactly 12 yards"  
in the languages used by plaintiffs. This relief would  
seem to be incidental to the portion of the injunction  
which related to fanciful scrollwork used by both parties.<sup>4</sup>

The use of the word "Grenadine" as a trade-mark for  
a syrup made of pomegranate juice was protected by  
injunction against a defendant who began the sale of  
another syrup under the name of "Grenade Syrup,"  
notwithstanding the word "Grenade" in French signifies  
"Pomegranate." This was purely a case of unfair com-  
petition.<sup>5</sup> The patent office has refused registration for

<sup>1</sup> Re Weisman, Newton, Dig. 119.

<sup>2</sup> Re Railton, Newton, Dig. 213.

<sup>3</sup> Gout v. Aleploglu, 6 Beavan, 69; 5 Leg. Obs. 495; Seb. 51.

<sup>4</sup> *Broadhurst v. Barlow*, W. N. 1872, p. 212; L. J. Notes of Cases, p. 183; Seb. 411. The use of labels printed in several languages was enjoined in *Siegert v. Findlater*, L. R. 7 Ch. D. 801; *Siegert v. Ehlers*, Seb. 432; *Curtis v. Bryan*, 2 Daly, 212; Cox, 434, *Siegert v. Abbott* (2), Cox, Manual, 718; *Société Anonyme v. Western Distilling Co.*, 43 Fed. Rep. 416; *Fischer v. Blank*, Cox, Manual, 731.

<sup>5</sup> *Rillet v. Carlier*, 61 Barb. S. C. 435; 11 Abb. Pr. N. S. 186; Seb. 334. The word "Ethiopian" printed in Egyptian characters upon stockings was protected from infringement, but in a case of unfair competition. *Hine v. Lart*, 10 Jur. 106; 7 L. T. 41.

the words "Für Familien-Gebrauch" (For Family Use) and "Lawrence Feiner Familien-Flannel" (Lawrence Fine Family Flannel), but upon the ground that they were mere words in common use and not distinctive.<sup>1</sup> And it is now the fixed rule of that office that no descriptive words reproduced in letters from a foreign language will be admitted to registration, when registration would be refused to their English equivalents.<sup>2</sup>

§ 39. **Words become generic through use.**—A word originally fanciful and indicative of origin or ownership may through the laches of the owner become *publici juris*. Thus the word "Chlorodine," while originally a good trade-mark, became generic through the failure of the manufacturer to prosecute a suit brought by him to restrain its use,<sup>3</sup> and because it had become the name of the article.<sup>4</sup> This, of course, is substantially a holding that the trade-mark has been abandoned by the owner's neglect. The American courts have been averse to so holding. It was said in *Taylor v. Carpenter* that the court was "not aware that a neglect to prosecute, because one believed he had no rights, or from mere procrastination, is any defense at law, whatever it may be in equity, except under the statute of limitations pleaded and relied on, or under some positive statute, like that as to patents, which avoids the right if the inventor permits the public to use the patent some time before

<sup>1</sup> *Re Lawrence & Co.*, 10 Off. Gaz. 163; Seb. 504.

<sup>2</sup> *Ex parte Stuhmer*, 86 Off. Gaz. 181. In this case the applicant sought registration for the words "Gold Label" produced in Hebrew characters.

<sup>3</sup> *Browne v. Freeman* (1), 12 W. R. 305; 4 N. R. 476.

<sup>4</sup> *Browne v. Freeman* (2), W. N. 1873, 178; *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541.

In this case the controlling fact was that the complainant's and defendant's marks were used on different classes of goods. The court, however, expressly names the laches of the complainant as a ground for withholding relief, citing, in support of this proposition, *inter alia*, the opinion of Chancellor Walworth in *Smith v. Adams*, 6 Paige, 435-443; and the copyright case of *Lewis v. Chapman*, 3 Beavan, 133, where a delay of six years was held to disentitle the plaintiff from relief.

taking out letters.”<sup>1</sup> Words primarily indicative of origin or ownership remain valid as trade-marks notwithstanding the fact that the articles to which they are applied may obtain such extensive sales that the marks have also become indicative of quality.<sup>2</sup>

§ 40. **The use of generic names protected.**—Possibly the widest deviation from the narrow path of trade-mark protection which has been accomplished by the law of unfair competition is to be found in the cases involving the deceptive use of generic terms. The supreme court of the United States has held in regard to the name of a person used as a descriptive name of a patented article, during the life of a patent, that while that name becomes *publici juris* upon the expiration of the patent, it must be so used by manufacturers other than the original maker as not to deceive the public into the belief that the goods offered for sale are the goods of such original maker.<sup>3</sup> The same rule has been established in England.<sup>4</sup>

So it was held by Mr. Justice McKenna, when circuit judge, that “Syrup of Figs” was entitled to injunctive protection. He said: “Respondent urges that the words ‘Syrup of Figs’ are descriptive, and that complainant deceives when it uses them to designate its compound. The deceit does not appear on the face of the bill, and it is unimportant if they are descriptive. The question is now, not whether complainant has the exclusive right to use the words ‘Syrup of Figs’ or ‘Fig Syrup,’ but it is whether respondent has, by use of them and other words, and by the other imitations alleged and exhibited, so far imitated the form of complainant’s device and descrip-

<sup>1</sup>Taylor v. Carpenter, 2 Wood. & M. 1; 9 L. T. 514; Cox, 32.

<sup>2</sup>Burton v. Stratton, 12 Fed. Rep. 696-702; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547.

<sup>3</sup>Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; Singer Mfg. Co. v. Bent, 163 U. S. 205. See also, to the same effect, Fairbanks v. Jacobus, 14 Blatchf. 337; Adey v. Peck Bros. & Co., 37 Fed. Rep. 209; Singer Mfg. Co. v. Brill, Cox, Manual, 672.

<sup>4</sup>Singer Mfg. Co. v. Loog, H. L. 8 A. C. 15; 53 L. J. Ch. 481; 48 L. T. 3; 31 W. R. 325; Cartmell, 306.

tion to represent its goods as its goods, and appropriate its reputation and trade. The *gravamen* of the action is the simulation of complainant's devices and the deception of purchasers. This is the principle of the best considered cases, uniting them, notwithstanding their diverse facts."<sup>1</sup>

In affirming the decision of Judge McKenna, however, the circuit court of appeals held that "Syrup of Figs" was not a generic name.<sup>2</sup> The more recent case of *California Fig Syrup Co. v. Worden*<sup>3</sup> again puts the plaintiff's right to relief upon the proper ground of unfair competition, aside from any technical trade-mark right in the words.

From the doctrine stated by the federal supreme court<sup>4</sup> it follows that the designs, symbols and marks used by a patentee during the life of the patent upon packages containing the patented article may not be imitated by another upon the expiration of the patent, and such imitation will be enjoined.<sup>5</sup>

The rule of unfair competition, that no man has a right

<sup>1</sup>California Fig Syrup Co. v. Improved Fig Syrup Co., 51 Fed. Rep. 296-297, citing Burton v. Stratton, 12 Fed. Rep. 696; Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799; Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205; Anonyme, etc., Société v. Western Dis. Co., 43 Fed. Rep. 417.

<sup>2</sup>Improved Fig Syrup Co. v. California Fig Syrup Co., 54 Fed. Rep. 175-178. It is very difficult to understand how the court could conclude that "Syrup of Figs" was not a generic name. It lacks every requisite of a valid trade-mark, and is undoubtedly either deceptive or merely descriptive of one of the ingredients of the medicine (a liquid laxative). It has been so held in California Fig Syrup Co. v. Stearns, 67 Fed. Rep. 1008; s. c., 73 Fed. Rep. 812-814; California Fig Syrup Co. v. Putnam, 66 Fed. Rep. 750.

<sup>3</sup>(1) 86 Fed. Rep. 212-215; California Fig Syrup Co. v. Worden (2), 95 Fed. Rep. 132.

<sup>4</sup>Singer Mfg. Co. v. June, 163 U. S. 169; Singer Mfg. Co. v. Bent, 163 U. S. 205.

<sup>5</sup>Greene v. Woodhouse, 38 Off. Gaz. 1891; Centaur Co. v. Killenberger, 87 Fed. Rep. 725; Same v. Robinson, 91 Fed. Rep. 889; Same v. Neathery, 91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901. In this connection it is probable that the name by which the patented article was known during the life of the patent (if otherwise valid as a trade-mark) may be continued in use, with the prefix "original." Cocks v. Chandlers, L. R. 11 Eq. 447.

to represent his goods as the goods of another, is distinctly applied in several of the more recent English decisions to terms strictly generic and of which technical trade-mark rights could not be predicated. Thus where the manufacturers of "Reddaway Camel Hair Belting" sought to enjoin a rival manufacturer from styling his product "The Bentham Camel Hair Belting," Lord Justice Lindley, in the court of appeal, said: "The catch-words are 'Camel Hair Belting' . . . The use of the catch-words alone may establish the plaintiffs' right to relief. The plaintiffs have no right to the exclusive use of these words; but they have a right to restrain any one from so using them as to pass his goods off as the goods of the plaintiffs."<sup>1</sup> So an injunction was granted. Very similar to this was the case in which the plaintiffs manufactured a soap under the name "The Self-washer." The defendants thereafter applied the term "Self-washing" to their soaps. It was held that the term "Self-washer" or "Self-washing" were used in a descriptive sense and therefore neither could be appropriated as a valid technical trade-mark; but because of the paper used by the defendants in wrapping their soap, being an imitation parchment paper, and the type used by them, which closely resembled that used by the plaintiffs, the defendants were enjoined, Lord Justice Cotton, in the court of appeal, observing: "There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing off, the defendants' soap as the plaintiffs', then, although the plaintiffs have no monopoly either in 'Self-washing' or 'Self-washer' or in the parchment paper or in the spaced printing, yet if those things in which they have no sole right are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common-law doctrine in respect of which equity will give to the aggrieved party an injunction in

<sup>1</sup> Reddaway v. Bentham Hemp Spinning Co., 9 R. P. C. 503; L. R. (1892) 2 Q. B. 639; 67 L. T. 301; Cartmell, 282.

order to restrain the defendant from passing off his goods as those of the plaintiff."<sup>1</sup>

These cases, with those cited in the foot-note, will sufficiently demonstrate the fact that the rule under consideration is not only important but well established, and that the user of a strictly generic term will be protected in the business he has established under that term, as against a dishonest use of it by a competitor.<sup>2</sup>

The doctrine of unfair competition, by which the use of descriptive words has sometimes been restrained, has engrafted upon it this important qualification—that in no case will the use of a merely descriptive word be restrained as deceptive, unless in circumstances which show fraud on the part of the user.<sup>3</sup> The English leading cases upon this proposition are the "Camel Hair Belting" case,<sup>4</sup> to which we have already referred, and the "Cellular Clothing" case.<sup>5</sup> In the former case the defendant said expressly that by using the term "Camel Hair Belting" he would be enabled to sell his goods as those of the plaintiff. Each case involved the use of a descriptive word. In the belting case, however, the word had acquired an additional meaning. The mere use of the words "Camel's Hair" had come to be understood in the trade as indicating belting of the plaintiff's manufacture. It was proved in addition to

<sup>1</sup>Lever v. Goodwin, 4 R. P. C. 492-506; 36 Ch. D. 1; 57 L. T. 583; 36 W. R. 177; Cartmell, 209.

<sup>2</sup>Lever v. Bedingfield, 80 L. T. N. S. 100; Barlow v. Johnson, 7 R. P. C. 395; Cartmell, 73; Curtis v. Pape, 5 R. P. C. 146; Cartmell, 105; Jay v. Ladler, 6 R. P. C. 136; 40 Ch. D. 649; 60 L. T. 27; 37 W. R. 505; Cartmell, 184; Powell v. Birmingham Vinegar Brewery Co., L. R. (1894) 3 Ch. D. 449-462; Reddaway v. Banham, L. R. (1896) A. C. 199; Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; Jennings v. Johnson, 37 Fed. Rep. 364; Meyer v. Bull Medicine Co., 58 Fed. Rep. 884; Morgan Envelope Co. v. Walton, 86 Fed. Rep. 605; VanHorn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326; Goodman v. Bohl's, 3 Tex. Civ. App. 183; 22 S. W. Rep. 11.

<sup>3</sup>Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-341.

<sup>4</sup>Reddaway v. Banham, L. R. (1896) A. C. 199.

<sup>5</sup>Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

this that the defendant's acts were done in consummation of a fraudulent design to sell his goods as those of the plaintiff. For these reasons the use of the words by the defendant was restrained.<sup>1</sup> The Cellular Clothing case differed from this on the facts. As in the belting case, the words "Cellular Clothing" were originally purely descriptive, being applied to a cloth of cellular structure. It was not shown that the term had so acquired a technical and secondary meaning, differing from its natural meaning, that it could be excluded from the use of every one else,<sup>2</sup> and it was not shown that the defendant had intended to defraud the plaintiff, or that any one had bought of the defendant in the belief that he was getting plaintiff's goods.<sup>3</sup> The Cellular Clothing case demonstrates very clearly that one who takes upon himself to prove that words which are merely descriptive or expressive of the quality of the goods have acquired a secondary meaning and indicate that the goods are of his manufacture has assumed a burden which, while it is not impossible, is, in the language of Lord Davey, "at the same time extremely difficult to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word, not significant and not descriptive, but what has been compendiously called a 'fancy' word."<sup>4</sup>

§ 41. **The test of "origin or ownership."**—One of the primary methods—if indeed it is not the fundamental test—in determining the validity of a trade-mark has been broadly announced by the supreme court of the United States in these words: "The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other

<sup>1</sup> See opinion of Lord Halsbury in *Cellular Clothing Co. v. Maxton*, L. R. (1899) A. C. 326-335, and *Reddaway v. Banham*, L. R. (1896) A. C. 199, 204-205.

<sup>2</sup> Lord Halsbury in *Cellular Clothing Co. v. Maxton*, L. R. (1899) A. C. 326-337.

<sup>3</sup> Lord Watson in *Cellular Clothing Co. v. Maxton*, L. R. (1899) 326-337.

<sup>4</sup> Lord Davey in *Cellular Clothing Co. v. Maxton*, L. R. (1899) 326-343.

words, to give notice who was the producer.”<sup>1</sup> And it has recently been said: “That such mark or symbol (*i. e.*, any mark or symbol claimed as trade-mark) must be designed, as its primary object and purpose, to distinguish each of the articles to which it is affixed from like articles produced by others, seems to be the clear consensus of all the cases which are authoritative.”<sup>2</sup>

Substantially this form of expression has been employed by the American courts from their earliest trade-mark decisions. Our profoundly learned chancellor, Walworth, stated the rule as well as any court that has followed him, when he said: “The court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade or business. And that having appropriated to himself a particular label, or sign or trade-mark, indicating to those who wish to give him their patronage that the article is manufactured or sold by him, or by his authority, or that he carries on business at a particular place, he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainant’s friends or customers, or the patrons of his trade or business, by sailing under his flag without his authority or consent.”<sup>3</sup> In the light of this statement, the words of the supreme court assume a broader meaning. In 1849, the year following that in which the last quoted opinion was rendered, it was said in an opinion of the superior court of New York City, that “the owner of a trade-mark has no right to an exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods.”<sup>4</sup> And the same court, by the same judge (Duer),

<sup>1</sup> Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327.

<sup>2</sup> Lurton, J., in Deering Harvester Co. v. Whitman-Barnes Mfg. Co., 91 Fed. Rep. 376-378, citing Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; Amoskeag Mfg. Co. v. Trainer, 101 U. S. 54; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; Columbia Mill Co. v. Alcorn, 150 U. S. 460.

<sup>3</sup> Patridge v. Menck, 2 Sand. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; Cox, 72; Seb. 91.

<sup>4</sup> Amoskeag Mfg. Co. v. Spear, 2 Sand. S. C. 599; Cox, 87; Seb. 100.



repeated the statement in very nearly the same words in 1857, saying that a name could be rightfully used and protected as a trade-mark only "where the name is used merely as indicating the true origin or ownership of the article offered for sale, never where it is used to designate the article itself and has become, by adoption and use, its proper appellation."<sup>1</sup> And in 1868 the supreme court of California stated the rule to be that trade-marks will be protected "only so far as such marks serve to designate the true origin or ownership of the goods to which they are attached."<sup>2</sup> So that when the doctrine as first stated by the federal supreme court was announced, it had become well settled in our jurisprudence that a trade-mark must indicate origin or ownership, and the only difficulty presented by the maxim to bench and bar is that of its application to each new state of facts as it arises. It must be noted, however, that "it is, of course, no fatal objection to the validity of a trade-mark that it does not include the name of the manufacturer or producer. The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source."<sup>3</sup>

It is self-evident that while a mark may be indicative of origin and ownership, it may, because generic or deceptive, fall short of being a valid trade-mark. But every valid trade-mark must be indicative of origin or ownership in the sense in which those words are used in the decisions.

**§ 42. Geographical names.**—The rule that geographical names cannot be exclusively appropriated for the

<sup>1</sup>Fetridge v. Wells, 4 Abb. Pr. 144; 13 How. Pr. 385; Cox, 180; Seb. 144.

<sup>2</sup>Falkinburg v. Lucy, 35 Cal. 52; and Eggers v. Hink, 63 Cal. 445. See also Osgood v. Allen (Maine), 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410.

<sup>3</sup>Lurton, J., in Deering Harvester Co. v. Whitman & Barnes Mfg. Co., 91 Fed. Rep. 376-380. To the same effect see Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-656.

purposes of trade-mark has been recognized from the infancy of trade-mark law. It was said by the United States supreme court that "No one can apply the name of a district of country to a well-known article of commerce and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it."<sup>1</sup>

**§ 43. As employed by sole owner of a natural product and its place of production.**—There can be no doubt that, where the owner of a geographical site productive of a salable article is the sole owner, he may have an exclusive right in the name of his site. This rule has been followed in several cases where the pro-

<sup>1</sup>Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327; Columbia Mill Co. v. Alcorn, 150 U. S. 460; Candee, Swan & Co. v. Deere & Co., 54 Ill. 439; 5 Am. Rep. 125; 4 Am. L. T. 266; 10 Am. L. Reg. N. S. 694; Seb. 339; Re Tolle, 2 Off. Gaz. 415; Seb. 405; Osgood v. Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410; Glendon Iron Co. v. Uhler, 75 Pa. St. 467; 15 Am. Rep. 599; 13 Am. L. Reg. N. S. 543; 6 Off. Gaz. 154; Seb. 439; Bulloch, Lade & Co. v. Gray, 19 Journ. of Jurisp. 218; Seb. 452; Wolfe v. Goulard, 18 How. Pr. 64; Clinton Met. Paint Co. v. N. Y. Met. Paint Co., 50 N. Y. Supp. 437; Gabriel v. Sicilian Asphalt Co., 52 N. Y. Supp. 722; Morgan Envelope Co. v. Walton, 86 Fed. Rep. 605; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495; Burgess v. Burgess, 17 Eng. L. & Eq. 257; Brooklyn White Lead Co. v. Masury, 25 Barb. 416; Lea v. Wolff, 13 Abb. Pr. N. S. 389; 15 Id. 1; 46 How. Pr. 157; 1 Am. L. T. N. S. 400; Seb. 407; Carmichel v. Latimer, 11 R. I. 395; Eggers v. Hink, 63 Cal. 445; Dunbar v. Glenn, 42 Wis. 118; Anheuser-Busch Brewing Association v. Pisa, 23 Blatchf. 245; Lea v. Deakin, 11 Biss. 23; Pratt's Appeal, 117 Pa. St. 401; Smith v. Walker, 37 Mich. 456; Smith v. Imus, 32 Alb. L. J. 455; Burton v. Stratton, 12 Fed. Rep. 696; Evans v. Van Laer, 32 Fed. Rep. 153; Coffman v. Castner, 87 Fed. Rep. 457. Even though the word "Raleigh" was that of an historical personage, registration was refused because it was also a geographical name. Ex parte Oliver, 18 Off. Gaz. 923; Price & Steuart, 59.

prietor of the commodity was the owner of the place of its production, and the name of that place was a prominent and controlling part of the trade-mark. Lord Cranworth so held in the case of a wine-grower who used the name of his vineyard as a trade-mark for his wines.<sup>1</sup> And the use of the words "Congress Water" as designating the product of "Congress Spring" was sustained on the suit of the sole owner of the springs.<sup>2</sup>

**§ 44. When geographical names will be protected as trade-marks.**—In many cases the use of geographical words has been protected on the ground of unfair competition. It was so held where the complainants applied the word "Durham," the name of a town in North Carolina, to tobacco manufactured by them at that locality. The defendant, whose business was conducted at Richmond, was enjoined from applying the word to tobacco produced by him.<sup>3</sup> And the usual rule by which geographical names have been protected against infringers by injunction was thus tersely stated by our patent office: "Undoubtedly courts of equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiffs."<sup>4</sup> Probably a more accurate statement, however, is that of the United States circuit court of appeals in the very well considered opinion in *Pillsbury-Washburn Co. v. Eagle*:<sup>5</sup> "The distinction, both in

<sup>1</sup>*Seixo v. Provezende*, L. R. 1 Ch. 192; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

<sup>2</sup>*Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 4 Am. L. T. 168; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; 45 N. Y. 291; Cox, 599; *La Republique Francaise v. Schultz*, 57 Fed. Rep. 37; *City of Carlsbad v. Kutnow*, 68 Fed. Rep. 794; s. c., 71 Fed. Rep. 167; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469; *Northcutt v. Turney*, 101 Ky. 314; 41 S. W. Rep. 21.

<sup>3</sup>*Blackwell & Co. v. Dibrell & Co.*, 3 Hughes, 151; *Price & Steuart*, 10.

<sup>4</sup>*Ex parte Farnum & Co.*, 18 Off. Gaz. 412; *Price & Steuart*, 68.

<sup>5</sup>86 Fed. Rep. 608; overruling s. c., 82 Fed. Rep. 816. The false use of a geographical name will not be tolerated when it is so used

the English and American cases, is between those where a geographical name has been adopted and claimed as a trade-mark proper, and those where it has been adopted first as merely indicating the place of manufacture, and afterwards, in the course of time, has become a well-known sign and synonym for superior excellence. In the latter class of cases, persons residing at other places will not be permitted to use the geographical name so adopted as a brand or label for similar goods for the mere purpose, by fraud and false representation, of appropriating the good-will and business which long continued industry and skill and a generous use of capital has rightfully built up. It will be of no avail in such cases, where the facts are admitted or proven, to allege a want of power in a court of equity to find a remedy." In other words, geographical names can never be appropriated as trade-mark; but with the development of the law of unfair competition has come the incidental protection of geographical names applied to merchandise, not as technical trade-mark, but as an indication to the public of the true place of its manufacture. And no manufacturer can defend, any more than he could maintain a suit in equity, where he is falsely representing the place where his manufacture is conducted.

**§ 45. Geographical names—The underlying principle.**—Judge Lacombe has recently given this concise expression of the rule applied by courts of equity to geographical names falsely used in unfair competition:

as to promote unfair competition and to induce the sale of spurious goods. *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693.

"Whatever might have been the doubts some years ago, we think that now it is pretty well settled that the plaintiff, merely on the strength of having been first in the field, may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names and advertisements from deceitfully diverting the plaintiff's custom." This was said of the word "Waltham" as applied to watches, by Holmes, J., in *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85; 53 N. E. Rep. 141; followed in *American Waltham Watch Co. v. Sandman*, 96 Fed. Rep. 330.

“Whatever may be the decisions in the state courts, it is abundantly settled by authority in the federal courts that they will not tolerate a false use of a geographical name when it is so used as to promote unfair competition and to induce the sale of spurious goods.”<sup>1</sup> And in another recent case the United States circuit court of appeals of the seventh circuit said, per Bunn, J.: “The distinction, both in the English and American cases, is between those where a geographical name has been adopted and claimed as a trade-mark proper, and those where it has been adopted first as merely indicating the place of manufacture, and afterwards, in the course of time, has become a well-known sign and synonym for superior excellence. In the latter class of cases, persons residing at other places will not be permitted to use the geographical name so adopted as a brand or label for similar goods for the mere purpose, by fraud and false representation, of appropriating the good-will and business which long continued industry and skill and a generous use of capital has rightfully built up. It will be of no avail in such cases, where the facts are admitted or proven, to allege a want of power in a court of equity to find a remedy.”<sup>2</sup>

The supreme court of the United States has clearly excluded geographical names from use as technical trade-marks.

It was said by Mr. Justice Jackson: “The general principles of law applicable to trade-marks, and the conditions under which a party may establish an exclusive right to the use of a name or symbol, are well settled by

<sup>1</sup>Collinsplatt v. Finlayson, 88 Fed. Rep. 693.

<sup>2</sup>Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608-618. The leading English case is the Stone Ales Case, Thompson v. Montgomery, (1891) App. Cas. 217; 8 R. P. C. 365. Of this decision a very learned English law writer has said: “There are dicta in the Stone Ales Case, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured; but they must, it is submitted, be read by reference to the facts of the case, which was one of deliberate fraud.” Kerly on Trade-marks (London, 1894), p. 44.

the decisions of this court, . . . which . . . establish the following general propositions: . . . (3) That the exclusive right to the use of the mark or device claimed as a trade-mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles of production. (4) Such trade-marks cannot consist of words in common use as designating locality, section, or region of country.”<sup>1</sup>

The reasons for this rule have been more fully expressed by Mr. Justice Strong, in these words: “No one can claim protection for the exclusive use of a trade-mark or trade-name, which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected; for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to a legal protection. . . . He has no right to appropriate a sign, or a symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they cannot point to the origin (personal origin) of the articles of trade to which they may be applied. . . . It must be considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in

<sup>1</sup>Columbia Mill Co. v. Alcorn, 150 U. S. 460.

similar articles coming from the district, from truthfully using the same designation."<sup>1</sup>

Is it not a reasonable conclusion from these and the kindred cases which we have heretofore examined, that there can be no technical trade-mark in a geographical name? To the author's mind that conclusion is inevitable, and there is but one class of geographical names which are to be excepted from the operation of the rule, namely, those applied to a natural product and its sole place of production. The name so used may very properly be a trade-mark, indicative of the origin and ownership of the natural product, and at the same time indicating the locality of its production. Here the name undoubtedly is a trade-mark if there is but one owner of the entire locality, and the courts have uniformly so held.<sup>2</sup> The same scientific objection to geographical names as trade-mark obtains as in the case of proper names. They are generic, in that every manufacturer who sees fit to locate in that city or vicinage and inaugurate a competing business has an equal right with all those who have preceded him in the locality, and all those who may thereafter so locate, in using the name of that locality in advertising his wares and in preparing them for commerce.<sup>3</sup>

Being generic they cannot be used as trade-marks, with the one exception we have noted, that of the title to the entire locality being vested in one owner. In that case no one else can locate there and institute competition; the name of the locality is not generic, and that fact exempts it from the operation of the rule. There is one other very rare exception which is the subject of difference between two of the federal courts in different cir-

<sup>1</sup>Delaware & Hudson Canal Co. v. Clark, 13 Wall. 323.

<sup>2</sup>City of Carlsbad v. Schultz, 78 Fed. Rep. 469; City of Carlsbad v. Kutnow, 71 Fed. Rep. 167, affirming 67 Fed. Rep. 794; Hill v. Lockwood, 32 Fed. Rep. 389; Northcutt v. Turney, 101 Ky. 314, 41 S. W. Rep. 21.

<sup>3</sup>Blackwell v. Dibrell, 3 Hughes, 160; Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; New York Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212.

cuits; the case where the locality has derived its name from the use of the word by the party claiming it as trade-mark, one court holding that it is a valid trade-mark,<sup>1</sup> the other denying its validity.<sup>2</sup> Without expressing an opinion upon this proposition, the general rule may be said to be unaffected by these possible exceptions; and the unfair use of a geographical name is a matter with which the law of unfair competition must deal in the majority of cases.

In the course of a well-considered opinion Judge Showalter has held the name "Elgin" as applied to watch-movements to be a strictly technical trade-mark, even though the name is that of the town where the factory is situated, because, in the words of the court: "This mark has this significance (designating complainants' manufacture) where the town of Elgin is entirely unknown." But this is purely a dictum, and presented in a case of fraudulent competition, where the defendants had removed their factory from Chicago to Elgin "with the purpose . . . of giving some color of right to a designed trespass on complainant's good-will."<sup>3</sup>

**§ 46. A false geographical name vitiates trade-mark.**—To all that has been said in the last preceding section must be noted one broad qualification. He who seeks to uphold a trade-mark in a court of equity must do so with clean hands, so that a trade-mark otherwise good will be vitiated and the right to it destroyed by the use of a false geographical name in connection with it.<sup>4</sup> And this is true, as expressed by Judge Showalter, even though "No actual or substantial wrong may have resulted to any one from this misrepresentation."<sup>5</sup>

**§ 47. The right to complain of unfair use of geographical name.**—The right to use the name of a locality in the manufacture and sale of goods is a general right

<sup>1</sup> *Atwater v. Castner*, 88 Fed. Rep. 642.

<sup>2</sup> *Coffman v. Castner*, 87 Fed. Rep. 457.

<sup>3</sup> *Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 89 Fed. Rep. 437.

<sup>4</sup> *Manhattan Med. Co. v. Wood*, 108 U. S. 218; and cases cited *ante*, § 27.

<sup>5</sup> *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-382.



of all who manufacture in that locality.<sup>1</sup> It therefore follows that where any one not living in that locality uses its name to indicate his merchandise, he is resorting to a trick to divert business from the dealers in the same kind of merchandise who in fact live in the locality and honestly use its name as a mark upon the goods.<sup>2</sup>

The action to restrain such an unfair competition may be brought either by one<sup>3</sup> or all<sup>4</sup> of the merchants who are entitled to the use of the name of the locality and are using it upon the same class of merchandise.

**§ 48. When relief will be granted against fraudulent use of geographical names.**—It would be a vain task to enumerate the various forms of misuse of geographical names which have been enjoined. An examination of the cases will show the versatility of the fraudulent dealer in devising schemes to deceive the public and deprive the legitimate dealer of his trade. The printing of an American label in the French language has been treated as evidence of unfairness in competition against French exporters to the United States;<sup>5</sup> and the statement upon a package that its contents were "Chicorien Kaffee aus der fabrik von E. B. Muller & Co., in Roulers (Belgien)," was held to be misleading and unfair where the facts showed that the only part of the manufacture done in Belgium was to "harvest" the chicory root, the other processes being done in the United States.<sup>6</sup> In brief, it is particularly true of the subject under discussion that "a court of equity keeps pace with the rapid strides of the sharp competitors for the prize

<sup>1</sup>Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608.

<sup>2</sup>Ibid. "A palpable trick," it was termed by Gresham, J., in Southern White Lead Co. v. Cary, 25 Fed. Rep. 125-127.

<sup>3</sup>Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; 51 N. Y. 189; 10 Am. Rep. 588; Klotz v. Hecht, 73 Fed. Rep. 822; Scheuer v. Muller, 74 Fed. Rep. 225; Gage-Downs Co. v. Featherbone Corset Co., 83 Fed. Rep. 213; Southern White Lead Co. v. Coit, 39 Fed. Rep. 492; A. F. Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

<sup>4</sup>Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608.

<sup>5</sup>Koltz v. Hecht, 73 Fed. Rep. 822.

<sup>6</sup>Scheuer v. Muller, 74 Fed. Rep. 225-228.

of public favor and insists that it shall be won only by fair trade.”<sup>1</sup> Some of the cases are cited in the footnote.<sup>2</sup>

§ 49. **Proper names as trade-mark.**—It is a self-evident proposition that every one has the right to use his own name for purposes of trade. It was held by Vice-Chancellor Wood that a man’s own name might be his trade-mark even when united with other words, themselves generic and hence incapable of exclusive appropriation. In sustaining the words “Ainsworth’s Thread” as a trade-mark he said: “Is not a man’s name as strong an instance of trade-mark as can be suggested?—subject only to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name.”<sup>3</sup> But any name may be used by any one who cares to designate himself by it, and in this sense a proper name can never be an essential part of a trade-mark, because, as we have seen, a valid trade-mark must be exclusive, as against all the world. The decisions as to this are conflicting, very confusing, and in many instances the result of careless use of language. Thus Chancellor Westbury said: “It is true that a name or the style of a firm may by long usage become a mere trade-mark.”<sup>4</sup> In another case the same learned chancellor said: “A name, though origi-

<sup>1</sup>R. Heinisch’s Sons Co. v. Boker, 86 Fed. Rep. 765-768.

<sup>2</sup>Atwater v. Castner, 88 Fed. Rep. 642; Anheuser-Busch Brewing Ass’n v. Piza, 24 Fed. Rep. 149; A. F. Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896; Southern White Lead Co. v. Cary, 25 Fed. Rep. 125; Same v. Coit, 39 Fed. Rep. 492; City of Carlsbad v. Thackeray, 57 Fed. Rep. 18; Cahn v. Gottschalk, 2 N. Y. Supp. 13; Hiram Walker & Sons v. Mikolas, 79 Fed. Rep. 955; Von Mumm v. Frash, 56 Fed. Rep. 830; Lea v. Wolff, 15 Abb. Pr. N. S. 1; 46 How. Pr. 147; Seb. 407; Anheuser-Busch Brewing Co. v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Manitowoc Pea-Packing Co. v. William Numsen & Sons, 93 Fed. Rep. 196.

<sup>3</sup>Ainsworth v. Walmsley, L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. N. S. 205; 14 L. T. N. S. 220; 14 W. R. 363; Seb. 257.

<sup>4</sup>Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137-142; Seb. 223.

nally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the individual who first affixed it."<sup>1</sup> In the first named case, any one named "Ainsworth" might lawfully use the words as a trade-mark. He would be restrained only where he resorted to unfair competition by so preparing or advertising his thread as to deceive customers into the belief that they were buying the thread made by the other Ainsworth. As to the dicta of Lord Westbury, they are meaningless, for the same reason. If a man's name is not a valid trade-mark for his goods in his life-time, because any one of the same name may use it for the same purpose, how can it possibly become a trade-mark in the use of his successors after his death?

§ 50. **Names of celebrities.**—Far different is the rule as to names which are those of celebrities, their use as trade-mark being universally recognized.<sup>2</sup> Yet here the scientific objection remains that any one bearing the name of the ill-fated Corsican would have the undoubted right to manufacture "Napoleon" cigarettes, notwithstanding the prior appropriation of that word as trade-mark by another manufacturer. If the words "Emperor Napoleon" were so appropriated, they would undoubtedly be good as against the world.<sup>3</sup>

<sup>1</sup>Hall v. Barrows, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; 3 N. R. 259; Seb. 215.

<sup>2</sup>"'Roger Williams,' though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be so applied the names of Washington, Greene, Perry, or of any other heroes, living or dead." Ames, C. J., in Barrows v. Knight, 6 R. I. 434; Cox, 238; Seb. 184. It has been so held of the word "Bismarck" (used as a trade-mark for paper collars) during the life-time of Bismarck. Messerole v. Tynberg, 36 How. Pr. 14; 4 Abb. Pr. N. S. 410.

<sup>3</sup>The learned English barrister Sebastian, in his work on Trade-marks, thus states the rule: "There is between a name of an individual or firm used as a trade-mark, and a fancy name or arbitrary

§ 51. **In general, of one's own name.**—Although the custom is universal for male persons to bear the name of their parents, there is nothing in the law prohibiting a man from taking any other name he may choose.<sup>1</sup> This doctrine has long been settled beyond peradventure. It is of course equally certain that one must not use his name so as to work a fraud upon others of the same name.<sup>2</sup> Subject to this restriction a man will never be restrained from the full enjoyment of his name, whether that name be that of his parents or adopted by

symbol used for the same purpose, a broad distinction which was early perceived and which caused some difficulty in the universal acceptance of a name as an efficacious trade-mark. The difference is, that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the christian name is commonly abbreviated to an initial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate." Sebastian, *Trade-marks* (3d ed.), 26.

<sup>1</sup> *England v. New York Pub. Co.*, 8 Daly, 375; *Price & Steuart*, 14; *Re Snook*, 2 Hilt. 566.

*The right to assume a name.*—Lord Chelmsford observes: "In this country we do not recognize the absolute right of a person to a particular name to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by an injunction. But the mere assumption of a name which is the patronymic of a family by a stranger who had never before been called by that name, whatever cause of annoyance it may be to the family, is a grievance for which our law affords no redress." *Du Boulay v. Du Boulay*, L. R. 2 P. C. 430-441; and see *Olin v. Bate*, 98 Ill. 53; 38 Am. Rep. 98, where injunction to restrain the use of an assumed name was denied under peculiar circumstances.

<sup>2</sup> The doctrine is well settled that "every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name, in such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But although he may thus use his name, he cannot

himself. As stated by Turner, L. J.: "Where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not."<sup>1</sup> Hence we see that the subject of this section is more properly treated under the head of unfair competition, and it is therefore considered in that connection elsewhere.

§ 52. **Trade-names, so-called.**—We have in the preceding sections given some consideration to the subject of proper names, considered with reference to their exclusive appropriation for mercantile purposes. The conclusion reached was that in a scientific sense there can be no trade-mark in a proper name, because all proper names are generic. The author believes that this rule is well sustained by the reasons heretofore given at length.

resort to any artifice or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name." Devens, J., in *Russia Cement Co. v. Le Page*, 147 Mass. 206-208; quoted and followed in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169-187. This is the rule announced in *Burgess v. Burgess*, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53. And see *Linoleum Mfg. Co. v. Nairn*, 7 Ch. Div. 834-837; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; 1 Trade-marks, 291; Dig. 536; *Croft v. Day*, 7 Beavan, 84; Dig. 76; *Holloway v. Holloway*, 13 Beavan, 209; Dig. 106; *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Montgomery v. Thompson*, (1891) App. Cas. 217; *Rogers v. Rogers*, 53 Conn. 121; 55 Am. Rep. 78; 33 Alb. L. J. 70; *Gilman v. Hunnewell*, 122 Mass. 139; Dig. 541; *Meneely v. Meneely*, 62 N. Y. 427; 1 Hun, 673; 2 Thomp. & C. 540; N. Y. Ct. of App. 62 N. Y. (17 Sickels), 427; 20 Am. Rep. 489; 2 Am. L. T. N. S. 482; Dig. 472; *Pillsbury v. Pillsbury*, 24 U. S. App. 395-404; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537; 31 Fed. Rep. 776; *Brown Chem. Co. v. Meyer*, 139 U. S. 540; 31 Fed. Rep. 453; *Coats v. Merrick Thread Co.*, 149 U. S. 562; 45 Off. Gaz. 347; *Singer Mfg. Co. v. Larsen*, 8 Bissell, 151-153; *Price & Steuart*, 72; *Singer Mfg. Co. v. Bent*, 163 U. S. 205.

<sup>1</sup>*Burgess v. Burgess*, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. O. S. 53; Dig. 117. A man cannot sell his own name to another for the purpose of carrying on a rival trade against another bearing the name so attempted to be used. *Melachrino v. Melachrino Cigarette Co.*, 4 R. P. C. 215; *Cartmell*, 223.

In their anxiety to effect perfect justice the courts have frequently said that such words were valid trade-marks,<sup>1</sup> but the reasoning of the opinions indicated that the use of the language adopted was careless and erroneous. The proper method of reading the class of cases just referred to is to bear in mind that, while the courts recognized the law of unfair competition, they did not know or recognize it by that name. The tendency was to restrain fraudulent competition, but to restrain it by invoking trade-mark law. In the inaccurate reasoning of the courts, the fact that a man whose name was "R. P. Hall" came into equity seeking an injunction against a defendant bearing a different name, but printing "R. P. Hall" upon his merchandise, suggested that the easiest manner of disposing of the issues was to say that Hall had a trade-mark right in his own name, which right the defendant was infringing.<sup>2</sup> So the defendant was very properly enjoined, justice was done, and the technical error of the decision was overlooked. For error it was, because the proper name Hall, even prefixed by the initials R. P., is a generic name which any one may use, provided that he does not so use it as to pass off his goods upon the purchasing public as the goods of another.

If any further proof were needed to show the rule to be accurate, we could examine the cases in which the use of a proper name could not possibly give a right of trade-mark, because the name was not used in application to merchandise. One of the most striking instances of this kind is afforded by the case in which a theatrical combination was protected in the use of the name "Christy's Minstrels."<sup>3</sup>

<sup>1</sup>Standinger v. Standinger, 19 Leg. Int. 85; Fulton v. Sellers, 4 Brews. 42; Candee v. Deere, 54 Ill. 439; Howe v. Howe Sewing Machine Co., 50 Barb. 236; Gillis v. Hall, 3 Brews. 509.

<sup>2</sup>Gillis v. Hall, 3 Brews. 509.

<sup>3</sup>Christy v. Murphy, 12 How. Pr. 77. In his opinion, Judge Clarke makes these prefatory remarks: "It is now well established that the court will grant an injunction against the use by one tradesman of the trade-marks of another. Will this protection be extended to enterprises undertaken for the purpose of affording amusement or recreation to the public?" The court instinctively, in his sense of

There is, however, a considerable class of words applied to places of business, and not to merchandise, which are not trade-marks, but may be conveniently called trade-names, and these are protected against unfair competition.<sup>1</sup> In using the expression "trade-name" however, it must be remembered that it is simply a colloquial term, used by the courts as a matter of convenience, and that it has no technical significance.

**§ 53. The use of proper names generally.**—From this preliminary discussion of the principles of unfair competition we can now undertake to classify what we may term, for want of a better phraseology, the proper-name cases.

(a) Where the defendant is using his own name in good faith. In these cases there is no unfairness in the competition between the parties, and the defendant will not be restrained.<sup>2</sup>

equity, saw that a wrong was being committed and that it ought to be enjoined, and he enjoined it. The remedy was just as effective and proper as if he had comprehended the law of unfair competition as treated in the later decisions. But if he had understood the principles he administered he would not have referred to the law of trade-marks to justify his conclusion.

<sup>1</sup>Weinstock, Lubin & Co. v. Marks, 109 Cal. 529-537.

<sup>2</sup>Burgess v. Burgess, 3 DeG. M. & G. 806; 17 Jur. 292; Seb. 117; Coats v. Platt, 17 Leg. Int. 213; Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, 401; Seb. 273; Wolfe v. Burke, 7 Lans. 151; 56 N. Y. 115; Meneely v. Meneely, 1 Hun, 367; 62 N. Y. 427; Seb. 472; Decker v. Decker, 52 How. Pr. 218; Seb. 525; Prince Metallic Paint Co. v. Carbon Metallic Paint Co., Seb. 573; Rodgers v. Nowill, 6 Hare, 325; Seb. 82; Clark v. Clark, 25 Barb. 76; Cox, 206; Seb. 148; Comstock v. White, 18 How. Pr. 421; Cox, 232; Binninger v. Wattles, 23 How. Pr. 206; Cox, 318; Seb. 240; Hardy v. Cutter, 3 Off. Gaz. 468; Seb. 427; Carmichel v. Latimer, 11 R. I. 395; 23 Am. Rep. 481; 16 Alb. L. J. 73; Seb. 521; Gilman v. Hunnewell, 122 Mass. 139; Seb. 541; McLean v. Fleming, 96 U. S. 245; 13 Off. Gaz. 913; Brown Chemical Co. v. Meyer, 139 U. S. 591; Cox, Manual, 726; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495; Landreth v. Landreth, 22 Fed. Rep. 41; Wm. Rogers Mfg. Co. v. R. W. Rogers Co., 66 Fed. Rep. 56; affirmed, 70 Fed. Rep. 1017; Wm. Rogers Mfg. Co. v. Rogers, 84 Fed. Rep. 639; Rogers v. Taintor, 97 Mass. 291; Thynne v. Shove, L. R. (1890) 45 Ch. D. 577-582; Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; Marcus Ward & Co. v. Ward, 15 N. Y. Supp. 913; 61 Hun, 625; Drummond Tobacco Co.

But in this connection it should be observed that one who enters into competition with another person of the same name, who has an old and established business, is under an obligation to more widely differentiate his goods from those of the latter than is required of third persons having different names.<sup>1</sup> A court of equity will direct a defendant, in such a case, how to use his name so as not to injure the complainant who bears the same name.<sup>2</sup> This direction has at times taken the form of an injunction restraining the party at fault from using his name in connection with his product, except in conjunction with the words "No connection with the original —" (giving the name and location of the other party), or words of like import.<sup>3</sup>

(b) Where the defendant is using his own name or that of another in a manner wilfully calculated to deceive the public into a belief that his goods are the goods of the plaintiff who bears the same name. This presents a state of facts that warrants the invocation of the injunctive power of equity; the decisions being practically unanimous.<sup>4</sup>

v. Randle, 114 Ill. 412; Newark Coal Co. v. Spangler, 54 N. J. Eq. 354; 34 Atl. Rep. 932; American Cereal Co. v. Pettijohn Cereal Co., 76 Fed. Rep. 372; affirming s. c., 72 Fed. Rep. 903; Duryea v. National Starch Mfg. Co., 45 U. S. App. 649; 79 Fed. Rep. 651; affirmed, 101 Fed. Rep. 117; Wm. Rogers Mfg. Co. v. Simpson, 54 Conn. 527; Foster v. Webster Piano Co., 13 N. Y. Supp. 338; 59 Hun, 624; Tussaud v. Tussaud, 38 W. R. 440; Iowa Seed Co. v. Dorrr, 70 Ia. 481; Turton & Sons (Ltd.) v. Turton, 42 Ch. D. 128.

<sup>1</sup>Baker & Co. v. Baker, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889-895.

<sup>2</sup>Baker & Co. v. Baker, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; Tarrant & Co. v. Hoff, 76 Fed. Rep. 959; affirming s. c., 71 Fed. Rep. 163; Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889-894; City of Carlsbad v. Schultz, 78 Fed. Rep. 469. In the last named case Judge Coxe designed a label for the defendant's use, a copy of which is embodied in his opinion.

<sup>3</sup>Allegretti Chocolate Cream Co. v. Keller, 85 Fed. Rep. 643.

<sup>4</sup>Holloway v. Holloway, 13 Beav. 209; Seb. 106; Burgess v. Burgess, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53; Seb. 117; Taylor v. Taylor, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124; Clark v. Clark, 25 Barb. 76; Cox, 206; Seb. 148; Stonebraker v. Stonebraker, 33 Md. 252; Seb. 333; Holmes, Booth & Hay-



"Every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But, although he may thus use his name, he cannot resort to any artifice or to any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name. Where the name is one which has previously thereto come to indicate the source of manufacture of particular devices, the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception alluded to in the foregoing adjudications."<sup>1</sup>

*dens v. Holmes, Booth & Atwood Mfg. Co.*, 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; *James v. James*, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388; *McLean v. Fleming*, 96 U. S. 245; 13 Off. Gaz. 913; *Thorley's Cattle Food Co. v. Massam*, 42 L. T. N. S. 851; Cox, Manual, 668; *Russia Cement Co. v. Le Page*, 147 Mass. 206; 44 Off. Gaz. 823; Cox, Manual, 706; *Brown Chemical Co. v. Meyer*, 55 Off. Gaz. 287; 139 U. S. 540; *Meyer v. Bull Medicine Co.*, 66 Off. Gaz. 197; 18 U. S. App. 372; 7 C. C. A. 558; 58 Fed. Rep. 884; *Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; *Wm. Rogers Mfg. Co. v. R. W. Rogers Co.*, 66 Fed. Rep. 66; 73 Off. Gaz. 970; *DeLong v. DeLong Hook & Eye Co.*, 74 Off. Gaz. 809; *Garrett v. Garrett & Co.*, 79 Off. Gaz. 1681; 78 Fed. Rep. 472-478; *Baker & Co. v. Baker*, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; *Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. Rep. 495; *Price & Steuart*, 621; *Tuerk Power Co. v. Tuerk*, 36 N. Y. Supp. 384; 92 Hun, 65; *Gillis v. Hall*, Cox, 596; *Devlin v. Devlin*, 69 N. Y. 212; *Tussaud v. Tussaud*, 38 W. R. 440; *Frazer v. Frazer Lubricating Co.*, 121 Ill. 147; *Shaver v. Shaver*, 54 Ia. 208; *India Rubber Comb Co. v. Rubber Comb Co.*, 45 N. Y. Super. Ct. R. 258; *Gage v. Canada Pub. Co.*, 11 Can. Sup. 306; *Rogers Co. v. Wm. Rogers Mfg. Co.*, 70 Fed. Rep. 1017; *Landreth v. Landreth*, 22 Fed. Rep. 41; *Manufacturing Co. v. Simpson*, 54 Conn. 527; *Rogers v. Rogers*, 53 Conn. 121; *Hohner v. Gratz*, 52 Fed. Rep. 871; *Williams v. Johnson*, 2 Bos. 1; Cox, 214; *Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243; reversing s. c., 85 Fed. Rep. 778.

<sup>1</sup>*Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169. "A man may not use his own name to accomplish a fraud, designed or constructive." *Jenkins, J.*, in *Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243-248.

(c) Where the defendant is a corporation whose corporate name includes a proper name and was selected by its incorporators with the intent and for the purpose of deceiving the public into the belief that its goods are the goods of the plaintiff. Such frauds will of course be enjoined.<sup>1</sup>

(d) Where the defendant has, solely for the purpose of unfair trade, secured from some person having the same name as the plaintiff a license to use that name for the purpose of fraudulently competing with the plaintiff. This, being an artifice in promotion of unfair trade, renders the defendant liable to injunction.<sup>2</sup>

Finally, in regard to the assignment of the right to use one's name, the law is well settled that a man can so assign the right to use his name subject only to the general rules of public policy governing contracts in restraint of trade.

The right to use the name Booth, in connection with a theatre, described in the assignment of a lease as "Booth's Theatre," was held to pass to the assignee because it had become affixed to the establishment;<sup>3</sup> and it may follow that proper names attached to or used in connection with places of amusement generally would pass to an assignee without specific enumeration in the instrument of assignment.

It was suggested in the case of *Christy v. Murphy*, involving the right to use the words "Christy's Minstrels," that if the plaintiff had seen fit to do so he could have conveyed to the defendants an irrevocable license to use that name in connection with that form of theatrical

<sup>1</sup> *Wm. Rogers Mfg. Co. v. R. W. Rogers Co.*, 73 Off. Gaz. 970; 84 Fed. Rep. 639; *Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. Rep. 495; *Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 402; *Plant Seed Co. v. Michel Plant & Seed Co.*, 23 Mo. App. 579; *Garrett v. T. H. Garrett & Co.*, 78 Fed. Rep. 472; *Clark Thread Co. v. Armistage*, 74 Fed. Rep. 936; *Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243; reversing s. c., 85 Fed. Rep. 778.

<sup>2</sup> *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215; *Cartmell*, 223; *Sawyer v. Kellogg*, 7 Fed. Rep. 720; *Cox*, Manual, 681; *R. Heinisch's Sons Co. v. Boker*, 86 Fed. Rep. 765; *Garrett v. T. H. Garrett & Co.*, 78 Fed. Rep. 472.

<sup>3</sup> *Booth v. Jarrett*, 52 How. Pr. 169; *Seb*, 524.

enterprise.<sup>1</sup> But in the more recent case of *Messer v. The Fadettes*, the supreme court of Massachusetts, Lathrop, J., dissenting, refused to recognize an assignment of the name of an orchestra, holding that while the organizer and conductor of a musical organization may have some right of ownership in it, such right is purely personal, depending upon the personal reputation or skill of the conductor, and is therefore not assignable; and that the continued use of the name would mislead and therefore work a fraud upon the public.<sup>2</sup> While the name involved ("The Fadettes") is not the name of a person, the decision is properly noticed here as a striking departure from the doctrine of *Christy v. Murphy*, *supra*, and from what the author conceives to be the law. The dissenting opinion of Justice Lathrop is well grounded on authority, and the reader is referred to it for his reasoning. Briefly, the court ought to have done as has been done in the federal courts, namely, it should have instructed the assignee of the name "The Fadettes" how to use that name in its advertising matter so as not to deceive the public into a belief that the orchestra was still under the personal direction of its former manager and director. To hold that the assignment was void was to put a premium on dishonesty. The court erred in neglecting its duty to instruct the assignee how to use the name—the right to use which he had bought and paid for—as not to work a fraud upon the public; its power and duty in this respect have been judicially defined.<sup>3</sup>

One who has assigned the right to use his name in specific trade will be enjoined from using his own name in that trade, in competition with his assignee, for such competition would be unfair and fraudulent.<sup>4</sup> Promoters

<sup>1</sup>*Christy v. Murphy*, 12 How. Pr. 77; Cox, 164; Seb. 137.

<sup>2</sup>*Messer v. The Fadettes*, 168 Mass. 140.

<sup>3</sup>*Baker & Co. v. Baker*, 77 Fed. Rep. 181; *Tarrant & Co. v. Hoff*, 76 Fed. Rep. 959; s. c., 71 Fed. Rep. 163; *Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889-894; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469-472. In the last named case Judge Coxe went so far as to design a label for the defendant's use, which is embodied in fac-simile in his opinion.

<sup>4</sup>*Meyers v. Kalamazoo Buggy Co.*, 54 Mich. 215; *Thynne v. Shove*,

of a corporation whose names have been used as a part of the corporate name cannot be permitted to use their names in connection with and as the name of a rival company. Such conduct will be enjoined because of "the injury to the party aggrieved, and the imposition upon the public, by causing them to believe that the goods of one man or firm are the production of another."<sup>1</sup>

The care with which equity protects the names of corporations is well recognized; the reason being found in the fact that its name is a vital essential of a corporation.<sup>2</sup>

In conclusion, the general rule underlying this class of cases has been aptly stated as follows: "All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so."<sup>3</sup>

§ 54. **Corporate names.**—Upon this subject the courts are hopelessly confused in their phraseology. There can be no trade-mark right in a corporate name, for the conclusive reason that it is not, as such, applied to the subject-matter of commerce. In an early case Judge Deady, of Oregon, said, "The corporate name of a corporation is a trade-mark from the necessity of the thing,"<sup>4</sup> and this very phrase, with other dicta, has been quoted with ap-

L. R. (1890) 45 Ch. D. 577; *Wood v. Sands*, Seb. 467; *Russia Cement Co. v. Le Page*, 147 Mass. 206; *Kidd v. Johnson*, 100 U. S. 617; *Spieker v. Lash*, 102 Cal. 38-45; *Hoxie v. Chaney*, 143 Mass. 592; *Skinner v. Oakes*, 10 Mo. App. 45; *Grow v. Seligman*, 47 Mich. 647; *Churton v. Douglas*, Johns. 174; 28 L. J. Ch. 841; 5 Jur. N. S. 887; 33 L. T. 57; 7 W. R. 365. And where the assignor has acquiesced in the opening of mail addressed to him, by his assignee, he will be enjoined from receiving and opening such mail addressed to him. *Dr. David Kennedy Corp. v. Kennedy*, 55 N. Y. Supp. 917.

<sup>1</sup>*Holmes, Booth & Haydens v. The Holmes, Booth & Atwood Mfg. Co.*, 37 Conn. 278; 9 Am. Rep. 324; Seb. 340.

<sup>2</sup>*Investor Pub. Co. v. Dobinson*, 72 Fed. Rep. 603; s. c., 82 Fed. Rep. 56.

<sup>3</sup>*Lowell, J., in Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. Rep. 495-499.

<sup>4</sup>*Newby v. Railroad Co.*, Deady, 609. "The name of a corporation has been said to be the 'knot of its combination,' without which it cannot perform its corporate functions." *Wallace, J., in Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co.*, 21 Fed. Rep. 276.

proval in a more recent case.<sup>1</sup> The author has in a former section collected the judicial definitions of trade-mark, and it is a scientific impossibility to bring Judge Deady's dictum within the scope of either of those definitions, or to extend the definitions to include that dictum. Justice Clifford's definition may be referred to as making the author's position clearer.<sup>2</sup> It is entirely erroneous to treat a corporate name as being a trade-mark.

This error has arisen from the unfamiliarity of the courts with the essential requirements of technical trade-marks, and the fact that equitable relief had to be administered in cases where the courts had no precedents at hand except in the trade-mark decisions, which afforded similar reasoning to support their conclusions.

The reason why equity intervenes to protect corporate names from imitation is that they are essential parts of the being of corporations, or, as expressed by the supreme court of Missouri, its name is a necessary element of the existence of a corporation.<sup>3</sup> The courts, therefore, will protect a corporation in the use of its name in the absence of any express statutory enactment.<sup>4</sup> The exercise of this power is an enforcement of the law of unfair competition as shown in the following language of Bradley, J.: "Fair competition in business is legitimate, and promotes the public good; but an unfair appropriation of another's business, by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity."<sup>5</sup> This dictum is contained in the opinion in the Celluloid case, where the corporate name happened to be the trade-mark applied by the corporation to merchandise manufactured and

<sup>1</sup>Investor Pub. Co. v. Dobinson, 72 Fed. Rep. 603-606.

<sup>2</sup>McLean v. Fleming, 96 U. S. 245-254.

<sup>3</sup>State v. McGrath, 92 Mo. 357.

<sup>4</sup>Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co. of Kansas, 1 N. Y. Supp. 44; William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Investor Pub. Co. v. Dobinson, 72 Fed. Rep. 603.

<sup>5</sup>Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

sold by it. It is a self-evident proposition that a generic word embodied in a corporate name is not entitled to protection in equity. The rule was thus stated by Mr. Justice Field, in delivering the opinion of the United States supreme court in a case where the Goodyear Rubber Co. sought to restrain another corporation from using the name "Goodyear's Rubber Manufacturing Co." He said: "The name of 'Goodyear Rubber Company' is not one capable of exclusive appropriation. 'Goodyear Rubber' are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them. Thus parties united to produce or sell wine, or to raise cotton or grain, might style themselves wine company, cotton company, or grain company; but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles and to publish the fact to the world. Names of such articles cannot be adopted as trademarks, and be thereby appropriated to the exclusive right of any one, nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name."<sup>1</sup>

<sup>1</sup>Mr. Justice Field, in *Goodyear Co. v. Goodyear Rubber Co.*, 128 U. S. 598-602; reversing s. c., 21 Fed. Rep. 276. Thus in an action by one fire insurance company to restrain another from the use of the word "Continental" in its corporate name, the court said: "The distinguishing feature of the names of the two incorporated companies is the word 'Continental.' It is the use of this word by the defendant which the complainant seeks to enjoin. It is the contention of the complainant that, by reason of the long-continued use of this word by it, and the fact that it has built up a large and lucrative business under this distinguishing name, it has secured a property right in said word 'Continental,' in connection with its incorporated name, and it is entitled to the exclusive use of the word 'Continental,' in connection with its insurance business, in the sections of

A foreign corporation cannot, by application to a court in the state in which a new corporation is being organized, secure an injunction restraining the formation of the new corporation under the same corporate name as that of the plaintiff. But in dismissing a bill brought for such a purpose, Judge Gresham said: "I do not say what may be done if the defendants succeed in creating their corporation bearing the complainant's name, and a suit shall be brought by the complainant to prevent individuals claiming to be officers or managers of such corporation from interfering with the complainant's business."<sup>1</sup>

In conclusion, there is no practical difference, so far as equitable rights and remedies are concerned, between corporate names and the name of a copartnership or an individual. As said by Mr. Justice Bradley, on circuit, in dealing with the names of corporations plaintiff and defendant, "the fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known, and are to be dealt with precisely as if they were the names of private firms or partnerships."<sup>2</sup>

the country where it is engaged in such business. Upon the showing made by the complainant, it might be entitled to the relief sought, were the distinguishing word of its corporate name such a one as could be exclusively appropriated in the designation or conduct of a business by a person, firm or corporation. The word 'continental' is in general and prevalent use, and means pertaining to or characteristic of a continent. As applied to or designating an insurance company, it would be descriptive of the bounds within which such company carried on its business. The scope of the business carried on by many insurance companies is continental in extent. A term which can be truthfully used by many in the description of a business or occupation cannot be exclusively appropriated by any one of them. The word 'continental' is a generic term, and it is not the policy of the law to permit the exclusive appropriation of words or terms which are generic; that is, which pertain to a class of related things, and which are of general application. The right to use such words should remain vested in the public." Meek, J., in *Continental Ins. Co. v. Continental Fire Ass'n*, 96 Fed. Rep. 846-848; affirmed, 101 Fed. Rep. 255. To the same effect see *Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44.

<sup>1</sup>*Lehigh Valley Coal Co. v. Hamblen*, 23 Fed. Rep. 225, 226.

<sup>2</sup>*Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. Rep. 94-97.

A corporation cannot, by securing a license from or employing a person bearing the desired proper name, so use that name as part of its corporate name as to maintain an unfair competition with an older business employing the name.<sup>1</sup>

<sup>1</sup>Garrett v. T. H. Garrett & Co., 78 Fed. Rep. 472.



## CHAPTER IV.

### TRADE-MARK RIGHTS IN TITLES OF BOOKS AND PERIODICALS.

§ 55. **Trade-mark in title of a book.**—Upon this subject there has been less harmony of opinion than would be expected. It has been said by the court of appeals of Maryland that “A publisher has either in the title of his work or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade-mark.”<sup>1</sup>

Mr. Browne in his learned treatise on trade-marks says: “Can printed books be protected by trade-marks? Yes, as mere merchandise; no, as literary productions.”<sup>2</sup> This is true, in so far as it asserts that marks or devices may be used to distinguish the product of the publisher or book dealer.<sup>3</sup> He says further: “There seems to be no sufficient reason why the title of a book may not be deemed a valid trade-mark,”<sup>4</sup> and thereby expresses the error contained in the careless dictum of the Maryland court quoted above. The correct view is stated in clear terms by Mr. Rowland Cox, in his note to *Clemens v. Bedford*:<sup>5</sup> “It is necessarily true that the name of a book is, under all circumstances, a descriptive term which means a particular thing. The book is created and given a name, and the name is added to the language as a term of description. If a copyright is taken, the owner of the copyright enjoys, as long as the privilege continues, the

<sup>1</sup>Robertson v. Berry, 50 Md. 591; Price & Steuart, 153.

<sup>2</sup>Browne, Trade-marks, sec. 116.

<sup>3</sup>Mr. Browne cites six cases in support of this proposition, neither one of which is applicable. All related to property right in the title of a periodical publication.

<sup>4</sup>Browne, Trade-marks, sec. 118.

<sup>5</sup>14 Fed. Rep. 728; Cox, Manual, 685.

exclusive right to the use of the name; and when the privilege expires, the name, always a descriptive term, becomes *publici juris*. If the book is not copyrighted, the literary matter becomes *publici juris* as soon as it is published, and the name of the literary matter goes to the public as an incident of that which it describes. If there is language in some of the cases which seems to indicate that the name of a book can be protected as a trade mark, reflection will demonstrate that it cannot be made good. The names of periodicals and newspapers, as distinguished from books, are protected as in the nature of trade-marks; and in many instances the publications in connection with which the names have been used were proper subjects of copyright. In some cases they contained, or might have contained, articles in connection with which the statutory privilege had been acquired. But the name which has been protected has never been simply the name of a book, but always that of a constantly changing series. Thus the term 'Old Sleuth Library' was distinctly arbitrary, and never the name of a particular book or literary production, and for this reason it was in an accurate sense a trade-mark, and must continue to be as long as the publication was continued. But if the publication of the periodical were discontinued for a period of years, the name would cease to be arbitrary and take its place in literature as indicating a definite collection of articles, pictures, etc., and as soon as it acquired that settled meaning, it would, in the absence of copyright, become *publici juris*."

It is now established law that there is no trade-mark right in the title of a book. Judge Wallace stated the rule very lucidly when he said: "Neither the author or proprietor of a literary work has any property in its name. It is a term of description, which serves to identify the work; but any other person can with impunity adopt it, and apply it to any other book, or to any trade commodity, provided he does not use it as a false token to induce the public to believe that the thing to which it is applied is the identical thing which it originally des-

ignated. If literary property could be protected upon the theory that the name by which it is christened is equivalent to a trade-mark, there would be no necessity for copyright laws."<sup>1</sup> This doctrine is fully sustained by the later cases.<sup>2</sup>

**§ 56. Trade-mark in title of periodical.**—In 1859 Vice-Chancellor Stuart enjoined a defendant who had begun the publication of "The Penny Bell's Life and Sporting News" from publishing any newspaper under that name, or any other name in which the words "Bell's Life" should occur, the application being made by the proprietors of "Bell's Life in London." In the course of his opinion the vice-chancellor said: "This is an application in support of the right to property."<sup>3</sup> Thus was distinctly recognized the right of trade-mark in the title of a periodical publication. Long prior to this time, however, equity had suppressed this species of piracy between publishers, the first reported case being that of *Hogg v. Kirby*, where the complainant was the proprietor of a magazine called "The Wonderful Magazine" and the defendant's publication bore substantially the same name with the addition of the words "New Series, Improved." The injunction was granted by Lord Eldon.<sup>4</sup>

In the United States Chancellor Sandford was the first to recognize this right, in 1825, although he refused to enjoin the use of the title "The New York National Advocate" on the application of the proprietor of "The National Advocate," both being applied to newspapers

<sup>1</sup>Black v. Ehrich, 44 Fed. Rep. 793, 794.

<sup>2</sup>Merriam v. Holloway Pub. Co., 43 Fed. Rep. 450 (opinion by Mr. Justice Miller on circuit); Merriam v. Famous Shoe and Clothing Co., 47 Fed. Rep. 410 (opinion by Judge Thayer); Merriam v. Texas Siftings Pub. Co., 49 Fed. Rep. 944 (opinion by Judge Shipman).

<sup>3</sup>Clement v. Maddick, 1 Giff. 98; 5 Jur. N. S. 592; 33 L. T. 117; Seb. 174.

<sup>4</sup>Hogg v. Kirby, 8 Ves. 215; Seb. 10. Lord Eldon also restrained a defendant from the publication of a court calendar which he was issuing as a continuation of the complainant's work. Longman v. Winchester, 16 Ves. 260; Seb. 15.

published in the city of New York, holding the names to be substantially different; and this notwithstanding the fact that the defendant had been the editor for the publisher who had sold "The National Advocate" to the complainant. The chancellor did not expressly hold the title of the paper to be a trade-mark, but treated it as part of the good-will of the printing establishment.<sup>1</sup> Indeed he seems to have treated the subject solely from the standpoint of unfair competition, ignoring the question of technical property right, as did Chancellor Walworth in 1840 in refusing to enjoin the use of the title "New Era" on the application of complainants who published the "Democratic Republican New Era," saying, *inter alia*, "There could be very little excuse for the editor of a new paper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons."<sup>2</sup>

In 1867, however, a clear cut opinion of the court of common pleas of the city of New York recognized the property right in unmistakable terms. The plaintiffs, proprietors of the "National Police Gazette," applied for an injunction to restrain the publication of the "United States Police Gazette" by the defendants. Brady, J., said: "The title of a newspaper may be a purely original one, and the proprietor for that reason entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire an exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words in common use. . . . It also appears that the plaintiffs' paper has been published weekly under that name for many years, . . . that its circulation is large and valuable, and that it was the only police gazette, *eo nomine*, published in the United States at the time of the publication of the paper complained of by them. . . . From these facts it is

<sup>1</sup> Snowden v. Noah, Hopkins, Ch. R. 347; Cox, 1; Seb. 41.

<sup>2</sup> Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

apparent that the plaintiffs have acquired a right connected with the publication of a newspaper called the National Police Gazette, which must be preserved against any fraud attempted to be perpetrated against them.”<sup>1</sup>

Subsequently the superior court of New York City, per Monell, J., said: “I do not understand that the protection which the law affords to ‘trade-marks,’ even assuming the name of a newspaper to be a trade-mark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some particular manufacture or business. There can be no such property in a newspaper except, perhaps, in the name or title of the paper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trade-marks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character.”<sup>2</sup>

As late as 1881 Sir George Jessel, master of the rolls, said: “It does not appear to me that there was any invention in the combination of ‘Splendid Misery,’ any more than there would be in the words ‘Miserable Sinner,’ or anything of that kind. The adoption of the words as the title of a novel might make a trade-mark.”<sup>3</sup>

In 1898 the appellate division of the supreme court of New York said it could not follow the reasoning of counsel “when he contends that the public, by its short way of referring to the ‘Commercial Advertiser,’ has given the plaintiff some kind of an undefined trade-mark

<sup>1</sup>Matsell v. Flanagan, 2 Abb. Pr. N. S. 459; Cox, 367; Seb. 270.

<sup>2</sup>Stephens v. De Conto, 7 Robertson, 343; 4 Abb. Pr. N. S. 47; Cox, 442; Seb. 295. The learned court cites an opinion holding that a newspaper or price current cannot be copyrighted because the term science cannot, with any propriety, be applied to a work of so fluctuating and fugitive a form. Clayton v. Stone, 2 Paine, 382-392.

<sup>3</sup>Dicks v. Yates, L. R. 18 Ch. D. 76-88.

in this popular form of speech,—a doctrine which would equally apply to a ‘sobriquet’ or diminutive; that its unauthorized use by the defendant, whether likely to injure the plaintiff or not, should be absolutely enjoined as an invasion of a strict property right.”<sup>1</sup>

While, on the other hand, the United States circuit court for the district of New Jersey had held in 1894 that the words “Social Register,” applied by a publisher to a directory of a certain locality, containing names of persons resident therein, selected with reference to the personal and social standing of such persons, “become a trade-mark, and are entitled to protection as such.”<sup>2</sup>

From our cursory view of the foregoing decisions and dicta it is plainly manifest that the right to technical trade-mark in the title of a periodical has been affirmed and denied with some show of reason upon each side. The subject has been ably discussed by Mr. Browne, who concludes that the name so used is a technical trade-mark.<sup>3</sup> In that conclusion we must coincide, and it is well sustained by the reasoning of Mr. Rowland Cox, which we have before quoted.<sup>4</sup> But the fact is patent that it is still a mooted question, and that the solicitor attempting to restrain piracy of this kind would better frame his bill upon unfair competition and not upon technical trade-mark. The New York supreme court, in its decision above referred to, says that “the fundamental doctrine upon which relief in this class of cases is afforded” is that of “misleading or the tendency to mislead, with consequent injury, actual or probable.”<sup>5</sup>

<sup>1</sup>Commercial Advertiser Ass’n v. Haynes, 49 N. Y. Supp. 938-942.

<sup>2</sup>Social Register Ass’n v. Howard, 60 Fed. Rep. 270, 271.

<sup>3</sup>Browne, Trade-marks (2d ed.), sec. 115. As instances of injunction restraining use of infringing titles of periodicals, see Edmonds v. Benbow, Seton (3d ed.), 905; Re Edinburgh Correspondent Newspaper, Ct. of Sess. Cas. 1st ser. I (new ed.), 407 n.; Cox, Manual, No. 34.

<sup>4</sup>Note to Clemens v. Belford, 14 Fed. Rep. 728; Cox, Manual, 684; *ante*, § 55.

<sup>5</sup>Commercial Advertiser Ass’n v. Haynes, 49 N. Y. Supp. 938-942; citing Bradbury v. Beeton, 39 Law J. Ch. 57; Ingram v. Stiff, 5 Jur. N. S. 947; Lee v. Haley, 5 Ch. App. Cas. 155; Clement v. Maddick, 5 Jur.

N. S. 592. And see *Snowden v. Noah*, Hopkins, Ch. 347; *Bell v. Locke*, 8 Paige, 75; *Talcot v. Moore*, 6 Hun, 106; *Stephens v. DeConto*, 4 Abb. Pr. N. S. 47; *Matsell v. Flanagan*, 2 Abb. Pr. N. S. 459; *Publishing Co. v. Dobinson*, 82 Fed. Rep. 56; *Richardson & Boynton Co. v. Richardson & Morgan Co.*, 8 N. Y. Supp. 53; *Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co.*, 1 N. Y. Supp. 44; *Borthwick v. Evening Post*, L. R. 37 Ch. D. 449; *Estes v. Leslie* (2), 29 Fed. Rep. 91; *Estes v. Leslie* (1), 27 Fed. Rep. 22; *Estes v. Worthington*, 31 Fed. Rep. 154.

## CHAPTER V.

### THE LOSS OF THE RIGHT TO A TRADE-MARK'S USE.

§ 57. **Laches.**—There is no laches where a complainant is only waiting to get a sufficient quantity of evidence to secure a successful prosecution of the infringer,<sup>1</sup> and of course none exists where the complainant has no knowledge of the fact of infringement;<sup>2</sup> and it has been distinctly held by the federal supreme court that an injunction will not generally be refused on the ground of delay alone.<sup>3</sup> Following that decision, it was said by Judge Nixon, in the United States circuit court in the district of New Jersey: "There has been large discussion of the question how far laches, in stopping the infringement of a trade-mark, will deprive a complainant of the benefits of a preliminary injunction. But that discussion has been put to rest, so far as this court is concerned, by the recent decision of the supreme court in the case of *McLean v. Fleming*,<sup>4</sup> where it was held that acquiescence of long standing was no bar to an injunction, although it precluded the party acquiescing from any right to an account for past profits."<sup>5</sup>

The rule has always been, however, that laches on the part of the owner of a trade-mark would be a bar to his application for a preliminary injunction. Judge Wallace stated the rule as follows: "Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, appar-

<sup>1</sup> *Cave v. Myers*, Seton (4th ed.), 238; *Lee v. Haley*, 22 L. T. N. S. 251.

<sup>2</sup> *Re Farina*, 27 W. R. 456; *Seb.* 642; *Weldon v. Dick*, L. R. 10 Ch. D. 247; 39 L. T. N. S. 467; *Seb.* 638; *Taylor v. Carpenter* (1), 3 Story, 458; *Cox*, 14; *Seb.* 78; *Taylor v. Carpenter* (2), 2 Wood. & M. 1; *Cox*, 32; 9 L. T. 514; *Gilka v. Mihalovitch*, 50 Fed. Rep. 427.

<sup>3</sup> *McLean v. Fleming*, 96 U. S. 245.

<sup>4</sup> *Supra.*

<sup>5</sup> *Consolidated Fruit Jar Co. v. Thomas*, *Cox*, 665. And see *La Republique Française v. Schultz*, 102 Fed. Rep. 153.



ently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a lawsuit, and delayed legal proceedings until his patience was exhausted. When delay of the owner of a patent or trade-mark to prosecute infringers has been of a tendency to mislead the public or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing."<sup>1</sup>

**§ 58. Laches and acquiescence distinguished.**—"Laches" and "acquiescence" are terms frequently used synonymously, or at least without due regard to their respective meanings. "Laches" imports a merely passive, while "acquiescence" implies an active assent.<sup>2</sup> The supreme court of California has said, "'Laches' would strictly seem to imply neglect to do that which ought to have been done; 'acquiescence' a resting satisfied with or submission to an existing state of things."<sup>3</sup>

"Acquiescence—that is, assent—is tantamount to an agreement."<sup>4</sup> The supreme court of the United States, by Mr. Justice Swayne, has said: "Acquiescence and waiver are always questions of fact. There can be neither without knowledge. The terms import this foundation for such action. One cannot waive or acquiesce in a wrong while ignorant that it has been committed. Current suspicion and rumor are not enough. There must be knowledge of facts which will enable the party to take effectual action."<sup>5</sup>

**§ 59. Acquiescence.**—"The consent of a manufacturer to the use or imitation of his trade-mark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or im-

<sup>1</sup> *Estes v. Worthington*, 22 Fed. Rep. 822.

<sup>2</sup> *Wood on Limitations*, sec. 62.

<sup>3</sup> *Lux v. Haggin*, 69 Cal. 255-269.

<sup>4</sup> *Matthews v. Murchison*, 17 Fed. Rep. 760-766.

<sup>5</sup> *Pence v. Langdon*, 99 U. S. 578-581. See also *Allen v. McKeen*, 1 Sumn. 276-314; *Evans v. Smallcombe*, L. R. 3 H. L. 249; *Ramsden v. Dyson*, L. R. 1 H. L. 129; *Reed v. West*, 47 Tex. 240.

plied, when purely gratuitous, may certainly be withdrawn; and when implied, it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license. The existence of the fact may be a proper subject of inquiry in taking an account of profits if such an account shall hereafter be decreed; but even the admission of the fact would furnish no reason for refusing an injunction."<sup>1</sup> This dictum of Judge Duer in *Amoskeag Mfg. Co. v. Spear* is so comprehensive as to warrant its extended quotation above given. While it was held by Vice-Chancellor Wood that a plaintiff's acquiescence in the defendant's use of his mark for two years after the plaintiff had seen it publicly exhibited would disentitle him to relief,<sup>2</sup> an injunction was granted in a case where a dissenting opinion shows that the essential feature of the mark had been used by others than plaintiff with his knowledge for more than twenty years.<sup>3</sup> It has been held in a federal circuit court that acquiescence for a time equal to that prescribed in the statute of limitations must be shown.<sup>4</sup> Acquiescence cannot be inferred, and it is revocable if it could be.<sup>5</sup>

"In England the rule is stringent in trade-mark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reason-

<sup>1</sup>*Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C. 599; Cox, 87. The withdrawal of gratuitous permission to use one's name may be made at the pleasure of the party granting such permission. *McCardel v. Peck*, 28 How. Pr. 120.

<sup>2</sup>*Beard v. Turner*, 13 L. T. R. N. S. 747; Cox, 717.

<sup>3</sup>*Gillott v. Esterbrook*, 47 Barb. 455; Cox, 340. Dissent of Ingraham, J.

<sup>4</sup>*Taylor v. Carpenter* (2), 2 Wood. & M. 1; Cox, 32. But "laches for even less than the statutory period of limitations, aided by other circumstances, will bar a right." *Acheson, J., in Prince's Met. Paint Co. v. Prince Mfg. Co.*, 57 Fed. Rep. 938-944, where the plaintiff was held to be estopped by eight years' acquiescence.

<sup>5</sup>*Gillott v. Esterbrook*, *supra*; *Amoskeag Mfg. Co. v. Spear*, *supra*; *Christy v. Murphy*, 12 How. Pr. 77; Cox, 164; Seb. 137; *Menendez v. Holt*, 128 U. S. 514.

able diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant."<sup>1</sup>

§ 60. **Abandonment.**—The consideration of laches and acquiescence leads us naturally to the subject of abandonment. The first form of abandonment is by disuse of the mark. "That the right to use a trade-mark may be lost by abandonment or disuse is too clear to need argument or the support of authority."<sup>2</sup> But the length of time during which the mark is not used is immaterial except when it is such as, taken in connection with all the circumstances, will show the intention of its owner to abandon it. "A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose he lost his trade-mark by not putting more goods on the market when it was glutted."<sup>3</sup> Registration was refused in England where the applicant's mark "Emollio" had not been used by him for eleven years, and his application was opposed by one who had, in the meantime, registered the word "Emolline" as a trade-mark for articles similar to those upon which the applicant intended to affix his mark (perfumery).<sup>4</sup> Before the courts will declare an abandonment by disuse there must be satisfactory proof of intention of abandonment. It has been suggested by Chitty, J., that such intention will be gathered from the owner's acts in breaking up the moulds by which the mark is made, and taking the trade-marked article from his price lists.<sup>5</sup>

<sup>1</sup>Nixon, J., in *Sawyer v. Kellogg*, 9 Fed. Rep. 601.

<sup>2</sup>Hughes, J., in *Blackwell v. Dibrell*, 3 Hughes, 151; 14 Off. Gaz. 633; *Price & Steuart*, 39; Seb. 590; *Laverne v. Hooper*, Ind. L. R. 8 Mad. 149; *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376.

<sup>3</sup>Chitty, J., in *Monson v. Boehm*, L. R. 26 Ch. D. 398-406; *Cartmell*, 233.

<sup>4</sup>*Re Grossmith*, 6 R. P. C. 180; 60 L. T. N. S. 612; *Cartmell*, 137.

<sup>5</sup>*Monson v. Boehm*, L. R. 26 Ch. D. 398-405; *Cartmell*, 233.

It must be borne in mind, in this connection, that the defense of abandonment is not favored by the courts. One judge has said, "there is something very abhorrent in allowing such a defense to a wrong,"<sup>1</sup> although as a matter of course a trade-mark once abandoned may be adopted by another for the same class of merchandise.<sup>2</sup> There must be clear proof of the fact of abandonment,<sup>3</sup> and it ought to be clearly shown that any other person is adopting the same mark fairly and honestly, and not in an attempt to filch from its original owner the reputation he has obtained for it.<sup>4</sup> What act or acts will constitute an abandonment must be determined by the facts in each particular case. One English decision held that a dismissal of a bill for injunction was an abandonment of the trade-mark sought to be protected by the bill.<sup>5</sup>

The abandonment of names used in connection with particular premises where selling or manufacturing is conducted has led to some apparent conflicts of opinion among the courts. Careful analysis of the facts will show that there is some semblance of harmony in the rulings. Whether a removal from the premises will constitute an abandonment of the use of the name depends on whether the name indicates the building itself, or merely the business conducted therein. Thus, "Booth's Theatre" designated the theatre and not the actor, and upon its sale by Edwin Booth he could not restrain his vendee from the use of the name, as Messrs. Jarrett & Palmer had fully advertised the fact that they were lessees and managers, and no question of fraud could be raised.<sup>6</sup> As stated by Wallace, J., in *Atlantic Milling Co. v. Robinson*: "The right to the exclusive use of a word or symbol as a trade-mark is inseparable from the right to make and sell the commodity which it has been appropriated

<sup>1</sup>Woodbury, J., in *Taylor v. Carpenter* (2), 2 Wood. & M. 1; Cox, 32.

<sup>2</sup>Holt v. Menendez, 128 U. S. 514; *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-382.

<sup>3</sup>Sohl v. Geisendorf, 1 Wilson (Ind.), 60; Seb. 367.

<sup>4</sup>*Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-382.

<sup>5</sup>*Browne v. Freeman*, 12 W. R. 305; 4 N. R. 476.

<sup>6</sup>*Booth v. Jarrett*, 52 How. Pr. 169.

to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than of the proprietor. A trade-mark of this description is of no value to the original proprietor because he could not use it without deception, and therefore would not be protected in its exclusive enjoyment. Such a trade-mark would seem to be an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence. It should be deemed to pass with a transfer of the business because such an implication is consistent with the character of the transaction and the presumable intention of the parties."<sup>1</sup>

So that the use of the name "Stillman" to indicate the cloth product of the Stillman Mills;<sup>2</sup> "Old Oscar Pepper" to indicate the product of the distillery of that name;<sup>3</sup> "Osborne House" to designate a hotel first owned by Osborne;<sup>4</sup> "Tower Palace," designating a building, having a tower, where a clothing business was conducted,<sup>5</sup> are all held to be indicative of the premises and abandoned by the owner of the name who sells the premises or removes therefrom. It follows that a mere arbitrary name not designating the locality or building in which a business is transacted will survive a change in the location of the business.<sup>6</sup>

<sup>1</sup>Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 218; citing Dixon Crucible Co. v. Guggenheim, 3 Am. L. T. 228; Hudson v. Osborne, 39 L. J. Ch. N. S. 79; Shipwright v. Clements, 19 W. R. 599. See also Hall v. Barrows, 4 DeG. J. & S. 157; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 227-234; Kidd v. Johnson, 100 U. S. 617; Leather Cloth Co. v. American Leather Cloth Co., 11 Jur. N. S. 513; Ainsworth v. Walmesley, 44 L. J. 555.

<sup>2</sup>Carmichael v. Latimer, 11 R. I. 395.

<sup>3</sup>Pepper v. Labrot, 8 Fed. Rep. 29.

<sup>4</sup>Hudson v. Osborne, 39 L. J. Ch. N. S. 79.

<sup>5</sup>Armstrong v. Kleinhaus, 82 Ky. 304.

<sup>6</sup>Dewitt v. Mathey (Ky.), 35 S. W. Rep. 1113 (not officially reported).

The length of time during which a trade-mark is not used is, as we have seen, merely a circumstance to be considered with all the other facts in the case in determining whether there was an intention to abandon its use. Thus, defendants have been restrained from using a mark that has lain in disuse for periods of one year,<sup>1</sup> three years,<sup>2</sup> nine years,<sup>3</sup> ten years,<sup>4</sup> and even twenty years.<sup>5</sup> The vital question is the intention of the owner of the mark, and the burden of establishing abandonment lies upon the party who affirms it.<sup>6</sup>

There may be an involuntary abandonment of a trade-mark through the fact that, once distinctive, it has ceased to indicate the merchandise of the owner of the mark and has become *publici juris* because it indicates only a peculiar product or method of manufacture. This again arises from the peculiar circumstances of each case. "What is the test by which a decision is to be arrived at, whether a word which was originally a trade-mark has become *publici juris*? I think the test must be, whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the

<sup>1</sup> Lemoine v. Ganton, 2 E. D. Smith, 343; Cox, 142.

<sup>2</sup> Julian v. Hoosier Drill Co., 75 Ind. 408.

<sup>3</sup> Lazenby v. White, 41 L. J. N. S. 354. But nine years' inaction, where knowledge can be imputed to the party, has been held to work an abandonment of his trade-mark in Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536; and an injunction was refused because plaintiff delayed action for nine years in Amoskeag Mfg. Co. v. Garner, 55 Barb. 151.

<sup>4</sup> Wolfe v. Barnett, 24 La. Ann. 97.

<sup>5</sup> Gillott v. Esterbrook, 48 N. Y. 374.

<sup>6</sup> Julian v. Hoosier Drill Co., 75 Ind. 408. This is analogous to the rule that where one sued for infringing a trade-mark sets up a prior right to the mark in question, it is incumbent upon him to establish his prior use by satisfactory evidence. Tetlow v. Tappan, 85 Fed. Rep. 774.

goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically as the right to a trade-mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone." This extract from an opinion of Mellish, L. J.,<sup>1</sup> is probably the clearest explanation of the cases involving this topic. The cases turning upon this point are many.<sup>2</sup>

The adoption of a new label or brand is, of course, an abandonment of all the distinctive features of the old label or brand not preserved in the new one.<sup>3</sup>

The owner of a trade-mark may by a practice of shipping goods bearing the mark to the same consignee, so that it may be held out to or believed by purchasers to indicate some right to the mark in the consignee, lose the exclusive right to its use.<sup>4</sup>

The fact that a manufacturer uses his name or an additional symbol, such as a coat-of-arms, in connection with the distinctive word, does not deprive him of his trade-mark right in the distinctive word. Thus the manufacturer of "Eureka" shirts, which he marked "R. Ford's Eureka Shirt, London," was awarded an injunction restraining a defendant from the sale of an article marked

<sup>1</sup>Ford v. Foster, L. R. 7 Ch. D. 611.

<sup>2</sup>Lazenby v. White, 41 L. J. Ch. 354; Lea v. Millar, Seb. 513; Seton (4th ed.), 242; Lea v. Deakin, 11 Biss. 23; Re Arbenz, L. R. 35 Ch. D. 248; Neva Stearine Co. v. Mowling, 9 Vict. L. R. 98; Sherwood v. Andrews, 5 Am. L. R. N. S. 588; Re Hall, 13 Off. Gaz. 229; Liebig's Extract Co. v. Hanbury, 17 L. T. N. S. 298; Watkins v. Landon, 52 Minn. 389-393; Marshall v. Pinkham, 52 Wis. 572; Price & Steuart, 497. The mere fact that a name used as trade-mark comes into popular use in a descriptive sense does not invalidate its use as a trade-mark. Selchow v. Baker, 93 N. Y. 59; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547; Burton v. Stratton, 12 Fed. Rep. 696.

<sup>3</sup>Manhattan Medicine Co. v. Wood, 108 U. S. 218; Lea v. Millar, Seton (4th ed.), 242; Seb. 513.

<sup>4</sup>Robinson v. Finlay, and Ward v. Robinson, L. R. 9 Ch. D. 487.

"The Eureka Shirt."<sup>1</sup> The manufacturers of "Excelsior White Soft Soap" sought to enjoin the makers of "Bustard & Co.'s Excelsior White Soft Soap," and upon the motion it was held that their right to injunctive relief was not affected by the fact that the defendants had never used the word except in conjunction with their firm name.<sup>2</sup>

A manufacturer who uses his trade-mark in connection with words indicating that his goods are the product of another maker will lose his right to have the word used as trade-mark protected. This was held in a case where "Eton" cigarettes were so put up as to suggest that they were of foreign manufacture.<sup>3</sup> But a manufacturer who uses his trade-mark on goods prepared for the jobbing trade, adding to or using therewith the name of the jobber, does not lose his right to the protection of the trade-mark, for, as said by Judge Colt: "In doing this no real deceit was practiced upon the public, because the purchaser obtained the same goods which he would have purchased if the name of the jobber had not been upon them."<sup>4</sup> In one case it was argued by the defendants that when the plaintiffs furnished their "Excelsior" stoves to the trade and marked the dealers' names upon the stoves, they thereby permitted the dealer to hold himself out to the public as the manufacturer of the stoves. This was not a successful defense, but the court stood upon the fact that there was "nothing in connection with the names of these dealers to indicate that they are the

<sup>1</sup>Ford v. Foster, L. R. 7 Ch. D. 616; L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384. The mere addition of a coat-of-arms to a trade-mark (as registered in England) is not sufficient to disentitle the person using the mark to sue for an injunction. Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Hammond v. Brunner, 9 R. P. C. 301; Cartmell, 142.

<sup>2</sup>Braham v. Bustard, 1 H. & M. 447; 9 L. T. N. S. 199; 11 W. R. 1061; 2 N. R. 572; Seb. 226. The same defense was attempted where "Cottolene" was the trade-mark and "Cottoleo," with the defendant's name, the alleged infringement. Defendant was enjoined. N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

<sup>3</sup>Wood v. Lambert, L. R. 32 Ch. D. 247.

<sup>4</sup>Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896-898.



manufacturers, and there is no evidence that any one ever supposed they were the manufacturers."<sup>1</sup>

Advertisements published in the United States by a corporation having the exclusive sale of certain Hungarian mineral waters, to the effect that the name under which the waters were sold had become a general name for all similar waters, and that the corporation would thenceforth distinguish the particular water sold by it by a special trade-mark, were held to evidence an abandonment of the original mark which was binding on the owner of the wells.<sup>2</sup>

In the same case it was held that the failure of the corporation to sue infringers of the label used in bottling the water worked an abandonment of the trade-marks used on the label as against the owner of the well.<sup>3</sup>

There may be a constructive abandonment of specific features of a trade-mark, arising from a failure to enumerate such features in securing registration. If the registration shows a claim to a trade-mark "more limited in its description than the owner's common-law rights would otherwise be, the owner is bound by such limitation as showing what he really claimed."<sup>4</sup> Thus, in an application for registration of a trade-mark, the failure to claim the letter "s" as a part or feature thereof was held to be an abandonment of that feature of the mark.<sup>5</sup>

<sup>1</sup>Sheppard v. Stuart, 13 Phila. 117; Price & Steuart, 193.

<sup>2</sup>Saxlehner v. Eisner & Mendelson Co. (1), 88 Fed. Rep. 61; affirmed in Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536.

<sup>3</sup>Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536; overruling Saxlehner v. Eisner & Mendelson Co. (1), 88 Fed. Rep. 61.

<sup>4</sup>Hawley, J., in Hennessy v. Braunschweiler & Co., 89 Fed. Rep. 664-668; citing Kohler Mfg. Co. v. Beeshore, 8 C. C. A. 215; 59 Fed. Rep. 572; Richter v. Reynolds, 8 C. C. A. 220; 59 Fed. Rep. 577.

<sup>5</sup>Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637.

## CHAPTER VI.

### GOOD-WILL.

§ 61. **Defined.**—“Good-will is a modern but important growth of the law, not mentioned by some of the early writers, but given great prominence at the present time.”<sup>1</sup> Mr. Justice Story has defined good-will as “the advantage or benefit which is acquired by an establishment beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices.”<sup>2</sup>

It would be very difficult, if indeed possible, to frame a more accurate and comprehensive definition. This one, as given, has been expressly and *in hæc verba* adopted by the supreme court of the United States, Mr. Chief Justice Fuller prefacing his use of it by saying “there is difficulty in deciding accurately what is included under the term.”<sup>3</sup>

§ 62. **In particular cases.**—“As applied to a newspaper, the good-will usually attaches to its name rather

<sup>1</sup>Vann, J., in *People v. Roberts*, 159 N. Y. 70-80; 53 N. E. Rep. 685; 45 L. R. A. 126.

<sup>2</sup>Story on Partnerships, sec. 99.

<sup>3</sup>*Metropolitan Bank v. St. Louis Dispatch Co.*, 149 U. S. 436-446.

“Good-will was defined by Lord Eldon in *Crutwell v. Lye*, 17 Ves. 335-346, to be ‘nothing more than the probability that the old customers will resort to the old place;’ but Vice-Chancellor Wood, in *Churton v. Douglas, Johnson*, V. C. 174-188, says it would be taking too narrow a view of what is there laid down by Lord Eldon to confine it to that, but that it must mean every positive advantage that has been acquired by the old firm in the progress of its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any

than to the place of publication. The probability of the title continuing to attract custom in the way of circulation and advertising patronage, gives a value which may be protected and disposed of and constitutes property.”<sup>1</sup>

Good-will is an appurtenant of every form of business which relies directly upon public favor. We find in the books cases in which the existence of a valuable good-will is found as appurtenant to a wide range of mercantile pursuits; as, for example, in the business of flour and grain merchants,<sup>2</sup> the manufacture of patent medi-

other matter carrying with it the benefit of the business.” Mr. Chief Justice Fuller in *Menendez v. Holt*, 128 U. S. 514-522.

“The good-will of an established business, which is a common subject of contract, is nothing but the chance of being able to keep the business which has been established.” Wallace, J., in *Barber v. Connecticut Mutual Life Ins. Co.*, 15 Fed. Rep. 312, 313.

“It is property of a very peculiar and exceptional character. It is intangible property which, in the nature of things, can have no existence apart from a business of some sort that has been established and carried on at a particular place.” Thayer, J., in *Metropolitan Bank v. St. Louis Dispatch Co.*, 36 Fed. Rep. 722-724.

“The good-will of a business comprises those advantages which may inure to the purchaser from holding himself out to the public as succeeding to an enterprise which has been identified in the past with the name and repute of his predecessor.” Wallace, J., in *Knoedler v. Boussod*, 47 Fed. Rep. 465, 466. This definition was approved on appeal. *Knoedler v. Glaenzer*, 55 Fed. Rep. 895-899.

“Good-will has been defined as ‘all that good disposition which customers entertain toward the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it.’ There is nothing marvelous or mysterious about it. When an individual or a firm or a corporation has gone on for an unbroken series of years conducting a particular business, and has been so scrupulous in fulfilling every obligation, so careful in maintaining the standard of goods dealt in, so absolutely honest and fair in all business dealings that customers of the concern have become convinced that their experience in the future will be as satisfactory as it has been in the past, while such customers’ good report

<sup>1</sup>*Metropolitan Bank v. St. Louis Dispatch Co.*, 149 U. S. 436-446; affirming *S. C.*, 36 Fed. Rep. 722. To the same effect see *Porter v. Gorman*, 65 Ga. 11; *Dayton v. Wilkes*, 17 How. Pr. 510.

The good-will and name of a newspaper may attach to the printing plant, so as to be vested in the lessee of the plant. *Lane v. Smythe*, 46 N. J. Eq. 443-454.

<sup>2</sup>*Menendez v. Holt*, 128 U. S. 514-522.

cines,<sup>1</sup> and of ferro plates and picture frames,<sup>2</sup> the business of a stage-line,<sup>3</sup> a livery-stable,<sup>4</sup> a milk-route,<sup>5</sup> a drinking saloon,<sup>6</sup> or where the owners of the good-will were bankers,<sup>7</sup> bakers,<sup>8</sup> glass-stainers,<sup>9</sup> haberdashers,<sup>10</sup> glass-blowers,<sup>11</sup> brewers,<sup>12</sup> hardware dealers,<sup>13</sup> tailors,<sup>14</sup> cheesemongers,<sup>15</sup> provision merchants,<sup>16</sup> manufacturing chemists,<sup>17</sup> real estate and fire insurance agents,<sup>18</sup> com-

of their own experience tends continually to bring new customers to the same concern, there has been produced an element of value quite as important—in some cases, perhaps, far more important—than the plant or machinery with which the business is carried on. That it is property is abundantly settled by authority, and, indeed, is not disputed. That in some cases it may be very valuable property is manifest.” Lacombe, J., in *Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17-20.

“Good-will has been defined by this court to be ‘the favor which the management of a business wins from the public, and the probability that old customers will continue their patronage.’” McGrath, J., in *Williams v. Farrand*, 88 Mich. 473-477.

“There is considerable difficulty in defining accurately what is included under this term *good-will*; it seems to be that species of connection in trade which induces customers to deal with a particular firm. It varies almost in every case, but it is a matter distinctly appreciable which may be preserved (at least to some extent), if the business be sold as a going concern, but which is wholly lost if the concern is wound up, its liabilities discharged, and its assets got in and distributed.” Sir John Romilly, M. R., in *Wedderburn v. Wedderburn*, 22 Beavan, 84-104.

<sup>1</sup>Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; s. c., 139 U. S. 540.

<sup>2</sup>Dean v. Emerson, 102 Mass. 480.

<sup>3</sup>Pierce v. Fuller, 8 Mass. 228.

<sup>4</sup>Herbert v. Dupaty, 42 La. Ann. 343.

<sup>5</sup>Munsey v. Butterfield, 133 Mass. 492.

<sup>6</sup>Howard v. Taylor, 90 Ala. 241.

<sup>7</sup>Smith v. Everett, 27 Beavan, 446.

<sup>8</sup>Costello v. Eddy, 12 N. Y. Supp. 236.

<sup>9</sup>Scott v. Rowland, 20 W. R. 508.

<sup>10</sup>Re Randall's Estate, 8 N. Y. Supp. 652.

<sup>11</sup>Featherstonhaugh v. Fenwick, 17 Ves. 298.

<sup>12</sup>Hall v. Hall, 20 Beavan, 139.

<sup>13</sup>Thompson v. Andrus, 73 Mich. 551.

<sup>14</sup>Parsons v. Hayward, 31 L. J. Ch. 666.

<sup>15</sup>Hudson v. Osborne, 39 L. J. Ch. 79.

<sup>16</sup>Scott v. Mackintosh, 1 V. & B. 503.

<sup>17</sup>Turner v. Major, 3 Giff. 442.

<sup>18</sup>Armstrong v. Bitner, 71 Md. 118.

mission agents,<sup>1</sup> mercers,<sup>2</sup> paper-makers,<sup>3</sup> pencil-makers,<sup>4</sup> hotel or public-house keepers,<sup>5</sup> whisky merchants,<sup>6</sup> dyers,<sup>7</sup> dealers in works of art and artists' materials,<sup>8</sup> dealers in boots and shoes,<sup>9</sup> tobacco brokers,<sup>10</sup> hide dealers,<sup>11</sup> snuff makers,<sup>12</sup> upholsterers,<sup>13</sup> iron masters,<sup>14</sup> dealers in seeds, grains and plants,<sup>15</sup> carriers,<sup>16</sup> milliners;<sup>17</sup> and as we will see elsewhere, physicians, solicitors and attorneys may have a vendible good-will.

It is patent that a good-will may be created in connection with any business, enterprise, occupation or profession. The older cases expressly denied the existence of a good-will which could be the subject of sale, in connection with the learned professions. Thus, Lord Chancellor Chelmsford, as recently as 1858, said: "The term good-will seems wholly inapplicable to the business of a solicitor, which has no local existence, but is entirely personal, depending upon the trust and confidence which persons may repose in his integrity and ability to conduct their legal affairs."<sup>18</sup>

That there is good reasoning in this dictum cannot be denied. In a case of later date, in Scotland, it was said

<sup>1</sup>Macdonald v. Richardson, 1 Giff. 81.

<sup>2</sup>Morris v. Moss, 25 L. J. Ch. 194.

<sup>3</sup>Potter v. Commissioners of Inland Revenue, 10 Ex. 147.

<sup>4</sup>Banks v. Gibson, 34 Beavan, 566.

<sup>5</sup>Spratt v. Jeffery, 10 B. & C. 249; Lashus v. Chamberlain, 6 Utah, 385; Elliott's Appeal, 60 Pa. St. 161; Musselman & Clarkson's Appeal, 62 Pa. St. 81.

<sup>6</sup>Kidd v. Johnson, 100 U. S. 617.

<sup>7</sup>Bryson v. Whitehead, 1 S. & S. 74.

<sup>8</sup>Knoedler v. Boussod, 47 Fed. Rep. 465; Knoedler v. Glaenger, 55 Fed. Rep. 895.

<sup>9</sup>Curtis v. Gokey, 68 N.Y. 300.

<sup>10</sup>Davies v. Hodgson, 25 Beavan, 177.

<sup>11</sup>Goodman v. Henderson, 58 Ga. 567.

<sup>12</sup>Hammond v. Douglas, 5 Ves. 539.

<sup>13</sup>Chisum v. Dewes, 5 Russ. 29.

<sup>14</sup>Hall v. Barrows, 4 DeG. J. & S. 150.

<sup>15</sup>Iowa Seed Co. v. Dorr, 70 Ia. 481.

<sup>16</sup>Cruttwell v. Lye, 17 Ves. 335.

<sup>17</sup>Shackle v. Baker, 14 Ves. 463.

<sup>18</sup>Auten v. Boys, 2 DeGex & Jones, 626-636.

“there is truly no such thing as good-will in the case of a business carried on by a professional man, such as a physician, surgeon, or law agent, whose success depends entirely upon his own personal skill. It is quite different in the case of a trade or manufacture, where the employer may have the possession of patents or trade secrets, or may, by long exercise of his trade or manufacture in some particular locality, have drawn together skilled artisans and attracted the custom of a district to his establishment. In such a case it is not the individual skill of the employer, but the reputation which his establishment has acquired, which creates that incorporeal, but frequently valuable, estate known as the ‘good-will’ of a trade. But there is no such thing in the case of a professional man. His business dies with him, and the man who comes after him in the district must depend for success upon his own exertions. It is quite true that such businesses are occasionally sold; but what is thus sold in case of a living professional man retiring from business is truly the personal recommendation which the seller gives to his former clients or patients in favor of his successor, coupled with the predecessor’s own retirement from business. But where the physician or law agent is dead, nothing of the kind can take place. He has been removed by death from all possibility of competing with the new doctor or the new solicitor, and his voice being forever silenced, he cannot give any recommendation to his clients or patients.”<sup>1</sup>

<sup>1</sup>Lord Curriehill in *Bain v. Munro*, 15 Scot. L. Rep. 260. It has been held that the good-will of an attorney was not a subject of administration. *Spice v. James*, Seb. 46; *Arundell v. Bell*, 52 L. J. Ch. 537.

In an early case, however, it was held that a contract entered into by a practicing attorney to relinquish practice, recommend his clients to his successor, that he would not practice within certain limits, and would permit the use of his name in the firm name of his successor for a certain period, was good in law. (1803) *Bunn v. Guy*, 4 East, 190. And in a similar case, where a solicitor sold his practice and agreed not to practice in Great Britain for twenty years, Lord Langdale held the contract valid and binding on the vendor, and he was enjoined from attempting to resume his practice

While the courts have, for the reasons stated, looked with disfavor upon executory contracts for the sale of the good-will of a professional man's practice, and have refused to decree specific performance under such contracts,<sup>1</sup> still when the sale is complete and the contract partly executed, its terms will be enforced.<sup>2</sup> Thus where a solicitor retired, permitting his partner to continue the use of the firm name, in consideration of an annuity to be paid him, and the continuing partner defaulted in the payment of the annuity, the contract was specifically enforced.<sup>3</sup>

In the United States there have been frequent instances of the sale of the good-will of a medical practitioner, and contracts for such sales have been uniformly held good.<sup>4</sup>

**§ 63. As a subject of sale.**—"The good-will of a trade is a subject of value and price. It may be sold,

in Great Britain during the specified time. (1841) *Whittaker v. Howe*, 3 Beavan, 383.

But the courts have refused to decree specific performance of a contract for the sale of an attorney's practice. *Bozon v. Farlow*, 1 Mer. 459; Seb. 22; *Thornbury v. Bevill*, 1 Y. & C. Ch. 554; 6 Jur. 407; Seb. 71.

And where a member of a firm of surgeons died, it was held that the survivor could not be obliged to sell the good-will of the practice for the joint benefit of himself and his deceased partner's estate, Vice-Chancellor Leach remarking that "such partnerships are very different from commercial partnerships." *Farr v. Pearce*, 3 Madd. 74.

<sup>1</sup> See last note.

<sup>2</sup> *Hanna v. Andrews*, 50 Ia. 462; *Smalley v. Greene*, 52 Ia. 241.

<sup>3</sup> *Aubin v. Holt*, 2 K. & J. 66.

<sup>4</sup> *Webster v. Williams*, 62 Ark. 101; 34 S.W. Rep. 537; *Bradbury v. Barden*, 35 Conn. 577; *Martin v. Murphy*, 129 Ind. 464; *Pickett v. Green*, 120 Ind. 584; *Hoyt v. Holly*, 39 Conn. 326; *Gilman v. Dwight*, 13 Gray, 356; *Dwight v. Hamilton*, 113 Mass. 175; *Warfield v. Booth*, 33 Md. 63; *Miller v. Keeler*, 9 Pa. Co. Ct. R. 274; *Butler v. Burleson*, 16 Vt. 176. But, to the contrary, see *Mandeville v. Harman*, 42 N. J. Eq. 185. In this case the covenant was as follows: "In consideration of this contract, made with him by the said Mandeville, the said Harman hereby covenants and agrees not to engage in the practice of medicine or surgery in the city of Newark at any time hereafter." The court held that the law was unsettled as to whether such a contract was or was not void as in restraint of trade, and therefore denied the preliminary injunction sought for.

bequeathed, or become assets in the hands of the personal representative of a trader.”<sup>1</sup>

It may be of greater value than the stock of goods or plant of machinery with which the business is carried on,<sup>2</sup> or it may attach to the mere name of a publication and have a definite value apart from and in no wise dependent upon any tangible property.<sup>3</sup>

It cannot be sold apart from the business with which it is connected.<sup>4</sup> It may be given, together with the business with which it is connected, in payment for stock in a corporation, so that stock issued solely for such good-will will, to the extent of its value, be issued for “property actually received” within the meaning of section 42 of the stock corporation law of the state of New York.<sup>5</sup> The good-will of a domestic corporation is property which is taxable as part of its capital stock.<sup>6</sup> That of a foreign corporation is liable to taxation “at the place where it has a market value.”<sup>7</sup>

It must be remembered that the trade-marks and the good-will of a business are inseparable. We have seen elsewhere that a trade-mark can have no existence in gross. It is strictly appurtenant to the good-will of the business in which it is used.<sup>8</sup> And so it has been said of good-will that “while it is not necessarily local, it is usually to a great extent, and must of necessity, be incident to a place, an established business, or a name known to the trade.”<sup>9</sup>

<sup>1</sup> Tindal, C. J., in *Hitchcock v. Coker*, 6 Ad. & E. 428-454.

<sup>2</sup> *Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17-20.

<sup>3</sup> *Metropolitan Bank v. St. Louis Dispatch Co.*, 149 U. S. 436-446; *Boon v. Moss*, 70 N. Y. 465.

<sup>4</sup> *Robertson v. Quiddington*, 28 Beavan, 529.

<sup>5</sup> *Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17.

<sup>6</sup> *Matter of Hondayer*, 150 N. Y. 37.

<sup>7</sup> *People v. Roberts*, 159 N. Y. 70; 53 N. E. Rep. 685.

<sup>8</sup> “As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be a fraud upon the public.” Colt, J., in *Morgan v. Rogers*, 19 Fed. Rep. 596. And to same effect, *Witthaus v. Braun*, 44 Md. 303; *Hoxie v. Chaney*, 143 Mass. 592; *Russia Cement Co. v. LePage*, 147 Mass. 206.

<sup>9</sup> Vann, J., in *People v. Roberts*, 159 N. Y. 70-83; 53 N. E. Rep. 685; 45 L. R. A. 126.



In a conveyance of good-will, however, apt words should be employed. Thus it has been held that the good-will was not covered by a clause in a contract of partnership relating to the partnership "property, credits and effects," or "stock in trade and effects."<sup>1</sup> And a similar holding has been made in regard to the words "premises, stock in trade, etc.,"<sup>2</sup> as well as where the words "estate and effects" were used in partnership articles.<sup>3</sup>

On the other hand, Lord Westbury construed the words, "stock belonging to the partnership," to include the good-will,<sup>4</sup> and other eminent judges have held good-will to be included in the words "moneys, stock in trade, debts, effects and things,"<sup>5</sup> and "property and effects,"<sup>6</sup> while Vice-Chancellor Malins said: "The sale of a business is a sale of the good-will. It is not necessary that the word 'good-will' should be mentioned. . . . In the sale of a business a trade-mark passes, whether specially mentioned or not." He accordingly held that good-will was included in an assignment that conveyed all the assignor's interest in the partnership premises and effects, without specifically referring to the good-will.<sup>7</sup> In a suit for the specific performance of a contract for the purchase of a share in a business, in which the expression "good-will, etc." was employed, Lord Romilly was of opinion that "these words are connected together, and unite such other things as are necessarily connected with and belong to the good-will, many of which are easily pointed out; for instance, the use of trade-marks. . . . All these would be included in the words *et cetera*, and would be included in the conveyance."<sup>8</sup>

<sup>1</sup>Hall v. Hall, 20 Beavan, 139.

<sup>2</sup>Burfield v. Rouch, 31 Beavan, 241.

<sup>3</sup>Steuart v. Gladstone, L. R. 10 Ch. D. 646.

<sup>4</sup>Hall v. Barrows, 4 DeG. J. & S. 150.

<sup>5</sup>Rolt v. Bulmer, Seb. 614.

<sup>6</sup>Reynolds v. Bullock, 47 L. J. Ch. 773.

<sup>7</sup>Shipwright v. Clements, 19 W. R. 599. But a mortgage of the entire assets of a business does not necessarily include the good-will. Santa Fe Electric Co. v. Hitchcock (New Mex.), 50 Pac. Rep. 332.

<sup>8</sup>Cooper v. Hood, 26 Beavan, 293.

In this connection it is to be noted that there are two general classes of good-will—general and local. The distinction is well-drawn in an English case, as follows: “In some classes of business, when the trade has long been carried on in a profitable manner in a particular house, and a new tenant comes in and continues to carry on the same business there, it is found by experience that many, if not all, of the customers resort there as before. This is found so regularly to happen that it has become usual to pay a money value for it, which is commonly called ‘good-will.’ It may be that there may be a species of good-will which may be the subject of bargain and sale, although not dependent on the business being carried on in any particular place; for instance, in the case of what are called ‘quack-medicines.’ But when we come to speak of the good-will of a public-house, it is obvious that it is a thing which is attached to a locality.”<sup>1</sup> In accordance with this rule, whenever the good-will is local, in the sense of being attached to a particular house or store, it will pass with a sale of the lease of the trading premises,<sup>2</sup> or the sale of a public house,<sup>3</sup> or even a tailoring establishment.<sup>4</sup>

While the unity existing between good-will and trade-marks is clearly defined, the subject of trade-names or firm-names in their relation to good-will is attended with some difficulty. The general rule has been well stated by Vice-Chancellor Wood, as follows: “The name of a firm is a very important part of the good-will of the business carried on by the firm. A person says: ‘I have always bought good articles at such a house of business; I know it by that name, and I send to the house of business identified by that name for that purpose.’ There are cases every day in this court with reference to the use

<sup>1</sup> *Llewellyn v. Rutherford*, L. R. 10 C. P. 456.

<sup>2</sup> *Daugherty v. Van Nostrand*, 1 Hoff. Ch. (N. Y.) 68; *Williams v. Wilson*, 4 Sandf. Ch. 379.

<sup>3</sup> *Ex parte Punnett*, L. R. 16 Ch. D. 226; *Elliott’s Appeal*, 60 Pa. St. 161.

<sup>4</sup> *Parsons v. Hayward*, 31 Beavan, 199; *Chittenden v. Witbeck*, 50 Mich. 401-421.

of the name of a particular firm, connected generally, no doubt, with the question of trade-mark. But the question of trade-mark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you are parting with the good-will of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You cannot put it anything short of that. That the name is an important part of the good-will of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm."<sup>1</sup> This dictum, however, is flatly opposed to the rulings of the American courts, that the sale of the good-will of a business carries with it no right to the use of the vendor's name as the name of the establishment,<sup>2</sup> although the purchaser may properly advertise himself as being "successor to" his vendor.<sup>3</sup> And the later English cases indicate that the rule has been somewhat modified in England, Justice Stirling saying, "the defendant is entitled to use the plaintiff's name in the business so long and so far as he does not by so doing expose him to any liability, but no further."<sup>4</sup> The American courts have very properly gone to the length of holding that, upon the withdrawal of a partner, the remaining partners will be enjoined from continuing the use of a firm name which indicates that the withdrawing partner is still a member of the firm.<sup>5</sup>

<sup>1</sup>Churton v. Douglas, Johns. 174.

<sup>2</sup>Knoedler v. Glaenzer, 55 Fed. Rep. 895; Reeves v. Denicke, 12 Abb. Pr. N. S. 92.

<sup>3</sup>Knoedler v. Glaenzer, 55 Fed. Rep. 895; Weed v. Peterson, 12 Abb. Pr. N. S. 178.

<sup>4</sup>Thynne v. Shove, L. R. (1890) 45 Ch. D. 577-582.

<sup>5</sup>McGowan v. McGowan, 22 Ohio St. 370.

§ 64. **Rights of vendor.**—The vendor of the good-will of a business may, in the absence of any agreement to the contrary, re-engage in a similar business in some other place.<sup>1</sup> As said by Chief Justice Bigelow in the supreme court of Massachusetts: "Whenever such is the intent of the parties, it is carried into effect by an express stipulation, which, if not in undue restraint of trade, may be valid and binding. But we know of no case where any such agreement has been raised by mere implication, arising from the sale of the good-will of a person's trade, in connection with a particular place of business where it has been carried on."<sup>2</sup>

An English writer has said, "As the decisions at present stand, the title to this section is to some extent misleading, inasmuch as the legal position of the assignor of a business, after he has parted with it, is in no way different from that of any other member of the public, provided, of course, that he has not bound himself by additional restrictive covenants."<sup>3</sup> Even in the absence of express stipulation, good faith requires of a party who has sold the good-will of his business that he should do nothing which tends to deprive the purchaser of its benefits and advantages. It is clear that he has no right to hold himself out as continuing the business which he sold to the plaintiff, or as carrying on his former business at another place to which he has removed.<sup>4</sup> In other words, in every case of the sale of a good-will the vendor must not enter into an unfair competition with his purchaser. What will constitute such unfair competition must be determined in the light of all the facts in each particular case.

<sup>1</sup>Hoxie v. Chaney, 143 Mass. 592-596; Trego v. Hunt, 65 L. J. Ch. 1.

<sup>2</sup>Bassett v. Percival, 5 Allen, 345-347; Porter v. Gorman, 65 Ga. 11; Knoedler v. Boussod, 47 Fed. Rep. 465; Knoedler v. Glaenger, 55 Fed. Rep. 895; Bergamini v. Bastian, 35 La. Ann. 60; 48 Am. Rep. 216; White v. Jones, 1 Abb. Pr. N. S. 337; Howe v. Searing, 6 Bosw. 354; Cruttwell v. Lye, 17 Ves. 344; Dayton v. Wilkes, 17 How. Pr. 516; Hanna v. Andrews, 50 Ia. 462; Cottrell v. Babcock Mfg. Co., 54 Conn. 138.

<sup>3</sup>Allan on Good-will, p. 32.

<sup>4</sup>Hoxie v. Chaney, 143 Mass. 592-597.

The vendor is at liberty to lease or sell other property he may own in the neighborhood, to another person who may carry on the same business, provided there is no collusion, and the lessor has no interest in the business.<sup>1</sup>

A verbal agreement not to engage in a rival business does not come within the statute of frauds. It may be valid when made as collateral to and distinct from a lease of premises, provided the parol agreement is made in consideration of the execution of the written lease.<sup>2</sup> But in an action at law upon a contract of sale, such collateral parol agreement cannot be shown or recovered on.<sup>3</sup>

A contract not to re-engage in business must, like any other contract, be founded on a sufficient consideration or it will not be enforced.<sup>4</sup> And the plaintiff in an action upon such a contract must not be guilty of any breach on his part, or he will be denied relief in equity.<sup>5</sup>

Furthermore, the contract must not be void as against public policy because in restraint of trade. The courts of late years have relaxed the old rules so that the restrictive covenant may be unlimited as to area. "It cannot be said that the early doctrine that contracts in general restraint of trade are void, without regard to circumstances, has been abrogated. But it is manifest that it has been much weakened, and that the foundation upon which it was originally placed has, to a considerable extent at least, by the change of circumstances, been removed."<sup>6</sup>

In the absence of a covenant not to re-engage in business, the vendor may employ any method of soliciting

<sup>1</sup>Bradford v. Peckham, 9 R. I. 250-253; Herbert v. Dupaty, 42 La. Ann. 343.

<sup>2</sup>Welz v. Rhodius, 87 Ind. 1; Spier v. Lambdin, 45 Ga. 319.

<sup>3</sup>Costello v. Eddy, 12 N. Y. Supp. 236; Herbert v. Dupaty, 42 La. Ann. 343.

<sup>4</sup>Onondaga Co. Milk Association v. Wall, 17 Hun, 494.

<sup>5</sup>Cassidy v. Metcalf, 1 Mo. App. 593-601; s. c., 66 Mo. 519; Hollis v. Shaffer, 38 Kas. 492.

<sup>6</sup>Andrews, J., in Diamond Match Co. v. Roeber, 106 N. Y. 473-484. The cases are reviewed at length in this opinion.

trade which does not involve a false or fraudulent representation.<sup>1</sup> But the English rule is that he cannot solicit former customers.<sup>2</sup> A covenant not to re-engage in business will not be implied from the vendor's covenant in the bill of sale "to warrant and defend the sale of the said property and interest, as herein stated."<sup>3</sup>

The good-will of the business of a decedent does not carry with it the right to use the decedent's name.<sup>4</sup> Such good-will is an asset to be accounted for by the personal representative, and if that representative takes charge of the business and conducts it as his own he is chargeable with the value of the good-will.<sup>5</sup>

Equity looks with disfavor upon any method of diverting from the purchaser of a good-will the benefits which ought to come to him by reason of his purchase. Thus, where partners sold out their interest in the good-will of a partnership known as the Kalamazoo Wagon Company, and then organized a corporation under the name of Kalamazoo Buggy Company, they were enjoined, at the suit of their vendee, from the use of that name; and the court held that the writ of injunction properly ran against all persons connected with the corporation.<sup>6</sup>

<sup>1</sup>Cottrell v. Babcock, 54 Conn. 122; Vonderbank v. Schmitt, 44 La. Ann. 264; Marcus Ward & Co. v. Ward, 40 N. Y. State Rep. 792; Knoedler v. Boussod, 47 Fed. Rep. 465; Close v. Flesher, 59 N. Y. State Rep. 283; Knoedler v. Glaenger, 55 Fed. Rep. 895.

<sup>2</sup>Trego v. Hunt, 65 L. J. Ch. 1; L. R. (1896) A. C. 7; 12 Eng. Ruling Cas. 442.

<sup>3</sup>Costello v. Eddy, 12 N. Y. Supp. 236. Agreements upon dissolution are construed by the same rules as other contracts, with a view of ascertaining the actual intent in the minds of the parties. Thus in a covenant which read "the said Rivers covenants that he will not engage in the manufacture of furniture so long as said Bagby continue such business," it was held that Bagby's conveyance of the business to a corporation was a discontinuance of the business by him, and Rivers was entitled to resume the furniture business if he saw fit. Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

<sup>4</sup>Morgan v. Schuyler, 79 N. Y. 490; Re Randall's Estate, 8 N. Y. Supp. 652-654.

<sup>5</sup>Re Randall's Estate, 8 N. Y. Supp. 652.

<sup>6</sup>Myers v. Kalamazoo Buggy Co., 54 Mich. 215; Brass & Iron Works Co. v. Payne, 50 Ohio St. 115; 19 L. R. A. 82.

In another case one Thomson was a partner of his brother, in Europe, and a partner of other persons in a separate establishment in New York. Both houses were dealing in "Thomson's Glove-fitting" corsets. Thomson sold out his interest in the New York house and afterward attempted to sell the corsets made by him in Europe, in the United States. He was enjoined from so doing, the court holding that, when he assigned his interest in the good-will of the New York partnership, the good-will carried with it all his right to use the trade-mark "Thomson's Glove-fitting" in the United States.<sup>1</sup>

In a sale of a physician's practice, where the vendor, after three months, returned to the same city and opened an office fifteen rods away from, in the nearest house but one to, his former office, the supreme court of Massachusetts held his conduct to be a breach of an implied covenant "that the vendor will not himself do anything to disturb or injure the vendee in the enjoyment of that which he has purchased."<sup>2</sup>

When an article of manufacture has had the manufacturer's name applied to it, and he sells his business, good-will and "confers the authority to use his name," so applied, to his vendee, he will be enjoined from again engaging in a similar business under his own name.<sup>3</sup>

A covenant by the vendor not to re-engage in business may not specify the territory in which he is precluded from doing business. If from all the circumstances of

<sup>1</sup>Batchellor v. Thomson, 86 Fed. Rep. 630.

<sup>2</sup>Endicott, J., in *Dwight v. Hamilton*, 113 Mass. 175-177. Where the vendor re-engaged in the same (a mercantile) business in the same vicinity, a bill in equity brought by him to reform the contract of sale was dismissed on the ground that he had not done equity. *Cassidy v. Metcalf*, 1 Mo. App. 593-601. This decision was reversed by the supreme court of Missouri, but that court agreed with the St. Louis court of appeals in holding that "the plaintiff's conduct was not characterized by that good faith with which a party should always approach a court of equity when asking its assistance." *Cassidy v. Metcalf*, 65 Mo. 519.

<sup>3</sup>*Frazer v. Frazer Lubricator Co.*, 121 Ill. 147; *Ayer v. Hall*, 3 Brewst. 509; *Filkins v. Blackman*, 13 Blatch. 440; *Probasco v. Bouyon*, 1 Mo. App. 241.

the case it appears that it was the intention of the parties to limit that territory to a town, county or state, the contract will be so construed, and the vendor will be enjoined from continuing or re-entering business in the territory so fixed.<sup>1</sup>

A vendor of a good-will may not do indirectly what he is forbidden, by the terms of his contract, from doing directly. So if he form a corporation to carry on his business, and the other incorporators have knowledge of his contract, the corporation will be enjoined from conducting business with or for the vendor.<sup>2</sup> If he re-engages in business under the pretense of acting as a broker or commission agent only, the same rule applies and he will be enjoined.<sup>3</sup> And again, the rule applies where the defendant re-engages in the prohibited business as the salaried employee of a third person, and he will be enjoined.<sup>4</sup> In a case where the vendor covenanted to make the good-will as valuable as he could, Lord Eldon held that the vendee was not bound to take the actual profit made, but that he would "have an action of covenant, if he can establish his title to more through the default of the vendor."<sup>5</sup>

Where a limit of time is fixed in the covenant against re-engaging in business, the vendor may re-engage in the business upon the expiration of the time. But where the covenant was made jointly with a conveyance of the vendor's good-will, he was restrained after he re-engaged in business from making personal solicitation of his former customers and using extracts from their books in relation to the business.<sup>6</sup>

<sup>1</sup>Hubbard v. Miller, 27 Mich. 15.

<sup>2</sup>Beal v. Chase, 31 Mich. 490.

<sup>3</sup>Richardson v. Peacock, 33 N. J. Eq. 597.

<sup>4</sup>Finger v. Hahn, 42 N. J. Eq. 606.

<sup>5</sup>Scott v. Mackintosh, 1 V. & B. 503. As a matter of course such a covenant will not be created by implication. Where the vendor conveyed the good-will of a school, it was held that the sale did not bind him by implication to exert his efforts thereafter to secure the attendance of pupils. McCord v. Williams, 96 Pa. St. 78.

<sup>6</sup>Armstrong v. Bitner, 71 Md. 118-127.



§ 65. **Partnership good-will.**—Disputes as to good-will arise most frequently between partners. The various text-writers who have treated the law of partnership have dwelt at length upon the principles of the law of good-will which are applicable in this connection, so that for the purpose of this book a brief glance at the leading principles will suffice.

As we have seen elsewhere, every man has the right to use his own name in business so long as he does not use it in such a way as to establish an unfair competition.

The use of the name of a withdrawing partner, as part of the firm name, in such a way as to expose him to liability or to the possibility of being sued, will be enjoined at his suit.<sup>1</sup> The better rule would seem to be that in the absence of express agreement the firm name will not pass to one who purchases the assets of a partnership.<sup>2</sup>

When one partner has been expelled from the partnership because of his violation of its articles, he will not, in the absence of contract binding him not to re-engage in the business, be enjoined from doing similar business in his own name, and soliciting patronage from customers of the old firm.<sup>3</sup> A surviving partner who has the right to use the firm name may enjoin his deceased part-

<sup>1</sup>McGowan v. McGowan, 22 Ohio St. 370; Peterson v. Humphrey, 4 Abb. Pr. 394.

<sup>2</sup>Williams v. Farrand, 88 Mich. 473; Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. Rep. 816. This rule is not yet clearly established. Thus the supreme court of Ohio says: "Upon the dissolution of a trading copartnership its assets, including the good-will of the business, may be sold as a whole, either by the partners directly, or through a receiver under an order made by a court in a case to which they are parties; and that a purchaser thereof under either method of sale is entitled to continue the business as the successor of the firm, and make use of the firm name for that purpose. And further, that when the purchaser transfers the property so acquired by him to a corporation of which he is a member, organized to succeed to the business, it may carry on the business in the same manner under a corporate name including the name which had been used by the firm." Williams, J., in Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86-96; citing Brass & Iron Works v. Payne, 50 Ohio St. 115.

<sup>3</sup>Dawson v. Beeson, L. R. 24 Ch. D. 504.

ner's executor from using the firm name for his own benefit.<sup>1</sup>

Upon the appointment of a receiver for the firm assets, either member of the firm will be enjoined from so using his own name as to mislead the public into the belief that he has acquired the good-will, since such injunction is necessary to the preservation of the good-will as part of the firm assets.<sup>2</sup>

A retiring partner who has sold the other the firm property, without making mention of the good-will, will be granted an injunction against any use of the firm name by the continuing partner which would give the public reason to believe he was still a member of the firm, to the injury of his new business.<sup>3</sup>

Upon the dissolution of a partnership the partner who retains the use of the old premises may lawfully advertise the premises as being "formerly occupied by" the old firm, and either partner may advertise himself as being "formerly of" or "late of" the firm, using words that convey only the facts and have no tendency to deceive or mislead the firm's customers or the public generally.<sup>4</sup>

Where the retiring partner permits the old firm name (of which his name is a part) to be used, and makes no publication of the fact of his retirement, he is estopped from denying the copartnership, as against a creditor of the continuing partner, who has extended credit on the belief that he is still a member of the firm.<sup>5</sup>

Upon administration of a partnership estate, the good-will should be included in the appraisement of the partnership assets, and if the surviving partner appropriates

<sup>1</sup>Lewis v. Langdon, 7 Sim. 422.

<sup>2</sup>Bininger v. Clark, 60 Barb. 113. Where a retiring partner stipulated that the continuing partner might continue the use of his name in the style of the firm, it has been held that the assignment of the right to use the name is personal and cannot be transferred by the continuing partner to another. Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. Rep. 817; Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

<sup>3</sup>McGowan v. McGowan, 22 Ohio St. 370.

<sup>4</sup>Morgan v. Schuyler, 79 N. Y. 490.

<sup>5</sup>Backus v. Taylor, 84 Ind. 503; Richards v. Hunt, 65 Ga. 342.

it to his own use by continuing the partnership business, he may be compelled to account for its value to the estate of the deceased partner.<sup>1</sup>

Where a partner came into a partnership for a fixed period, agreeing "to carry on business with the defendants for one year, and then to leave it in their hands," he was held to have acquired thereby no interest in the good-will of the business.<sup>2</sup>

§ 66. **Remedies.**—The purchaser of a good-will whose enjoyment of it is interfered with may have his remedy either at law or in equity. These remedies are administered on the same general principles which apply to other cases of unfair competition, and which are discussed elsewhere in this book.

The jurisdiction of equity in this class of cases is predicated upon the fact that the injury is continuous, that its further operation can only be restrained by the exercise of the injunctive power of the chancellor, and that damages at law afford no adequate compensation for the injury.

If, however, the plaintiff resorts to an action at law, the measure of his damages is well defined by the supreme court of Missouri: "If plaintiffs lost less than the defendant made, they cannot recover the whole of defendant's profits; if plaintiffs lost more than the defendant made, they would not be limited to defendant's profits. What the plaintiffs have lost by the defendant's breach of covenant, and not what the defendant has gained thereby, is the legal measure of damages in this case."<sup>3</sup>

<sup>1</sup>Rammelsberg v. Mitchell, 29 Ohio St. 22.

<sup>2</sup>Van Dyke v. Jackson, 1 E. D. Smith (N. Y.), 419; Duden v. Maloy, 63 Fed. Rep. 183; 11 C. C. A. 119. In the latter case the partnership articles provided that the incoming partner's interest should be ascertained annually, and further provided for the sale of his interest to his partner on dissolution at the price ascertained in determining his share. The court held that this disposed of his property in the good-will.

<sup>3</sup>Hough, J., in Peltz v. Eichele, 62 Mo. 171-180. And to the same effect see Burckhardt v. Burckhardt, 36 Ohio St. 261.

The parties to a contract for the sale of a good-will may provide in the contract for a fixed amount of damages. In the absence of fraud, the sum so fixed will be adopted as the measure of damages by the court.<sup>1</sup> Where the parties have so agreed upon the amount of damages, the vendee, in case of a breach of covenant, has an adequate remedy at law, and injunction will not lie.<sup>2</sup> The remedy is for the recovery of the sum so fixed.<sup>3</sup>

Where there are no damages stipulated, and no substantial injury is proven, the plaintiff is entitled only to nominal damages. "The loss of profits, if there are data from which the amount may be ascertained with reasonable certainty, the diminution in value of the property sold, all may be regarded as elements of the damages which go to make up the measure of recovery."<sup>4</sup>

<sup>1</sup>Tode v. Gross, 127 N. Y. 480-487; Dakin v. Williams, 17 Wendell, 447; Bagley v. Peddie, 16 N. Y. 469; Wooster v. Kisch, 26 Hun, 61.

<sup>2</sup>Martin v. Murphy, 129 Ind. 464-467. Unless the defendant is insolvent, which fact will make a case for injunctive relief. Pickett v. Green, 120 Ind. 584.

The general doctrine that equity will not interfere to restrain a person from doing an act which he has agreed not to do, when liquidated damages have been provided in case he does the act, is subject to this qualification. "The question in every case is, what is the real meaning of the contract? And if the substance of the agreement is that the party shall not do a particular act, and that is the evident object and purpose of the agreement, and it is provided that, if there is a breach of this agreement, the party shall pay a stated sum, which does not clearly appear to be an alternative which he has the right to adopt instead of performing his contract, there would seem to be no reason why a court of equity should not restrain him from doing the act, and thus carry out the intention of the parties. . . . In other words, naming a sum to be paid as liquidated damages does not in itself conclusively establish that the parties contemplated the right to do the act upon payment of the compensation, and make an alternative agreement for the benefit of the party who has done what he had agreed not to do." Endicott, J., in Ropes v. Upton, 125 Mass. 258-261.

<sup>3</sup>Martin v. Murphy, 129 Ind. 464.

<sup>4</sup>Howard v. Taylor, 90 Ala. 241-244; Burckhardt v. Burckhardt, 47 Ohio St. 474; Mitchell v. Read, 84 N. Y. 556; Mellesch v. Keen, 28 Beavan, 453; Rawson v. Pratt, 91 Ind. 9; Lashus v. Chamberlain, 6 Utah, 385.

For the greater part the remedies open to the owner of a good-will whose rights are invaded are administered by courts of equity. But injury to a good-will may be effected in many various ways, for each of which an appropriate remedy will be found either at law or in equity. Thus where a defendant's good-will has been destroyed by a wrongful attachment, he will be allowed compensation therefor in an action for damages against the attaching creditor.<sup>1</sup>

In an action at law a petition which alleges that plaintiff has purchased defendant's business and good-will, an agreement that the defendant was not to re-engage in the same line of business for two years, and that, in violation of his agreement, he has re-engaged in the same line of business during such period, and thereby damaged plaintiff, has been held good on demurrer.<sup>2</sup>

The action for damages for breach of contract involving good-will is governed by the general principles involved in similar actions in trade-mark cases, which are considered elsewhere in this book.

A contract for the sale of a business and good-will will be rescinded if the vendor has falsely stated facts in regard to the value of the good-will; as where he has represented that his receipts from the business were greater than they actually had been,<sup>3</sup> or that the premises sold have brought a higher rental than they actually did.<sup>4</sup> And the misrepresentation has been held to rescind the contract where the misstatement was not made directly to the vendee, but to a third party who communicated it, with the vendor's knowledge, to the vendee.<sup>5</sup> On the other hand, the duty is imposed upon the vendee to act at once upon learning the facts which justify a rescission. Where he fails to do so he will be bound by his contract, and his remedy lies in an action for damages.<sup>6</sup>

<sup>1</sup>Miller v. Beck (Iowa), 72 N. W. Rep. 553.

<sup>2</sup>Erwin v. Hayden (Texas), 43 S. W. Rep. 610.

<sup>3</sup>Dobell v. Stevens, 3 B. & C. 623.

<sup>4</sup>Lysney v. Selby, 2 Ld. Raym. 1118.

<sup>5</sup>Pilmore v. Hood, 5 Bing. N. C. 97.

<sup>6</sup>Dobell v. Stevens, 3 B. & C. 623.

Whenever the false representations amount to a warranty, an action for damages will lie even in the absence of proof of fraud. Otherwise the burden is upon the vendee to show that the representation was fraudulently made.<sup>1</sup>

Covenants against re-engaging in business may be specifically enforced, as we have seen, or the vendor may be enjoined from their violation. It has been held in England that with an action for specific performance a claim for damages may be made as an alternative.<sup>2</sup>

It has been held that a debtor's good-will cannot be reached by a creditor's bill, because it is not subject to levy in satisfaction of their debts.<sup>3</sup>

The application for injunctive relief is governed by the rules concerning similar applications in trade-mark cases.

A plaintiff need not allege or prove damages as a prerequisite to an injunction to restrain a defendant from re-engaging in business, in breach of a covenant between the parties.<sup>4</sup> When a vendee in applying for an injunction also asked judgment for the possession of the books and papers used by the vendor in the business in which it had engaged in violation of its covenant, the order was refused because there was a remedy at law for their recovery.<sup>5</sup>

In cases where the vendor of a good-will is sought to be restrained from re-engaging in business in violation of his covenant, the amount in controversy is the value of the good-will, and the federal courts cannot acquire jurisdiction unless the value of the good-will exceeds \$2,000.<sup>6</sup>

<sup>1</sup>Redgrave v. Hurd, L. R. 20 Ch. D. 1.

<sup>2</sup>Hipgrave v. Case, L. R. 28 Ch. D. 356.

<sup>3</sup>Lilienthal v. Drucklieb, 84 Fed. Rep. 918.

<sup>4</sup>Anderson v. Rowland, 18 Tex. Civ. App. 460; 44 S. W. Rep. 911.

<sup>5</sup>Lawrence v. Times Printing Co., 90 Fed. Rep. 24-26.

<sup>6</sup>Lawrence v. Times Printing Co., 90 Fed. Rep. 24-28.

## CHAPTER VII.

### TRADE SECRETS; RIGHTS OF PRIVACY.

§ 67. **Introductory.**—“A secret in trade is fully recognized as property in equity, the disclosure of which will be restrained by injunction.”<sup>1</sup> A contract in reference to such a secret cannot be in restraint of trade, “because the public has no rights in the secret.”<sup>2</sup>

When the name applied to a secret preparation is a trade-mark, no one but the owner of the mark can apply it to the preparation. But if it be not a valid trade-mark, then the manufacture of the secret preparation, and the placing of it upon the market under the same name, is open to any one who can lawfully discover the secret process.<sup>3</sup> But “it is settled that a secret art is a legal subject of property,”<sup>4</sup> and its owner has a vested right to the secrecy of all those who occupy a fiduciary relationship to his business. So that no one who obtains

<sup>1</sup>Smith, P. J., in *Champlin v. Stoddart*, 30 Hun, 300-302.

<sup>2</sup>*Morse Machine Co. v. Morse*, 103 Mass. 73-75; *Vickery v. Welsh*, 19 Pick. 523-527.

<sup>3</sup>*Watkins v. Landon*, 52 Minn. 389; 54 N.W. Rep. 193; *Davis v. Kendall*, 2 R. I. 566; *Siegert v. Findlater*, L. R. 7 Ch. D. 801; *Comstock v. White*, 18 How. Pr. 421; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *James v. James*, L. R. 13 Eq. 421; *Canham v. Jones*, 2 V. & B. 218.

“It may also be observed, in this connection, that the word ‘property,’ as applied to trade secrets and inventions, has its limitations; for it is undoubtedly true that when an article manufactured by some secret process, which is not the subject of a patent, is thrown upon the market, the whole world is at liberty to discover, if it can by any fair means, what the process is, and, when discovery is thus made, to employ it in the manufacture of similar articles. In such a case, the inventor’s or manufacturer’s property in his process is gone; but the authorities all hold that, while knowledge obtained in this manner is perfectly legitimate, that which is obtained by any breach of confidence cannot be sanctioned.” *Adams, J., in Eastman Co. v. Reichenbach*, 20 N. Y. Supp. 110-116; affirmed, 29 N. Y. Supp. 1143; 79 Hun, 183.

<sup>4</sup>*Gray, J., in Peabody v. Norfolk*, 98 Mass. 452.

knowledge of the secret by fraud or unfair means will be permitted to avail himself of the fruits of his fraud, by disclosing the secret or manufacturing under it.<sup>1</sup>

§ 68. **Where equity will not interfere.**—“Courts of equity will not interfere by injunction in disputes between the owners of quack medicines, meaning thereby remedies or specifics whose composition is kept secret, and which are sold to be used by the purchasers without the advice of regular or licensed physicians.”<sup>2</sup> And in 1817 Lord Eldon said: “I do not think that the court ought to struggle to protect this sort of secrets in medicine.”<sup>3</sup>

And, broadly stated, equity will not interfere to prevent the disclosure of secrets by means of which frauds have been committed.<sup>4</sup>

Then there are limits to the extent of the injunction, which will be suggested by the facts in each particular case. For example, in one case which has been frequently cited, the plaintiff was a tanner and manufacturer of leather, owning secret processes in regard to the treatment of leather. Two of his former employees were enjoined, on his application, from disclosing any of his secret processes, but, in the absence of any proof of an express agreement of secrecy, the court refused that portion of his prayer for relief which asked that the defendants be enjoined from disclosing “where or from whom the complainant buys his materials, and to whom he sells his goods, or the prices at which he buys or sells;” the chancellor remarking that an agreement in reference to such matters “may well be regarded, in the absence of anything to the contrary in its terms, as limited in its obligation to the time of employment. . . . He (the employee), notwithstanding such agreement, might him-

<sup>1</sup> *Salomon v. Hertz*, 40 N. J. Eq. 400; *Little v. Gallus*, 38 N. Y. Supp. 487.

<sup>2</sup> *Shiras*, Circuit Justice, in *Kohler Mfg. Co. v. Beeshore*, 59 Fed. Rep. 572-574.

<sup>3</sup> *Williams v. Williams*, 3 Mer. 157; Seb. 26.

<sup>4</sup> *Follet v. Jeffreyes*, 1 Sim. N. S. 1; *Gartside v. Outram*, 3 Jur. N. S. 39.



self, after leaving the employment, use the knowledge he had obtained. He might sell to the customers of his late employer, and buy of those from whom the latter purchased, and do both in competition with him."<sup>1</sup>

§ 69. **Relief in equity.**—In one of the early cases in which a property right in trade secrets was recognized, the proceeding was one brought to enforce the specific performance of a contract for the sale of the good-will of a dyer's business, with the exclusive use of a secret mode of dyeing. Vice-Chancellor Leach sustained the contract and directed its specific performance. In the course of his opinion he said: "Although the policy of the law will not permit a general restraint of trade, yet a trader may sell a secret of business and restrain himself generally from using that secret. Let the master, in settling the deed which is to give effect to this agreement, introduce a general covenant to restrain the use of the secret for twenty years, and a covenant, limited in point of locality, as to carrying on the ordinary business of a dyer, both parties being willing that the agreement should be so modified."<sup>2</sup>

As against employees who attempt to profit by secrets of which they have obtained knowledge by reason of their employment, the right to relief in equity has always been recognized. In one of the early cases Lord Cranworth said: "There is no doubt whatever that where a party who has a secret in trade employs persons under contract, express or implied, or under duty, express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer."<sup>3</sup>

In order to obtain this relief it is not necessary that the employee should have been bound to secrecy by con-

<sup>1</sup>Runyon, C., in *Salomon v. Hertz*, 40 N. J. Eq. 400.

<sup>2</sup>*Bryson v. Whitehead*, 1 S. & S. 74.

<sup>3</sup>*Morison v. Moat*, 21 L. J. Ch. 248; *Ansell v. Gaubert*, Seton (4th ed.), 235; *Peabody v. Norfolk*, 98 Mass. 452; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121; *Hagg v. Darley*, 47 L. J. Ch. 567; *Thum Co. v. Tloczynski*, 114 Mich. 149; 72 N. W. Rep. 140; *Salomon v. Hertz*, 40 N. J. Eq. 400; *Eastman Co. v. Reichenbach*, 20 N. Y. Supp. 110; 29 N. Y. Supp. 1143; 79 Hun, 188; *Little v. Gallus*, 38 N. Y. Supp. 487;

tract. In an opinion dealing with a case of this character, Judge Williams said: "Having entered the service of complainants, and having had imparted to him their secrets, defendant was, in equity and good conscience, obliged to preserve them as sacredly as his own, and this as well without a contract as with it."<sup>1</sup> And another court has stated the rule as follows: "By a careful reading of the various decisions upon this subject, it will be seen that some are made to depend upon a breach of an express contract between the parties, while others proceed upon the theory that where a confidential relation exists between two or more parties engaged in a business venture, the law raises an implied contract between them that the employee will not divulge any trade secrets imparted to him, or discovered by him in the course of his employment, and that a disclosure of such secrets, thus acquired, is a breach of trust and a violation of good morals, to prevent which a court of equity should intervene."<sup>2</sup>

Where there is such a contract between employer and employee, it is not objectionable as being in restraint of trade.<sup>3</sup>

The obligation of secrecy extends to every character of employment. Thus, canvassers who have accumu-

Fralich v. Despar, 165 Pa. St. 24; Merryweather v. Moore, L. R. (1892) 2 Ch. 518; Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163.

The following contract was held valid and binding upon the defendant in *Fralich v. Despar*, *supra*:

"I, Andrew Despar, of the city of Pittsburg, state of Pennsylvania, in the employ of E. C. Fralich, a manufacturer of oils, etc., also of the said city of Pittsburg, do solemnly swear that if the said E. C. F. makes known to me the ways and secrets of manufacturing and stilling of different kinds of oils, and of the different kinds of grease manufactured by him, that I will not use such knowledge or secrets for my own gain, nor will I ever, so long as I may live, divulge or make known in any way the knowledge I may receive while in his employ, or any part of said secret, either of mixing in oils or otherwise."

<sup>1</sup>Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163-166.

<sup>2</sup>Adams, J., in *Eastman Co. v. Reichenbach*, 20 N. Y. Super. 110-116.

<sup>3</sup>Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; *Peabody v. Norfolk*, 98 Mass. 452.

lated materials in the course of soliciting advertisements for their employer may be enjoined from using such material for a rival publication;<sup>1</sup> and an engine maker's clerk who had made a table of dimensions of his employer's engines was enjoined from disclosing the data so obtained.<sup>2</sup>

The principles under consideration extend beyond the relationship of master and servant. In fact, throughout all of this book that relates to equitable remedies we are but dealing with the application of those remedies which has been made upon specific forms of fraud. The cases analogous to trade secrets are many, and the language of Vice-Chancellor Turner in the leading case of *Morrison v. Moat* is applicable to all of them: "Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred."<sup>3</sup>

So a photographer has been restrained from making prints from a negative bearing the plaintiff's portrait;<sup>4</sup> a lithographer, from making copies of the plaintiffs' pictures in excess of the number ordered by the plaintiffs;<sup>5</sup> and the exhibition of etchings, obtained by the defendant through a breach of trust, has been restrained,<sup>6</sup> as has the publication of lectures, not published or authorized to be published by the lecturer,<sup>7</sup> and the publication of private letters.<sup>8</sup>

<sup>1</sup>Lamb v. Evans, L. R. (1892) 3 Ch. 462.

<sup>2</sup>Merryweather v. Moore, L. R. (1892) 2 Ch. 522.

<sup>3</sup>Morrison v. Moat, 20 L. J. Ch. 522.

<sup>4</sup>Pollard v. Photographic Co., 40 C. D. (Eng.) 345.

<sup>5</sup>Tuck & Sons v. Priestler, 19 Q. B. D. 629.

<sup>6</sup>Albert v. Strange, 2 De G. & Sm. 652.

<sup>7</sup>Abernethy v. Hutchinson, 3 L. J. Ch. 214.

<sup>8</sup>Earl of Lytton v. Devey, 54 L. J. Ch. 293; Perceval v. Phipps, 2 Ves. & B. 19.

A peculiar state of facts developed in a recent case is worthy of notice. The plaintiff, a hardware dealer, had published and distributed to the trade catalogues in which the prices were marked in figures, letters and characters, according to a secret code devised by plaintiff. The defendant, who owned a copy of the catalogue, so marked with prices in secret characters, obtained a copy of the key to the code from one of the plaintiff's employees, and incorporated the secret code from the key into the catalogue. Upon this state of facts the defendant was enjoined from disclosing the information thus obtained, and a receiver was appointed to take charge of the defendant's copy of the catalogue.<sup>1</sup> This case appears to be in conflict with the English case of *Reuter's Telegram Co. v. Byron*, where the plaintiffs had devised a cypher code containing cypher words indicating the names of their customers. This cypher was communicated to the defendant while he was in the employment of the plaintiffs. After he left the plaintiffs and started a rival business, he sent advertisements to their customers stating that he had their cyphers, and soliciting their custom. The court held that the defendant was guilty of no breach of trust because the cyphers were known to the customers, and the defendant could have obtained the cyphers from any of them who might choose to do business with him.<sup>2</sup> The decision of the American court seems to be correct in principle.

In every case where the plaintiff seeks protection for a trade secret, it must appear that it really is a secret. If a so-called secret process is known to others in the trade, no one will be enjoined from disclosing or using it.<sup>3</sup> But the fact that the secret has been the subject of a patent, since expired, which remained a mere paper patent, and dormant, does not negative the fact that it is or may be still a secret. "Many an invention and many an idea of value are doubtless to be found in the

<sup>1</sup> *Simmons Hardware Co. v. Waibel* (1 So. Dak.), 47 N.W. Rep. 814.

<sup>2</sup> *Reuter's Telegram Co. v. Byron*, 43 L. J. Ch. 661.

<sup>3</sup> *Bell & Bogart Soap Co. v. Petrolia Mfg. Co.*, 54 N. Y. Supp. 663-666; *Bristol v. Equitable Life Assurance Society*, 132 N. Y. 264.

records of the patent office, but so far as public actual knowledge thereof is concerned, they might as well be non-existent."<sup>1</sup>

Contracts relating to trade secrets are, of course, subject to the same rules of construction as other contracts. So in a case where the defendant sold a formula for making certain soap and "agreed to file and surrender his right and claims in the process and formulæ and making of said soap," and that he "would not sell any plants in the United States for the manufacture of (that particular kind of) soap, during the term of twenty years," it was very properly decided that the contract did not preclude him from selling or putting up any other kind of a soap plant to or for anybody else; and where he put up a soap plant for making soaps in general, and the owner of the plant then began the manufacture of the particular soap in question, there was no cause of action either as against him or the owners of the plant.<sup>2</sup>

Employees may be enjoined from disclosing trade secrets even in the absence of an express agreement of secrecy, as we have seen, and it is no defense that the employee was a minor at the time he entered the employment.<sup>3</sup>

A defendant had agreed upon entering the employment of the plaintiff as a workman, on a salary, to disclose certain secret processes known only to him. He failed to make the disclosure and left the plaintiff's employment. In defense to an application for an injunction restraining him from imparting the secret processes to others, he urged that his employment had been for no definite term. This defense did not avail in view of the fact that the plaintiff had invested in matters it expected to use in connection with the secret processes. The court observed that "although the processes were not patented, yet, as they were secret, and as their secrecy was protected by the contract between the defendant and the plaintiff, the plaintiff is in a situation to insist that the

<sup>1</sup> Shiras, J., in *Benton v. Ward*, 59 Fed. Rep. 411-413.

<sup>2</sup> *Bell & Bogart Soap Co. v. Petrolia Mfg. Co.*, 54 N. Y. Supp. 663.

<sup>3</sup> *Little v. Gallus*, 38 N. Y. Supp. 487.

defendant, who agreed to protect the secrecy of these processes, and thus preserve their value, should not be permitted to disclose them, and thus deprive the plaintiff of the valuable property which he had induced it to purchase."<sup>1</sup>

Where an employee of a partnership invents secret processes for the use of the firm, either member of the firm may after dissolution use the secret process, and either member will, on the complaint of another member, be enjoined from representing himself as being the sole owner of such secret process.<sup>2</sup>

§ 70. **The right of privacy.**—The right of privacy is among the most vague and indefinite elements of modern equity jurisprudence. In its broadest sense it may be defined to be the right of an individual to injunctive protection against the unauthorized publication of a portrait or other purely personal matter relating to himself or his relatives. The subject has been very thoughtfully treated in some of the leading legal periodicals,<sup>3</sup> but so far it has received but little attention from the courts. Where the existence of the doctrine has been admitted, it has been given a construction so narrow as to deprive it of any practical value. But the reported cases contain much that is interesting, and the close relationship between this subject and that of trade secrets warrants giving here a brief *resume* of its treatment by the courts.

In 1892 this right was distinctly affirmed by the supreme court of New York in a case<sup>4</sup> in which an injunction issued against the execution and display at the Chicago World's Fair of a statue of one Mrs. Schuyler, which

<sup>1</sup>Rumsey, J., in *National Gum & Mica Co. v. Braendly*, 51 N. Y. Supp. 93-97.

<sup>2</sup>*Baldwin v. Von Micheroux*, 25 N. Y. Supp. 857; affirmed, 83 Hun, 43; 31 N. Y. Supp. 857.

<sup>3</sup>"The Right of Privacy," 4 Harv. Law Rev. 193; and editorials in 32 Cent. L. J. 69; 40 Cent. L. J. 53; 49 Cent. L. J. 379; "Schuyler v. Curtis, and the Right of Privacy," 36 Am. Law Reg. and Rev. N. S. 745; "The Right to Injunction as a Means of Protecting Privacy," 7 Am. Lawyer, 558.

<sup>4</sup>*Schuyler v. Curtis*, 19 N. Y. Supp. 264.

statue was to be designated "The Typical Philanthropist." The proceeding was brought by a relative of Mrs. Schuyler, and the injunction issued against the members of an unincorporated association under whose auspices the display was to be made. The motion for injunction *pendente lite* was granted upon the ground that Mrs. Schuyler was not a public character because she had not placed herself before the public, either in accepting public office or in becoming a candidate for office, or as an *artiste* or *literateure*. This order being appealed from, Van Brunt, P. J., said: "While concurring with the conclusion arrived at by the learned justice below, I cannot subscribe to the doctrine which seems to pervade the opinion rendered upon the decision of the motion, that if Mrs. Schuyler had been a public character, as defined by him, this motion should have been denied. The claim that a person who voluntarily places himself before the public, either by accepting public office or becoming a candidate for office, or as an artist or literary man, thereby surrenders his personality while living and his memory when dead to the public, to be used or abused, as any one of that irresponsible body may see fit, cannot for a moment be entertained. . . . It is urged upon the part of the appellants that even if Mrs. Schuyler were alive, and had the same objection to the defendants' proposed action that the plaintiff now has, she would be remediless and powerless. If such were the fact, it would certainly be a blot upon our boasted system of jurisprudence that the courts were powerless to prevent the unwarranted doing of things by persons who are mere volunteers, which would wound in the most cruel manner the feelings of many a sensitive nature. It is further urged that the plaintiff has no standing in court and that the fancied injury to the plaintiff complained of, if any such injury can be in any way discovered, is certainly not such an injury as the court will grant an injunction to prevent, because it is not an injury to his person, to his estate, or to his good name, and is not a violation of his privacy or seclusion, and

because the plaintiff stands in the same relation to the defendants and to their project as does all the rest of the world, and in no other relation. The result of this claim is that when a person is dead there is no power in any court to protect his memory, no matter how outrageously it may be insulted. The feelings of relatives and friends may be outraged, and the memory of the deceased degraded with impunity, by any person who may desire thus to affect the living. It seems to us that such a proposition carries its own refutation with its statement. It cannot be that by death all protection to the reputation of the dead and the feelings of the living, in connection with the dead, has absolutely been lost. The memory of the deceased belongs to the surviving relatives and friends, and such relatives have a right to see that that which would not have been permitted in respect to the deceased when living shall not be done with impunity when the subject has become incapable of protecting himself. It is undoubtedly true that cases of the character now before the court are not to be found in the books. But it is probably the first time in the history of the world that the audacious claim which is here presented has ever been advanced. If it had, we have no doubt the books would have contained a record in connection with the same. The fact that the plaintiff has suffered no pecuniary damage, redress for which is sought in this action, is no answer to the application, because one of the most important departments in the jurisprudence of courts of equity is the prevention of wrongs which would be otherwise irreparable because courts of law cannot afford any remedy in damages."<sup>1</sup>

Upon entering judgment in the same case, Ingraham, J., calls attention to the fact that the action of the defendants was not a libel nor within the provisions of the New York constitution securing to each citizen the right to freely speak, write and publish his sentiments on all subjects.<sup>2</sup>

<sup>1</sup> *Schuyler v. Curtis*, 64 Hun, 594.

<sup>2</sup> *Schuyler v. Curtis*, 24 N. Y. Supp. 509-511.



In a subsequent case (1893) the superior court of New York city reaffirmed the doctrines of *Schuyler v. Curtis* in the case of an actor whose portrait was to be published in connection with that of another member of his profession as the subjects of a voting contest to ascertain which was the more popular, and such publication was enjoined.<sup>1</sup>

In 1895 *Schuyler v. Curtis* reached the New York court of appeals, and in an elaborate opinion delivered by Judge Peckham the judgment of the lower court was reversed. In the course of his opinion, however, he says: "For the purpose we have in view it is unnecessary to wholly deny the existence of the right of privacy to which the plaintiff appeals as the foundation of his cause of action. It may be admitted that courts have power in some cases to enjoin the doing of an act where the nature or character of the act itself is well calculated to wound the sensibilities of an individual, and where the doing of the act is wholly unjustifiable, and is, in legal contemplation, a wrong, even though the existence of no 'property,' as that term is generally used, is involved in the subject."<sup>2</sup>

Pending this appeal another New York court had held that "a parent cannot maintain an action to enjoin the unauthorized publication of the portrait of an infant child, and for damages for injury to his sensibilities caused by the invasion of his child's privacy, for the law takes no cognizance of a sentimental injury, independent of a wrong to person or property."<sup>3</sup>

The supreme court of Michigan in 1899 has held that it had no jurisdiction to enjoin the use of the name and likeness of a deceased person used upon a label applied to a cigar named after him, so long as such publication did not amount to a libel. At the conclusion of an exhaustive review of the cases, Hooker, J., said: "This 'law

<sup>1</sup>Marks v. Jaffa, 26 N. Y. Supp. 908.

<sup>2</sup>Schuyler v. Curtis, 42 N. E. Rep. 22-24; 147 N. Y. 434; 49 Am. St. Rep. 671; 31 L. R. A. 286.

<sup>3</sup>Murray v. Engraving Co., 28 N. Y. Supp. 271.

of privacy' seems to have obtained a foothold at one time in the history of our jurisprudence, not by that name, it is true, but in effect. It is evidenced by the old maxim, the greater the truth the greater the libel; and the result has been the emphatic expression of public disapproval, by the emancipation of the press and the establishment of freedom of speech, and the abolition in most of our states of the maxim quoted, by constitutional provisions."

"The limitation upon the exercise of these rights being the law of slander and libel, whereby the publication of an untruth that can be presumed or shown to the satisfaction, not of the plaintiff, but of others (*i. e.*, an impartial jury), to be injurious, not alone to the feelings but to the reputation, is actionable. Should it be thought that it is a hard rule that is applied in this case, it is only necessary to call attention to the fact that a ready remedy is to be found in legislation. We are not satisfied, however, that the rule is a hard one, and think that the consensus of opinion must be that the complainants contend for a much harder one."<sup>1</sup>

The only case in which the question of the existence of the right of privacy has been brought before the federal courts is one which the widow and children of George H. Corliss, an inventor, brought to enjoin the publication of a biographical sketch and portrait of Mr. Corliss. The plaintiffs put their case squarely upon the proposition that the proposed publication would be an invasion of the right of privacy which a court of equity should protect. There was some discussion upon the question whether Mr. Corliss was a public or a private character. The court distinctly denied the existence of any right of privacy which it could recognize, saying that under the law "one can speak and publish what he desires, provided he commits no offense against public morals or private reputation."<sup>2</sup> The opinion pro-

<sup>1</sup>Atkinson v. John E. Doherty & Co. (Mich.), 80 N. W. Rep. 285-289.

<sup>2</sup>Corliss v. E. W. Walker Co., 57 Fed. Rep. 434.

ceeds flatly on the theory that a court of equity has no power to restrain a libelous publication.<sup>1</sup> At the same time the publication of the portrait was enjoined because the original had been obtained by the defendant from the plaintiffs on certain conditions which it had not complied with.

Upon the motion to dissolve the injunction certain additional evidence had been adduced, and the court in its opinion finds the fact to be that the defendant had obtained the portrait from a photograph; and that Mr. Corliss was in fact a public character. The court says: "The distinction in the case of a picture or photograph lies, it seems to me, between public and private character. A private individual should be protected against the publication of any portraiture of himself, but where an individual becomes a public character the case is different. A statesman, author, artist, or inventor, who asks for and desires public recognition, may be said to have surrendered this right to the public."<sup>2</sup>

These cases practically negative the existence of any right of privacy that the courts will enforce. Under different facts and with the growth of the law the subject may possibly develop into one of consequence in the future.<sup>3</sup>

<sup>1</sup> *Boston Diatite Co. v. Florence Mfg. Co.*, 114 Mass. 69; *Brandreth v. Lance*, 8 Paige, 24; *Kidd v. Horry*, 28 Fed. Rep. 773.

<sup>2</sup> *Corliss v. E. W. Walker Co.*, 64 Fed. Rep. 280-282.

<sup>3</sup> Thus in a recent case presented to the Patent Office the applicant sought to register the mark "Dewey's Chewies," for confectionery. The commissioner said, in response to the applicant's suggestion that "Dewey's" is not an ordinary surname: "I cannot refrain from expressing the opinion that even if it be registrable, no one has the right without the consent of Dewey to appropriate it as a trademark. A living celebrity is entitled to protection from the ordinary trader." Duell, Commissioner, in *Ex parte McInnerney*, 85 Off. Gaz. 149.

## CHAPTER VIII.

### INFRINGEMENT.

§ 71. **Of infringement generally.**—The word “infringement” is difficult of exact definition. For the purposes of the present discussion, its broadest meaning, that of the infraction or invasion of another’s trade rights, by passing off, or attempting to pass off, upon the public one’s own goods as his, may suffice. As to technical trade-mark infringement, it should be more narrowly defined as the infraction or invasion of any portion of the mark, symbol or device in which one has acquired a right of property, either by way of reproduction in fac-simile, or imitation. An English text-writer has thus defined it: “Infringement is the use by the defendant, for trading purposes, in connection with goods of the kind for which the plaintiff’s right to exclusive use exists, not being the goods of the plaintiff, of a mark identical with the plaintiff’s mark, or either comprising some of its essential features or colourably resembling it, so as to be calculated to cause the goods to be taken by ordinary purchasers in any market where the marks circulate, for the goods of the plaintiff.”<sup>1</sup> Vice-Chancellor Shadwell stated the rule to be that, if a mark contains twenty-five parts and but one is taken (*i. e.*, imitated or copied), liability has been created thereby, and there has been a technical infringement.<sup>2</sup>

§ 72. **No trade-mark in form, size, material or color.**—It is a well settled rule that there can be no trade-mark right in the mere form, size or color of an

<sup>1</sup>Kerly on Trade-marks (London, 1894), p. 305.

<sup>2</sup>Guinness v. Ullmer, 10 L. T. 127; Seb. 89. “The imitation need not be exact or perfect. It may be limited or partial; nor is it requisite that the whole should be pirated.” Filley v. Fassett, 44 Mo. 173; Cox, 530; Seb. 313. And to the same effect, Braham v. Bustard, 9 L. T. N. S. 199; 1 Hem. & M. 447; 11 W. R. 1061; 2 N. R. 572; Seb. 226.

article used commercially, or the form, size or color of the package containing it.<sup>1</sup> It is also an established principle that there can be no trade-mark right in the directions, notices or usual advertising matter used upon or in description of merchandise.<sup>2</sup> There has never been a deviation from this rule in the adjudications of the courts of this country. Whenever relief has been granted against an imitator or counterfeiter of either the form, size, color, method of packing, advertising, or directions used by a legitimate dealer, it has been granted upon the broad theory of regulating fraud, and not upon the narrower ground of technical trade-mark infringement.

There can be no technical trade-mark in a well known material substance, such as a tin tag impressed upon plug tobacco;<sup>3</sup> nor in a method of packing merchandise;<sup>4</sup> but a fraudulent imitation of another's tin tag has been restrained;<sup>5</sup> and injunctions against the fraudulent use of another's style of package are frequent, in the absence of any claim to a technical trade-mark right in the complainant.

The courts have been averse to recognizing a trade-mark right in anything calculated to be useful, aside from indicating origin or ownership. So, in holding that

<sup>1</sup>Moorman v. Hoge, 2 Sawyer, 78; Harrington v. Libby, 14 Blatchf. 128; Ball v. Siegel, 116 Ill. 143; Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. 292; Sawyer v. Horn, 4 Hughes, 239; 1 Fed. Rep. 24; Manhattan Medicine Co. v. Wood, 108 U. S. 218; Re Kane & Co., 9 Off. Gaz. 105; Liggett & Myers Tob. Co. v. Hynes, 20 Fed. Rep. 883; Fairbanks v. Jacobus, 14 Blatchf. 337; Wilcox & Gibbs Sewing Machine Co. v. Gibbons, 21 Blatchf. 431; Brill v. Singer Mfg. Co., 41 Ohio St. 127; Re Whitaker, Newton's Dig. 130; Adams v. Heisel, 31 Fed. Rep. 279; Lorillard v. Pride, 28 Fed. Rep. 434; Davis v. Davis, 27 Fed. Rep. 490; Nuthall v. Vining, 28 W. R. 330; Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Witteman, 85 Fed. Rep. 966; Von Mumm v. Witteman (2), 91 Fed. Rep. 126; Fleischmann v. Starkey, 25 Fed. Rep. 127; Brown v. Doscher, 147 N. Y. 647-651; Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-811.

<sup>2</sup>Candee v. Deere, 54 Ill. 462; Ball v. Siegel, 116 Ill. 143.

<sup>3</sup>Lorillard v. Pride, 28 Fed. Rep. 434.

<sup>4</sup>Davis v. Davis, 27 Fed. Rep. 490.

<sup>5</sup>Lorillard v. Wight, 15 Fed. Rep. 383.

there was no trade-mark right in a series of indentations in plug tobacco, so arranged as to serve as guides in cutting the plug into pieces of one ounce each, Judge Blodgett said: "One of the principles running through the law of trade-marks is that there need be no utility attached to the trade-mark itself—that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture."<sup>1</sup>

**§ 73. The early adjudications.**—The endeavor of the dishonest merchant to prey upon and profit by the reputation of his honest competitor is always hampered by fear of detection. If a trade-mark is counterfeited the counterfeit product is placed upon the market stealthily; where the offender lacks the courage to counterfeit he resorts to colorable imitations, not of his competitor's trade-mark, but of his methods of packing and preparing goods for sale, thus simulating a resemblance, in the words of Judge Lacombe, "sufficiently strong to mislead the consumer, although containing variations sufficient to argue about, should the designer be brought into court."<sup>2</sup>

The earliest leading case involving this form of fraudulent competition arose between rival soap manufacturers. The plaintiffs made and sold an article styled "Genuine Yankee Soap." The defendant put up a soap under the same style, imitating the size and shape of the cake, the color and material of the wrapper, and a hand-bill, as used by the plaintiffs. There was a disinclination on the part of the court to decide whether the words "Genuine Yankee" were a valid trade-mark, and its decision was put solely upon the ground of unfair trade, the court saying: "The defendant is engaged in a gross and palpable endeavor, by imitating the marks and labels used by plaintiffs, to deceive the public and obtain patronage which would in all probability be attracted to the plaintiffs. . . . They have adopted, in reference to their manufacture (of an article which any and every one may

<sup>1</sup> Dausman & Drummond Tobacco Co. v. Ruffner, 15 Off. Gaz. 559.

<sup>2</sup> Collinsplatt v. Finlayson, 88 Fed. Rep. 693.

manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior handbill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold and known as their manufacture. All this the defendant has copied, with an exactness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. . . . Without deciding whether the defendant may or may not use either of the words 'Genuine' or 'Yankee,' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or handbills which he is using, nor any other like labels, handbills, or devices, in imitation of, or simulating the labels, devices, or handbills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or handbills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."<sup>1</sup>

Mr. Rowland Cox has said,<sup>2</sup> however, that the rule "that where the appearance of a peculiar and original package has acquired through use an understood reference to the goods of a manufacturer, and a competing manufacturer knowingly imitates the peculiar characteristics of the package, with intent to deceive the public, such imitation will be held to be an infringement of the rights of the person first using the package," can hardly be said to have found distinct expression prior to 1878, where it occurs in the opinion of Judge Wheeler in *Frese v. Bachof*.<sup>3</sup> And, indeed, that decision, if not the earliest, is still one of the clearest in its enunciation of the rule.

§ 74. **Infringement of color.**—The cases in which an unfair competition is effected by means of infringement

<sup>1</sup>Williams v. Johnson (1857), 2 Bos. 1; Cox, 214.

<sup>2</sup>Cox, Manual, p. 86; note to Williams v. Johnson.

<sup>3</sup>Seb. 603; 13 Off. Gaz. 635.

of color alone are naturally very few in number. Indeed the case nearest approximating such an infringement is one in which the complainant and defendant manufactured stoves of similar external appearance, enameling the inside faces of their stoves with white enamel. On demurrer to the bill Judge Baker said: "If the question for decision were simply whether the plaintiff could acquire the sole right to use white enamel for the lining of the doors of its stoves and ranges, it would present a question whose solution would prove embarrassing. But the case made upon the bill and admitted by the demurrer is that the defendants are manufacturing stoves and ranges having white enamel doors in the similitude of those manufactured by complainant, and with the fraudulent purpose of palming them off upon the trade and the public as the stoves and ranges manufactured by the complainant. It is not necessary to determine whether the white enamel lining, which has been long and exclusively used by the complainant for the inner lining of the doors of its stoves and ranges, constitutes a trade-mark, or whether it does not. It is sufficient to justify the interposition of a court of equity if the stoves and ranges manufactured by the defendants are purposely constructed in the similitude of those manufactured by the complainant, with the intention and result of deceiving the trade and the public, and inducing them to purchase the stoves and ranges of the defendants in the belief that they are purchasing the stoves and ranges of the complainant's manufacture. The imitative devices used upon the stoves and ranges manufactured by the defendants are alleged to be employed by them for the purpose and with the result of deceiving the public, and thereby diverting the trade of the complainant to the defendants. This they have neither the moral nor the legal right to do."<sup>1</sup>

The question of its collocation must always be considered in connection with the question of infringement by the use of color. Announcing the opinion of the federal

<sup>1</sup>Buck's Stove & Range Co. v. Kiechle, 76 Fed. Rep. 758.



circuit court of appeals of the second circuit, Judge Lacombe has said: "Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well, which go to make up the entire combination. Because a total change of color would so change the general appearance as to destroy resemblance to another package, it by no means follows that color alone would be sufficient to produce a general appearance, resembling another package. It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements, each differing more or less from its analogue in complainant's package, had been so collocated together as to produce a general appearance calculated to delude the unwary purchaser."<sup>1</sup>

So that we find many cases in which the imitation of color has been a material element in determining the question of infringement.<sup>2</sup> In a proper case the court will enjoin the defendant from using the color used by

<sup>1</sup>N. K. Fairbanks Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869; reversing s. c., 71 Fed. Rep. 295. To the same effect, see Allen B. Wrisley Co. v. Geo. E. Rouse Soap Co., 87 Fed. Rep. 589.

<sup>2</sup>Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Carbolio Soap Co. v. Thompson, 25 Fed. Rep. 625; Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-438; Anheuser-Busch Brewing Co. v. Clarke, 26 Fed. Rep. 410; Landreth v. Landreth, 22 Fed. Rep. 41; Lorillard v. Wight, 15 Fed. Rep. 383; Hostetter v. Adams, 10 Fed. Rep. 838; Von Mumm v. Frash, 56 Fed. Rep. 830; Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 Fed. Rep. 289; Gail v. Wackerbarth, 28 Fed. Rep. 286; Hires v. Hires, 6 Pa. Dis. R. 285; Myers v. Theller, 38 Fed. Rep. 607; American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14; Sperry v. Percival Milling Co., 81 Cal. 252; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293; Fleischmann v. Starkey, 25 Fed. Rep. 127; Carlisle Soap Co. v. Thompson, 25 Fed. Rep. 625; C. F. Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662; reversing s. c., 79 Fed. Rep. 954; Fischer v. Blank, 138 N. Y. 251; Cox, Manual, 731; McCann v. Anthony, 21 Mo. App. 83; 38 Off. Gaz. 333; Von Mumm v. Kirk, 40 Fed. Rep. 589; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Philadelphia Nov. Co. v. Blakesley Nov. Co., 40 Fed. Rep. 588; Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357.

the plaintiff, upon the theory that the defendant must be allowed no advantage out of the trade thus obtained wrongfully, but must establish the reputation of his goods upon merit, and without benefit of the imitation.<sup>1</sup>

It may be said that in issues of technical trade-mark infringement the color of the respective marks is frequently of controlling importance. Any system of registration, to be effective, ought to provide for the registration of marks in the exact coloring which it is intended to apply to the mark in use. After the English court of appeals had discussed this question,<sup>2</sup> it was enacted by Parliament that registration might be in color.<sup>3</sup>

**§ 75. Infringement of size and form.**—The decision of the leading case, *Cook & Bernheimer Co. v. Ross*,<sup>4</sup> by Judge Lacombe in the circuit court of the United States for the southern district of New York, marked a distinct advance in the scientific development of the law of unfair competition. The complainant was a corporation which had acquired the sole right to bottle, at the distillery, the "Mount Vernon Rye" whisky distilled by the Hannis Distilling Company, in which bottling the complainant used a bottle of distinctive form. The facts more fully appear in the opinion, a portion of which is as follows:

"Complainant, of course, has no exclusive right to the name 'Mount Vernon,' and the labels of defendants are in no sense an imitation of the labels of the complainant.

<sup>1</sup>*Franck v. Frank Chicory Co.*, 95 Fed. Rep. 818-821.

<sup>2</sup>*Re Worthington & Co.'s Trade-mark*, L. R. 14 Ch. D. 8-18. See also *Nuthall v. Vining*, 28 W. R. 330; *Cartmell*, 248.

<sup>3</sup>The Patents, Designs, and Trade-marks Act, 1883, sec. 67. It has been held, under this section, that the mark registered in color must be distinctive apart from its color; and as said by Kay, J.: "You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because, practically, under the terms of the act, that would give you a monopoly of all the colors of the rainbow." *Re Hanson's Trade-mark*, 5 R. P. C. 130; L. R. 37 Ch. D. 112; 57 L. J. Ch. 173; 57 L. T. N. S. 859; 36 W. R. 134; *Cartmell*, 146.

<sup>4</sup>73 Fed. Rep. 203.

Complainant's case rests solely on the form of package, which it claims has been so imitated as to make out a case of unfair competition.

“Undoubtedly, a large part of the consumption of whisky is in public drinking places, where it is dispensed to the consumer from the opened bottle. It is always desirable, therefore, for a dealer who wishes to push the sale of his own goods on their own merits to devise, if he can, some earmark more permanent than a pasted label to distinguish them. Complainant's predecessors accordingly, in March, 1890, adopted a brown glass bottle of a peculiar square shape, unlike any that had theretofore been used for bottling whisky, or, indeed, so far as the evidence shows, for any other purpose. It is a form of package well calculated by its novelty to catch the eye, and be retained in the remembrance of any one who has once seen it. In order to develop and extend the business they expected to control under their agreement with the Hannis Distilling Company, complainant and its predecessors have expended more than \$50,000 in advertising its said bottling. In all these advertisements the peculiar square-shaped bottle is the chief and most prominent feature. It is not surprising, therefore, to find it stated in the moving affidavits that the shape and general appearance of the bottle has come to be principally, if not exclusively, relied on by ordinary purchasers as the means of identifying this bottling of Mount Vernon whisky from all other bottlings, the purity of which is not guaranteed by the distillers, but only by the bottler. Complainant's bottling seems to have acquired a high reputation, large and increasing quantities of it being yearly sold, at a price in excess of that obtained by other bottlers of Mount Vernon whisky.

“About December, 1895, defendants, who had been dealing in Mount Vernon whisky for many years, began first to put it up in bottles, which are Chinese copies of the peculiar square-shaped, bulging-necked bottles of the complainant. Of course, they aver that this was without any intention ‘to deceive the public, or to palm off

defendants' goods for complainant's.' They account for the sudden appearance of their output of Mount Vernon whisky in this form as follows: 'There was a demand for Mount Vernon whisky along in November last, and defendants sought a convenient and useful package in which to place their product upon the market, and purchased a stock of bottles of the square form for that purpose, without making a special design therefor, and in the open market;' and allege that 'such bottles can be purchased of reputable bottle manufacturers from molds used for some time last past.' This last averment may well be true. The industry of defendants' counsel has marshaled here an array of square-shaped bottles filled with whisky, which shows that for some time imitations of complainant's bottle have been on the market. But there is not a word of proof to trace back any one of these bottles to a period anterior to the adoption of the square shape by complainant's predecessor as a distinctive form of package. Despite defendants' denials,—and they only deny intent to deceive the public, not intent to use a form of package just like complainant's,—the court cannot escape the conviction that they found the square-shaped bottle 'convenient and useful,' because it was calculated to increase the sale of their goods; and that such increase, if increase there be, is due to the circumstance that the purchasers from defendants have a reasonable expectation that the ultimate consumer, deceived by the shape, will mistake the bottle for one of complainants'. This is unfair competition within the authorities, and should be restrained. Injunction *pendente lite* is granted against the further use of the square-shaped, bulging-necked bottle as a package for Mount Vernon whisky."

There never existed a valid reason why a manufacturer should not be protected in the use of a package so peculiar and distinctive in size and shape as not to interfere with the packing methods of the trade generally. In this respect the law of trade-marks fell short in the recognition it should have extended to tradesmen, who,

like the Cook & Bernheimer Company in the case last mentioned, chose to distinguish their wares by distinctive packing. On account of this deficiency in the law, occasional hardships were inflicted upon honest tradesmen and the dishonest competitor went unwhipped of justice.<sup>1</sup> But the amount of fraudulent trading effected by means of this form of imitation was sure to evoke the ruling of the leading case in time, and there are numbers of other cases in which an imitation of size and form has been a moving ground of injunction.<sup>2</sup> The remedy has in some cases been held to be dependent upon proof that the public has actually been deceived by the defendant's package.<sup>3</sup> It has been expressly held, indeed, that "there is no unfair competition, apart from the infringement of a patent or trade-mark, unless the competing person so makes or marks his goods or conducts his business that purchasers of ordinary caution and prudence, and not those who are exceptionally dull, are likely to be misled into the belief that his goods are the goods of somebody else."<sup>4</sup> But it is the probability of deception, and not proof that customers have actually been deceived, that controls or should control in all cases of unfair competition as well as in cases of technical trade-mark infringement. A learned English judge has asked: "Why should we be astute to say that (the defendant)

<sup>1</sup>Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. 292.

<sup>2</sup>Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809; Apollinaris Co. v. Brumler, Cox, Manual, 429; Hostetter v. Adams, 10 Fed. Rep. 838; Sawyer v. Kellogg, 7 Fed. Rep. 720; Sperry & Co. v. Percival Milling Co., 81 Cal. 252; Noera v. Williams Mfg. Co., 158 Mass. 110; Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205; Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Hildreth v. McDonald, 164 Mass. 16; 49 Am. St. Rep. 440; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293.

<sup>3</sup>Hildreth v. McDonald, 164 Mass. 16; 49 Am. St. Rep. 440.

<sup>4</sup>Allen, J., in Dover Stamping Co. v. Fellows, 163 Mass. 191; 47 Am. St. Rep. 448; citing Gilman v. Hunnewell, 122 Mass. 139; Singer Mfg. Co. v. Wilson, 2 Ch. D. 434-447; Brill v. Singer Mfg. Co., 41 Ohio St. 127; 52 Am. Rep. 74; Robertson v. Berry, 50 Md. 591; 33 Am. Rep. 328. To the same effect, Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Witteman, 85 Fed. Rep. 966; affirmed, 91 Fed. Rep. 126.

cannot succeed in doing what he is straining every nerve to do?"<sup>1</sup> Where the form and size of a package have become common to a trade, resemblance in either or both of these particulars is not actionable.<sup>2</sup>

In all of this class of cases the general rule of trade-mark law applies, that it is immaterial whether the goods sold by the defendant are inferior or superior to those of the plaintiff. Thus in an early case Judge Morris said: "What we decide is that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labeled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color and label, no person has the right to use the complainant's form of package, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality."<sup>3</sup>

§ 76. **Intent and scienter.**—It was at first held that equity could only administer relief ancillary to that offered by the courts of law. It is, indeed, difficult to apprehend on what ground this reluctance to interfere in trade-mark cases arose. The only explanation vouchsafed is, that when chancery undertook to act it was "exercising a jurisdiction over legal rights."<sup>4</sup> But whether at law or in equity, the doctrine of the common law prevailed, that the defendant must be shown to have guilty knowledge or fraudulent intent.<sup>5</sup>

In 1838 the rule was distinctly announced that courts of equity "will act on the principle of protecting prop-

<sup>1</sup>Lindley, L. J., in *Slazenger v. Feltham*, 6 R. P. C. 538.

<sup>2</sup>*Allen B. Wrisley Co. v. Geo. E. Rouse Soap Co.*, 87 Fed. Rep. 589.

<sup>3</sup>*Sawyer v. Horn*, 1 Fed. Rep. 24-38.

<sup>4</sup>*Motley v. Downman*, 3 Mylne & Cr. 1-14.

<sup>5</sup>*Singleton v. Bolton*, 3 Doug. 293; *Morrison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4 Man. & G. 357; *Taylor v. Ashton*, 11 M. & W. 402; *Rodgers v. Nowill*, 5 C. B. 109; *Myers v. Baker*, 3 H. & N. 802; *Sykes v. Sykes*, 3 B. & C. 541; 5 D. & R. 292.

erty alone, and it is not necessary for the injunction to prove fraud in the defendant."<sup>1</sup> This rule is now universally recognized in technical trade-mark cases.<sup>2</sup> It is unnecessary to show that the defendant knew that his trade-mark resembled any other trade-mark,<sup>3</sup> and it follows that it need not be shown that he knew whose mark his resembled;<sup>4</sup> and, the intent of the defendant being immaterial, the fact that he intended to infringe plaintiff's rights will not entitle the plaintiff to relief if the defendants' acts do not amount to trade-mark infringement or unfair competition.<sup>5</sup>

There is a line of demarkation, to be noted in this regard, between the class of unfair trade cases which involves a technical trade-mark and that which does not. Where a plaintiff establishes by competent proof his title to the specific trade-mark, infringement is shown by comparison with the defendant's mark. The resemblance of the defendant's mark creates a presumption of fraud.<sup>6</sup>

<sup>1</sup>Millington v. Fox, 3 Mylne & Cr. 338.

<sup>2</sup>Glenny v. Smith, 2 Drew. & Sm. 476; 11 Jur. N. S. 964; 13 L. T. N. S. 11; 13 W. R. 1032; 6 N. R. 363; Seb. 247; Filley v. Fassett, 44 Mo. 173; Cox, 530; Seb. 313; Amoskeag Mfg. Co. v. Garner (1), 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541; Seb. 314; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; Singer Mfg. Co. v. Wilson, 3 App. Cas. 376-391; Colman v. Crump, 70 N. Y. 573; 16 Alb. L. J. 352; Seb. 579; Shaw v. Pilling, 175 Pa. St. 78-87; Wotherspoon v. Currie, L. R. 5 H. L. 508-517; McLean v. Fleming, 96 U. S. 245-253; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; C. F. Simmons Med. Co. v. Mansfield Drug Co., 93 Tenn. 84.

<sup>3</sup>Kinahan v. Kinahan, 15 Ir. Ch. 75; Orr-Ewing & Co. v. Grant, 2 Hyde, 185; Singer Mfg. Co. v. Loog, 18 Ch. D. 412; Harrison v. Taylor, 11 Jur. N. S. 408; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Burgess v. Hills, 26 Beavan, 244.

<sup>4</sup>Cartier v. Carlile, 31 Beavan, 292.

<sup>5</sup>Kann v. Diamond Steel Co., 89 Fed. Rep. 706-712.

<sup>6</sup>"A trade-mark, clearly such, is in itself evidence, when used by a third party, of an illegal act. It is of itself evidence that the party intended to defraud and to palm off his goods as another's." Mr. Justice Bradley in Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800. And to the same effect, Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; McLean v. Fleming, 96 U. S. 245; Menendez v. Holt, 128 U. S. 514; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537.

But where the plaintiff has no trade-mark there is no basis of comparison such as existed in the former case, because there is no technical property right in the plaintiff. Mere resemblance between the goods of the parties may or may not be sufficient to establish the right to injunction. It must be established that the defendant is unfairly competing with the plaintiff; his fraud must be proven directly or by inference. In a recent opinion Judge Baker says: "While the idea of fraud or imposition lies at the foundation of the law of technical trade-marks as well as the law of unfair competition, it must be borne in mind that fraud may rest in actual intent shown by the evidence, or may be inferred from the circumstances, or may be conclusively presumed from the act itself. In the case of unfair competition the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while in the case of the use by one trader of the trade-mark or trade-symbol of a rival trader, fraud will be presumed from its wrongful use."<sup>1</sup>

And the United States supreme court states the rule to be that "the deceitful representation must be made out or be clearly inferable from the circumstances."<sup>2</sup>

**§ 77. What persons liable.**—With the establishment of the rule that *mala mens* need not be shown,<sup>3</sup> it followed that liability for infringement was extended to many persons who, in the absence of that doctrine, could not be reached by the owner of the pirated mark. "All persons in any way connected with the infringement of a trade-mark are responsible to the owner for the injury done to his rights."<sup>4</sup>

**§ 78. The engraver or manufacturer of the label.**—The rule that equity will enjoin one who participates in the production of an infringing mark or label was first established in *Guinness v. Ullmer*, in 1847, in which case

<sup>1</sup>Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-279.

<sup>2</sup>Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-551.

<sup>3</sup>Wotherspoon v. Currie, L. R. 5 H. L. 508-517.

<sup>4</sup>Hawley, J., in *Hennessy v. Herrmann*, 89 Fed. Rep. 669-670.



the plaintiffs were brewers of porter, and the defendants, who were engravers, engraved plates to be used in printing labels in imitation of the plaintiff's label.<sup>1</sup> This decision was followed in 1855 by a case in which a printer printed and sold labels which were fac-similes of the plaintiff's labels, and the piracy was enjoined;<sup>2</sup> and the rule is now extended to include one who deals in counterfeit labels, though he does not manufacture them.<sup>3</sup>

In 1877 a label printer was enjoined by the superior court of New York from the manufacture of labels which were colorable imitations of plaintiff's. In affirming the decision of the lower court the New York court of appeals announced that it is not necessary in such a case "to establish a guilty knowledge or fraudulent intent on the part of the wrong-doer."<sup>4</sup> It is now the settled rule that "the mere act of printing and selling labels in imitation of the complainant's might be innocent, and,

<sup>1</sup>Guinness v. Ullmer, 10 L. T. 127; Seb. 89.

<sup>2</sup>Farina v. Silverlock, 1 K. & J. 509; 3 Eq. Rep. 883; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532; 6 DeG. M. & G. 214; 26 L. J. Ch. 11; 2 Jur. N. S. 1008; 27 L. T. 277; 4 W. R. 731; 52 Leg. Obs. 342; 30 L. T. 242; 31 L. T. 99; 4 K. & J. 650; Seb. 130. See also to the same effect, Colman v. Crump, 70 N. Y. 573; Cuervo v. Jacob Henkell Co., 60 Off. Gaz. 440; 50 Fed. Rep. 471; Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; De Kuyper v. Witteman, 23 Fed. Rep. 871; Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

<sup>3</sup>Hennessy v. Herrmann, 89 Fed. Rep. 669.

<sup>4</sup>Colman v. Crump, 70 N. Y. 573-578; affirming s. c., 40 N. Y. Super. Ct. (8 J. & S.) 548; Seb. 579. The court of appeals in this case further says (per Allen, J.): "It is an infraction of that right (i. e., the right to a trade-mark) to print or manufacture, or put on the market for sale and sell for use, upon articles of merchandise of the same class as those upon which it is used by the proprietor, any device or symbol which by its resemblance to the established trade-mark will be liable to deceive the public and lead to the purchase and use of that which is not the manufacture of the proprietor, believing it to be his." From which Mr. Cox makes this deduction: "The distinction would seem to be that where the facts of the case show that the printer of the labels contemplated their use upon goods not made by the owner of the mark, the court will interfere whatever the intent; but where the purpose was that they should be honestly used in such manner as to be tantamount to an application of the mark by its owner, the courts will decline to interfere." Note to Farina v. Silverlock, Cox, Manual, 130.

without evidence of an illicit purpose, would not be a violation of the complainant's rights."<sup>1</sup> Judge Thayer, however, held that the court would presume fraudulent intent where counterfeit labels were manufactured and sold and advertised for sale by the defendant.<sup>2</sup>

Where a person induces a manufacturer to make for him goods marked with the trade-mark of a third person, the manufacturer can hold him liable for all money paid and expense incurred by the manufacturer in compromising a suit brought against him by the owner of the trade-mark.<sup>3</sup>

Where both parties are in a similar business, one will be enjoined from buying up the empty bottles or other packages used by the other.<sup>4</sup>

**§ 79. Of counterfeiting trade-marks.**—A counterfeit mark is one which is a fac-simile (*e. g.*, an exact copy or reproduction) of a genuine trade-mark. Counterfeiting may be accomplished either by using forged fac-simile trade-marks, or by using genuine trade-marks upon goods substituted for those of the owners of the trade-marks; as by refilling bottles, boxes or other packages bearing trade-marks after their original contents have been consumed.

**§ 80. Of imitation of trade-marks.**—An imitation is a mark so contrived as to resemble an established trade-mark. The imitation is actionable only in cases where, upon comparison, the court determines that the difference is "merely colorable,"<sup>5</sup> or as stated by Vice-Chancellor Wood: "In every case the court must ascertain whether the differences are made *bona fide* in order to distinguish the one article from them, whether the re-

<sup>1</sup>Wallace, J., in *De Kuyper v. Witteman*, 28 Fed. Rep. 71; Cox, Manual, 694.

<sup>2</sup>*Carson v. Ury*, 39 Fed. Rep. 777; Cox, Manual, 709. See also *Von Mumm v. Wittemann*, 85 Fed. Rep. 966.

<sup>3</sup>*Dixon v. Fawcus*, 9 W. R. 414; 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; Seb. 194.

<sup>4</sup>*Evans v. Van Laer*, 30 Fed. Rep. 153; *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. Rep. 388.

<sup>5</sup>*Davis v. Kendall*, 2 R. I. 566; Cox, 112; Seb. 103.

semblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colorable.”<sup>1</sup>

§ 81. **Colorable imitation.**—As to what constitutes colorable imitation, some apparent diversity of opinion arises in the cases. In the opinion of Vice-Chancellor Wood from which we have quoted in the foregoing section, he says: “Resemblance is a circumstance which is of primary importance for the court to consider, because if the court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading.”<sup>2</sup> But this dictum is not convincing, because if the resemblance is not, in fact, calculated to mislead, the fact that it was adopted for the purpose of misleading is wholly immaterial.

Thus it has been held repeatedly that where there is no imitation of the essential part of a trade-mark, a resemblance in particulars common to the trade is not an infringement.<sup>3</sup>

§ 82. **The test of probability of deception.**—The variance of opinion as to what constitutes colorable imitation arises from the standard adopted by the different courts as to the tendency of the alleged infringement to deceive the cautious, ordinary or unwary customer. It is never necessary to establish actual deception. Lord Westbury said that it was not “necessary for relief in equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant’s mark under the belief that they were the manu-

<sup>1</sup>Taylor v. Taylor, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124.

<sup>2</sup>Taylor v. Taylor, *supra*.

<sup>3</sup>Portuondo v. Monne, 28 Fed. Rep. 16; Price & Steuart, 1115; Ball v. Siegel, 116 Ill. 137; 56 Am. Rep. 766; Re Horsburgh, 53 L. J. Ch. 237; Tucker Mfg. Co. v. Boyington, 9 Off. Gaz. 455; Thornton v. Crowley, 47 N. Y. Super. Ct. 527; Price & Steuart, 455; Coats v. Merrick, 45 Off. Gaz. 347; Marshall v. Hawkins, 4 N. Z. L. R. Sup. Ct. 59; Stachelberg v. Ponce (2), 128 U. S. 686.

facture of the plaintiffs, provided the court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other."<sup>1</sup> Accordingly it is no defense to show that all the persons purchasing goods bearing the simulated mark were aware that the goods were not of the plaintiff's manufacture,<sup>2</sup> or that the maker of the spurious goods, or the jobber who sells them to retailers, informs those who purchase that the article is spurious or an imitation;<sup>3</sup> the reason being that there is no assurance that the retailer will give the same cautionary information to his customers.<sup>4</sup> So where the defendant claimed that the goods bearing the false mark were for his own family's use, he was enjoined;<sup>5</sup> and where the defendants contended that they did not deal in the goods bearing the fraudulent mark, but only acted as forwarding agents, they were enjoined.<sup>6</sup>

It is always the presumption, however, that the consuming purchaser has no opportunity of comparing the conflicting marks; and this presumption is an important element in passing upon the probability of the defendant's mark effecting deception.<sup>7</sup>

<sup>1</sup>Edelsten v. Edelsten, 1 DeG. J. & S. 200; 9 Jur. N. S. 479; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300; *Monro v. Smith*, 13 N. Y. Sup. 708; *Cox, Manual*, 724; *Dixon v. Fawcus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; 9 W. R. 414; *Re Christiansen's Trade-mark*, 3 R. P. C. 54; *Cartmell*, 95; *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61; *Cartmell*, 103; *Orr-Ewing v. Johnston*, 7 A. C. 219; 51 L. J. Ch. 797; 46 L. T. 216; 30 W. R. 417; *Cartmell*, 249; *Seb.* 646; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, 9 R. P. C. 503; (1892) 2 Q. B. 639; 67 L. T. 301;

<sup>2</sup>Edelsten v. Edelsten, 9 Jur. N. S. 479; 1 DeG. J. & S. 185; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300.

<sup>3</sup>*Coats v. Holbrook*, 2 Sandf. Ch. 586; *Seb.* 79.

<sup>4</sup>*Chappell v. Davidson*, 2 K. & J. 123; 8 DeG. M. & G. 1; *Seb.* 136.

<sup>5</sup>*Upmann v. Forester*, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28; *Cartmell*, 331.

<sup>6</sup>*Upmann v. Elkan*, L. R. 12 Eq. 140; 40 L. J. Ch. 475; 24 L. T. N. S. 869; 19 W. R. 867; L. R. 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131; *Seb.* 369.

<sup>7</sup>*Pillsbury v. Pillsbury-Washburn Co.*, 64 Fed. Rep. 841; 12 C. C. A. 432; *Manufacturing Co. v. Trainer*, 101 U. S. 51-64; *Liggett & Myer Tobacco Co. v. Hynes*, 20 Fed. Rep. 883.

**§ 83. The degree of care expected of the purchaser.**

Mr. Justice Clifford expressed the rule in these words: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers buying with ordinary caution are likely to be misled."<sup>1</sup> But further, in the same opinion, he bases the decision explicitly upon the ground that the defendant's package "is well calculated to mislead and deceive the *unwary*."<sup>2</sup>

There are many instances of similar dicta. We have heretofore referred to the assertion of Vice-Chancellor Shadwell, who said that "If a thing contains twenty-five parts, and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud."<sup>3</sup> It is at this point that we can secure probably the most striking proof of the manner in which the law of trade-marks and the law of unfair competition overlap each other. True, the function of the trade-mark is to distinguish the goods to which it is applied, and whose origin or ownership it indicates. True that the purpose of an intentional infringement is to draw away the trade secured by the infringed mark for the benefit of the owner of the infringing mark. That infringement is to be determined, not by the question

Braham v. Bustard, 9 L. T. N. S. 199; 1 Hem. & M. 427; 11 W. R. 1061; 2 N. R. 572; Seb. 226; Filley v. Fassett, 44 Mo. 168; Seb. 313; Abbott v. Bakers & Confectioners Tea Ass'n, W. N. 1871, p. 207; W. N. 1872, p. 31; Seb. 379; Osgood v. Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410.

<sup>1</sup>McLean v. Fleming, 96 U. S. 245-251; following the language of Lord Cranworth in Seixo v. Provezende, L. R. 1 Ch. D. 192. See also Popham v. Wilcox, 14 Abb. Pr. N. S. 206; 38 N. Y. Super. Ct. 274; 66 N. Y. 69; 23 Amer. Rep. 22; Seb. 425; Dawes v. Davies, Seb. 426.

<sup>2</sup>McLean v. Fleming, 96 U. S. 245, at page 256.

<sup>3</sup>Guinness v. Ullmer, 10 L. T. 127. See also Leather Cloth Case, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873; Popham v. Wilcox, 66 N. Y. 69.

whether any substantial part of the trade-mark is copied or duplicated by the infringing mark, but by the tendency of the pirated mark to deceive (whether the careful, ordinary or unwary purchaser is immaterial), is an anomaly in our jurisprudence. But the courts have persisted in disregarding the technical composition and detail of trade-marks, and have invariably applied the test of tendency of the suspected mark to deceive. The test ignores the absolute right of property which exists in a lawful trade-mark, and gives the owner of such a mark no other or further rights than are given the plaintiff who uses only generic terms to designate his wares and perforce relies upon the doctrines of unfair competition.<sup>1</sup>

The broad rule as stated above by Mr. Justice Clifford has been elaborated by other courts. In some cases no reference is made to the care and caution expected to be exercised by the purchasing public,<sup>2</sup> while in others it is held that it must be shown that the mark employed bears such resemblance to the complainant's trade-mark "as to be calculated to mislead the public generally who are purchasers of the article;"<sup>3</sup> sometimes it has been expressed as the deception of "the ordinary mass of purchasers;"<sup>4</sup> or as by the Massachusetts court, that injunction will not lie "unless the form of the printed words, the words themselves, and the figures, lines and devices, are so similar that any person, with such reasonable care and

<sup>1</sup> Lord Westbury evidently was impressed with this thought when he said, "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is a test of the invasion by the defendant of the plaintiff's right of property; for there is no injury if the mark used by the defendant is not such as is mistaken, or is likely to be mistaken, by the public for the mark of the plaintiff; but the true ground of this court's jurisdiction is property." *Hall v. Barrows*, 4 DeG. J. & S. 150.

<sup>2</sup> *Ransome v. Bentall*, 3 L. J. Ch. N. S. 161; Seb. 53; *Taylor v. Carpenter* (3), 2 Sandf. 603; 11 Paige, 292; Cox, 45; Seb. 84; *Coffeen v. Brunton*, 5 McLean, 256; Cox, 132; Seb. 109; *Shrimpton v. Laight*, 18 Beav. 164; *Hardy v. Cutter*, 3 Off. Gaz. 468.

<sup>3</sup> *Walton v. Crowley*, 3 Blatchf. 440-447; *Compania de Tabacos v. Rehder*, 5 R. P. C. 61; *Cartmell*, 103.

<sup>4</sup> *Blackwell v. Wright*, 73 N. C. 310-313; *Crawshay v. Thompson*, 4 Man. & G. 357; 5 Scott N. R. 562; 11 L. J. C. P. 301; Seb. 72.

observation as the public generally are capable of using and may be expected to exercise, would mistake the one for the other.”<sup>1</sup> The irreverent layman could not fail to note the remarkable elasticity of the rule as thus laid down.<sup>2</sup> And we find a court of repute holding that “it is the unwary, and not the wary, who are to be protected, as most likely to be taken in by the counterfeit;”<sup>3</sup> and another saying that equity “should presume that the public makes use of the senses of sight and hearing, and that it is possessed of a sufficient amount of intelligence to note the difference these senses convey;”<sup>4</sup> and Sir George Jessel saying: “I am not, as I consider, to decide cases in favor of fools and idiots, but in favor of ordinary English people, who understand English when they see it.”<sup>5</sup>

The English courts have devoted much time to speculating whether “most Englishmen” would mistake the defendant’s mark for the plaintiff’s, or whether if the mark failed to deceive “most Englishmen” it still might mislead “the ordinary native purchaser in Bombay where the goods go,” as has actually been done in the opinion of one court.<sup>6</sup> Under the doctrine so stated, I will not be protected by injunction in a case where the defendant has not copied my trade-mark sufficiently in detail to

<sup>1</sup>*Gilman v. Hunnewell*, 122 Mass. 139-148. It is only fair to note that this case was improperly brought as a trade-mark case, and is treated as such by the court, whereas the facts show that injunctive relief could only have been granted, if at all, to restrain the unfair competition of the defendant. It has been held elsewhere, however, that the relief will not be granted where the defendants’ acts are such as could deceive only a careless purchaser. *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.*, 88 Fed. Rep. 694. But this decision was reversed on appeal: s. c., 102 Fed. Rep. 327-332.

<sup>2</sup>Substantially the same dictum is to be found in *Ball v. Siegel*, 116 Ill. 137-146; citing *Popham v. Cole*, 66 N. Y. 69.

<sup>3</sup>*Swift v. Day*, 4 Robertson, 611; Cox, 319; Seb. 245. And Judge Benedict has said: “It is no answer to say that the ultimate purchaser was ignorant or unwary.” *Von Mumm v. Frash*, 56 Fed. Rep. 830-839.

<sup>4</sup>*Munro v. Tousey*, 129 N. Y. 38.

<sup>5</sup>*Singer Mfg. Co. v. Wilson*, L. R. 2 Ch. D. 434; quoted with approval, *Munro v. Smith*, 13 N. Y. Sup. 708.

<sup>6</sup>*Wilkinson v. Griffith*, 8 R. P. C. 370-374.

deceive "most Englishmen," but if my goods are sold to natives of Africa I may have an injunction against him if he engages in that trade.

If we were to undertake to deduce a general rule from the cases it would be that the test is the likelihood of deception of the consuming purchaser;<sup>1</sup> and in applying this test all doubts are to be resolved in favor of the complainant.<sup>2</sup>

**§ 84. Infringement must be by use on same class of goods.**—The English Patents, Designs, and Trade-mark Acts, 1883 to 1888, provide that the application for registration must state the particular goods or classes of goods in connection with which the applicant desires the trade-mark to be registered.<sup>3</sup> A similar provision exists in the act of congress of 1881.<sup>4</sup> Aside from these provisions as to registration, it is self-evident that there can be no infringement unless the two marks are used on the same class of goods;<sup>5</sup> though in this country, owing to the absence of the exact classifications used in the English registration practice, it is probably more exact to say that the marks must be used upon goods of so similar description that goods bearing the defendant's mark may be taken for the manufacture of the plaintiff; as where the plaintiff adopted the words "Lone Jack" to designate smoking tobacco manufactured by him, and the defendant applied the same words to cigarettes. The

<sup>1</sup> *Allegretti Chocolate Cream Co. v. Keller*, 85 Fed. Rep. 643; *Colinsplatt v. Finlayson*, 88 Fed. Rep. 693; *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 Fed. Rep. 869-877.

<sup>2</sup> *Anheuser-Busch Brewing Ass'n v. Piza*, 24 Fed. Rep. 149-151.

<sup>3</sup> Patents, Designs, and Trade-marks Act, 1883, Part IV, sec. 62, subsec. 3.

<sup>4</sup> Act of 1881, sec. 3 (b).

<sup>5</sup> *Re Rabone*, Seb. 642; *Re Jelly, Son & Jones*, 51 L. J. Ch. 639; *Re Whiteley*, 43 L. T. N. S. 627; *Ainsworth v. Walmesley*, L. R. 1 Eq. 518; *Hall v. Barrows*, 4 DeG. J. & S. 150; *Hart v. Colley*, 7 R. P. C. 93; L. R. 44 Ch. D. 193; 59 L. J. Ch. 355; *Cartmell*, 154; *Jay v. Ladler*, 6 R. P. C. 136; L. R. 40 Ch. D. 649; 60 L. T. 27; 37 W. R. 505; *Cartmell*, 184; *Colman v. Crump*, 70 N. Y. 573; *Hecht v. Porter*, 9 Pac. C. L. J. 569; *Société Anonyme v. Baxter*, 14 Blatchf. 261; *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151; *George v. Smith*, 52 Fed. Rep. 830; *Air-Brush Mfg. Co. v. Thayer*, 84 Fed. Rep. 640.



court gave as its reason for enjoining the defendant that he was holding out his cigarettes as containing the plaintiff's tobacco.<sup>1</sup> And where the defendants were selling shirts under the name of "Wamyesta" and advertising them as made of "Wamyesta," they were enjoined from using that designation at the instance of the Wamsutta Mills, whose product was known as "Wamsutta" muslin, and was not used by defendants in the manufacture of their shirts.<sup>2</sup> Where the complainants used the words "Collins & Co." upon metal articles of their manufacture, but did not manufacture shovels, the defendants were enjoined from placing those words on shovels, they having exported shovels so marked to Australia, where the complainants marketed a portion of their output.<sup>3</sup> In a recent case Judge Bradford said: "Pale ale and half-and-half must, as against an infringer of a trade-mark for the former, be treated as malt liquors substantially similar to each other and belonging to the same class. Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrong-doer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."<sup>4</sup>

It is the necessary converse of the rule under consideration that it is no defense to an action for trade-mark infringement that the defendant used the mark in application to another class of merchandise before the plaintiff began his use of the mark. Thus where a defendant had applied the word "Epicure" to canned peaches and canned tomatoes, that fact did not avail as a defense, where the plaintiff was the first to apply the word to canned salmon, and the defendant afterwards began to apply it to canned salmon. In his opinion, Judge Coxe

<sup>1</sup>Carroll v. Ertheiler, Cox, Manual, 669.

<sup>2</sup>Wamsutta Mills v. Allen, 12 Phila. 535.

<sup>3</sup>Collins Co. v. Oliver Ames & Sons, 18 Fed. Rep. 561. See also Eno v. Dunn, L. R. 15 A. C. 252.

<sup>4</sup>Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206-211.

observes: "The reasoning of some of the authorities would indicate that the defendants had a right to use the brand in connection with other fruit and vegetables, analogous to tomatoes and peaches, but to assert that they have the right to use it on all canned goods is carrying the doctrine far beyond any reported case. Beer and nails do not belong to the same class of merchandise because both are sold in kegs."<sup>1</sup>

In a recent case in which the complainant's mark was applied to baking soda and saleratus, and the defendant's to baking powder, Judge Baker held the parties' goods to be in the same class because they were handled generally by the same class of dealers and purchased by the same class of customers; either is indifferently used to accomplish the same object; so that they come in direct competition with each other in sale and use. In that case the rule is announced that "goods are in the same class whenever the use of a given trade-mark or symbol on both would enable an unscrupulous dealer readily to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trade-mark, or with his authority and consent."<sup>2</sup>

**§ 85. The value of proof of fraudulent intent.**—So much is said of fraudulent intent in the decisions that it is proper to discuss it in this place, in its relation to infringement. As we have seen, equity will restrain the use of the infringing mark without regard to the intent of the defendant. It is, however, a matter of practical importance to establish the deliberate fraud of the defendant where it exists. It was distinctly held by Lord Westbury that an account would only be given with the injunction in respect of any user by a defendant after he had become aware of the prior ownership;<sup>3</sup> and in another case, where defendant claimed to have bought counterfeit champagne believing it to be genuine, an accounting was denied because of the absence of proof of guilty knowl-

<sup>1</sup>George v. Smith, 52 Fed. Rep. 830-832.

<sup>2</sup>Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-280.

<sup>3</sup>Edelsten v. Edelsten, 1 DeG. J. & S. 185.

edge.<sup>1</sup> And the fraudulent intention of the defendant must be shown in an action at law,<sup>2</sup> or at least to support the recovery of punitive damages.<sup>3</sup> But the rule is fixed both in England and the United States that proof of fraudulent intent, or actual deception of the public, are alike unnecessary in actions in equity, in technical trademark cases.

§ 86. **The manner of establishing fraudulent intent.**—The inspection of the two marks in controversy is the main test of the alleged resemblance,<sup>4</sup> although the testimony of expert witnesses familiar with the trade and the habits of customers is of weight.<sup>5</sup> So, for example, where the plaintiff's mark was a tin star, and the defendant's a tin buzz-saw, both affixed in use upon plug tobacco, the court could have small difficulty in inferring fraudulent intent.<sup>6</sup> Among other matters considered by the courts as probative of the defendant's intent are false representations of securing awards at an exhibition;<sup>7</sup> the fact that defendant, who adopted as a mark for his factory the words "Norfolk House," previously used by plaintiff, kept the publication of that name out of a city directory;<sup>8</sup> and the circumstance that defendant removed his place of business into the same locality as the plaintiff,<sup>9</sup> or is dealing in other fraudulent goods.<sup>10</sup>

A curious instance of facts regarded as indicia of fraud is to be found in a case where a plaintiff whose name,

<sup>1</sup>Moet v. Couston, 33 Beav. 578. See also Rose v. Loftus, 47 L. J. Ch. 576; Millington v. Fox, 3 Mylne & Cr. 338; Weed v. Peterson, 12 Abb. Pr. N. S. 178.

<sup>2</sup>Edelsten v. Edelsten, *supra*.

<sup>3</sup>Faber v. D'Utassey, 11 Abb. Pr. N. S. 399; Marsh v. Billings, 7 Cush. 322; Cox, 118.

<sup>4</sup>Drummond v. Tinsley, 52 Mo. App. 10.

<sup>5</sup>Drummond v. Tinsley, *supra*.

<sup>6</sup>Liggett & Myers Tob. Co. v. Sam Reid Tob. Co., 104 Mo. 53.

<sup>7</sup>Cave v. Myers, Seton (4th ed.), 238; Seb. 304.

<sup>8</sup>Rodgers v. Rodgers, 31 L. T. N. S. 285; Seb. 442.

<sup>9</sup>Elgin Nat. Watch Co. v. Illinois Watch Case Co., 88 Fed. Rep. 487, 488; reversed on other grounds, 94 Fed. Rep. 667; Fullwood v. Fullwood (1), W. N. 1873, p. 93; W. N. 1873, p. 185; Seb. 42. See also Lee v. Haley, 21 L. T. N. S. 546; 18 W. R. 181; L. R. 5 Ch. D. 155; 39 L. J. Ch. 284; 22 L. T. N. S. 251; 18 W. R. 242.

<sup>10</sup>Chas. E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-812.

originally "Dr. J. W. Trust," had been changed to "Dr. T. F. Gouraud," was the manufacturer of cosmetic styled "Gouraud's Oriental Cream," and the defendants, his sons, who had retained the name Trust, engaged in the sale of a cosmetic which they named "Creme Orientale, by Dr. T. F. Gouraud's Sons;" the court holding from these facts that the statement of the relationship, though truthful, was made with fraudulent intent.<sup>1</sup>

As most of these badges of fraud have been referred to by the courts because of their determining influence in cases of unfair competition, we will consider them at length in that connection. Those we have mentioned are illustrative, however, of the class of facts pertinent to be shown in cases of technical trade-mark infringement, and to prove which is important for the reasons and purposes above referred to.

**§ 87. Infringing by refilling trade-marked packages.**—There is no doubt that one who furnishes liquors (or any other class of goods) with the expressed purpose that the goods so sold are to be used in refilling genuine packages whose original contents have been removed will be dealt with as an infringer and enjoined in equity.<sup>2</sup> The refilling of genuine packages will be restrained,<sup>3</sup> even where the package, a bottle bearing a name blown in the glass, is used for a similar article, in connection with a label not resembling that borne by it originally.<sup>4</sup> Injunction will issue even where the refilling was done at the request of a customer.<sup>5</sup> Judge Thayer has enjoined

<sup>1</sup>Gouraud v. Trust, 3 Hun, 627; Seb. 460.

<sup>2</sup>Hostetter Co. v. Brueggeman-Reinart Distilling Co., 46 Fed. Rep. 188; Cox, Manual, 729. Compare Hostetter v. Fries, 17 Fed. Rep. 620, in which defendants compounded a substance to be used in making Hostetter's Bitters, and sold it with directions for so using it, but injunction was denied. This decision is entitled to no weight.

<sup>3</sup>Evans v. Von Laer, 32 Fed. Rep. 153; Sawyer Crystal Blue Co. v. Hubbard, 32 Fed. Rep. 388; Rose v. Henley, cited at 47 L. J. Ch. 577; 38 L. T. N. S. 410; Seb. 551.

<sup>4</sup>Evans v. Von Laer, 32 Fed. Rep. 153; Hostetter v. Anderson, 1 V. R. (W. A'B. & W.) Eq. 7; 1 Anst. Jour. 4; Seb. 652; Rose v. Loftus, 47 L. J. Ch. 576; 38 L. T. N. S. 409; Seb. 608. See *contra*, Welch v. Knott, 4 K. & J. 747; 4 Jur. N. S. 330; Seb. 157.

<sup>5</sup>Barnett v. Leuchars, 13 L. T. N. S. 495; 14 W. R. 166; Seb. 253.

a defendant from offering for sale an imitation of Hostetter's Bitters in bulk with advice to customers to refill bottles originally containing the genuine compound, with the spurious article.<sup>1</sup> In this class of cases "the burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."<sup>2</sup>

**§ 88. Infringement by applying a manufacturer's trade-mark to goods of his to which he does not intend its application.**—In *Hennessy v. White*, the defendants bottled brandy, purchased in casks from plaintiffs, and applied to such bottling a label which was a colorable imitation of that used by plaintiffs to designate a higher grade of brandy sold by them in bottles only. The court, by Molesworth, J., said: "I think a new feature which has not been present in any other case, and is, therefore, not touched by the language of the other cases, is one which I ought to act upon here; that is, that the makers of articles of different qualities are entitled to brand their best article in a particular way to show the superior value they put upon it." Stowell, C. J., in the same case, in the Victoria supreme court, states the rule more broadly: "If a brandy different from that which the manufacturer bottled is put into bottles and sold as the manufacturer's bottled brandy, the fact that it is the manufacturer's bulk brandy does not make the sale less an imposition."<sup>3</sup> There can be no doubt of the right of the manufacturer or selector to designate goods of a certain grade bottled or packed by him by a distinctive trade-mark, and that no one purchasing goods in bulk from

<sup>1</sup>*Hostetter v. Brueggeman-Reinart Co.*, 46 Fed. Rep. 188; *Cox, Manual*, 729; cited and followed in *Hostetter v. Sommers*, 84 Fed. Rep. 333. These cases overrule *Hostetter v. Fries*, 17 Fed. Rep. 620, where Judge Wallace refused to enjoin defendants who prepared and sold an extract, giving instructions to their customers for making "Hostetter's Bitters" from the extract. The rule stated in the text is followed in *Myers v. Theller*, 38 Fed. Rep. 607-609.

<sup>2</sup>*Coxe, J.*, in *Hostetter Co. v. Comerford*, 97 Fed. Rep. 585; and to the same effect see *Hostetter Co. v. Bower*, 74 Fed. Rep. 235.

<sup>3</sup>*Hennessy v. White*, 6 W. W. & A'B. Eq. 216-221; *Seb.* 650. See also to same effect *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225; *Seb.* 651; *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585.

him can thereby acquire the right to pack or bottle such goods under the trade-mark of the vendor used only upon his packing or bottling. Whether the bulk goods are better than or inferior to the trade-marked goods is utterly immaterial except as bearing upon the question of damages.<sup>1</sup>

"It is manifest that the sale of merchandise in bulk by a manufacturer does not justify the vendee in using on his retail packages the label which the manufacturer uses upon the same merchandise only when prepared by himself on smaller packages for the retail trade."<sup>2</sup>

§ 89. **Substitution.**—By "substitution," as used here, is meant the substitution by a retail merchant of goods other than those called for by a purchaser. In its narrower sense it is confined to the retail merchant who commits the offense. In its broader sense it includes the manufacturer of the substituted goods in cases where he has so prepared the goods as to make the substitution possible, and for the purpose and with the intent that they may be substituted.<sup>3</sup> Of such manufacturers the superior court of New York, by Barrett, J., has said: "The law of trade-marks has been gradually expanding so as to meet just such cases. The courts, in a long and unbroken line of decisions, have endeavored to uphold and enforce commercial morality, and have afforded their protection to honest enterprise and skill."<sup>4</sup> As to the re-

<sup>1</sup> See the case in which a person purchasing pens from a manufacturer removed the labels and substituted others marked with a numeral indicating another grade of pen made by the same manufacturer. *Gillott v. Kettle*, 3 Duer, 624; Cox, 148.

<sup>2</sup> Taft, J., in *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585-592.

<sup>3</sup> *Enoch Morgan's Sons Co. v. Wendover*, 43 Fed. Rep. 420.

<sup>4</sup> *Morgan Sons Co. v. Troxell*, Cox, Manual, 674. The New York court of appeals, treating this case as purely a technical trade-mark case, reversed it in 89 N. Y. 292. If there had been considered by the appellate court the doctrines we have now under discussion, the decision of the lower court would have been affirmed. *Taendsticks-fabriks Aktiebolaget Vulcan v. Myers*, 11 N. Y. Sup. 663; *Avery v. Meikle*, 81 Ky. 75; Cox, Manual, 686, and cases cited elsewhere in this chapter.

tailer who performs the actual substitution, there is no question that he will invariably be enjoined from repetitions of his offense.<sup>1</sup>

**§ 90. Infringement by a dissimilar word or mark.**

The general rule is that there may be infringement even in the absence of exact similarity between the marks.<sup>2</sup>

In 1866 Lord Cranworth said in a leading case: "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device."<sup>3</sup> This dictum was elicited in a case where the plaintiff sold wine in casks stamped with the device of a crown and an eagle, and the initials "B. S." on the head of the cask, and a crown, the word "Seixo" and a date at the bung hole, from which the wine had acquired the name "Crown Seixo;" while the defendants sold wine in casks stamped on the head and at the bung hole with the device of a

<sup>1</sup>Saxlehner v. Eisner & Mendelson Co., 88 Fed. Rep. 61-70; Munro v. Smith, 13 N.Y. Sup. 708.

<sup>2</sup>Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883. "What degree of resemblance is necessary is, from the nature of things, a matter incapable of definition *a priori*. All that courts of justice can do is to say that no trader can adopt a trade-mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled." Lord Cranworth in *Seixo v. Provezende*, L. R. 1 Ch. D. 192.

<sup>3</sup>*Seixo v. Provezende*, *supra*; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

The doctrine of the leading case applies to all cases where the goods of a particular dealer or manufacturer have become known by a name derived from his trade-mark. *Anglo-Swiss Condensed Milk Co. v. Metcalf*, L. R. 31 Ch. D. 454; 55 L. J. Ch. 463; 34 W. R. 345; 3 R. P. C. 28; *Cartmell*, 48; *Re Speer's Trade-mark*, 4 R. P. C. 521; 55 L. T. N. S. 880; *Cartmell*, 317; *Re Baschiera's Trade-mark*, 33 S. J. 469; *Re La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 436; L. R. (1894) 1 Ch. D. 61; 11 R. P. C. 142; *Wilkinson v. Griffith*, 8 R. P. C. 370; *Cartmell*, 344; *Morgan Envelope Co. v. Walton*, 82 Fed. Rep. 469; 81 Off. Gaz. 1615; *Johnson & Johnson v. Bauer & Black*, 82 Fed. Rep. 662; *Kann v. Diamond Steel Co.*, 89 Fed. Rep. 706.

crown, the initials "C. B.," the words "Seixo de Cima," and figures "1861." The defendants were enjoined notwithstanding the fact that the marks were not similar.

Under this rule, plaintiffs who made a certain beer to which they applied the device of a bull-dog's head were granted an injunction against the use by competing dealers of a label similar in shape to the plaintiffs' and bearing a terrier's head. There was no resemblance between the labels beyond the similarity in shape, but the plaintiffs' beer had come to be known as "Dog's Head Beer," and the use of a dog's head upon similar merchandise by the defendants was manifestly for the purpose of passing off their beer as being the plaintiffs'.<sup>1</sup> It is self-evident that a trade-mark may be infringed by a mark entirely different, but suggesting to customers and the public the same word or idea. Thus when an English house had used in India a trade-mark for yarn which had led the natives to call for it as "Bhe Hathi" (meaning "Two Elephant") yarn, a competing firm was enjoined from exporting yarn to India under a trade-mark of which the principal feature was the representation of two elephants.<sup>2</sup> On the same reasoning the word "Sportsman's" accompanied by a picture of two mounted huntsmen, used as a trade-mark for cherry brandy, was held to be infringed by the picture of a huntsman standing beside his horse, and the words "Huntsman's Cherry Brandy," where the proof *aliunde* showed that the plaintiffs' liquor had become known to the public as "The Hunter's Cherry Brandy."<sup>3</sup>

Judge Sanborn has well said that "every suit of this character is founded on the fact that the action, or the proposed action, of the defendant has deceived, or is calculated to deceive, ordinary purchasers buying with usual

<sup>1</sup> Read v. Richardson, 45 L. T. N. S. 54; Cox, Manual, No. 698.

<sup>2</sup> Orr-Ewing & Co. v. Johnston & Co., 40 L. T. N. S. 307; Seb. 646.

<sup>3</sup> Re Barker's Trade-mark, 53 L. T. N. S. 23; Cartmell, 72. Similar cases are Barlow v. Johnson, 7 R. P. C. 395; Cartmell, 73; Upper Assam Tea Co. v. Herbert, 7 R. P. C. 183; Cartmell, 333; Re Worthington's Trade-mark, L. R. 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747; Cartmell, 351; Jerome v. Johnson, 59 N. Y. Supp. 859.



care, so that they have purchased, or will probably purchase, the goods of the defendant under the mistaken belief that they are those of the complainant."<sup>1</sup> So that each case must turn upon the peculiar facts involved. Thus where a plaintiff had for some time manufactured tennis racquets uniformly stamped at a particular place upon the handle with the words "The Demon," and the defendant began to manufacture and sell racquets of a similar design, stamped, in the corresponding place upon the handle, with the word "Demotic," the use of the word "Demotic" was restrained.<sup>2</sup> So the word "Curative," applied to soap, has been held to infringe the word "Cuticura," similarly applied;<sup>3</sup> and a red Greek cross has been held to be infringed by a maltese cross with a red center, each being used as a mark upon medicinal plasters.<sup>4</sup>

Other instances in which the courts have declared a word or words used as a trade-mark to be infringed by a different word or words will be found instructive. For the convenience of the reader they are tabulated in alphabetical order.

<i>The Trade-mark.</i>	<i>Held to be infringed by</i>
"Apollinaris."	"Apollinis." <sup>5</sup>
"Black Diamond."	"Diamond Gem." <sup>6</sup>
"Bovilene."	"Bovina." <sup>7</sup>

<sup>1</sup>Kann v. Diamond Steel Co., 89 Fed. Rep. 706.

<sup>2</sup>Slazenger v. Feltham, 6 R. P. C. 531; Cartmell, 310. Thus where an anchor had been registered in England as an umbrella trade-mark, the word "Ancross" for umbrellas was refused registration. *Re Thewlis & Blakey's Trade-mark*, 10 R. P. C. 369.

<sup>3</sup>Potter Drug & Chemical Corp. v. Miller, 75 Fed. Rep. 657.

<sup>4</sup>Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662; reversing same case, 79 Fed. Rep. 954. In his opinion Judge Jenkins said: "It sufficiently appeared by the testimony that the goods of the appellant have come to be known, and are offered, ordered and sold, as 'Red Cross Plasters;' and we cannot but think that the maltese cross adopted by the appellee, in so far as it contains a red circle, has a tendency to promote confusion, and will interfere with the legitimate trade of the appellant. . . . The red cross speaks to the eye, and the article being known by that designation speaks also to the ear by that name."

<sup>5</sup>Apollinaris Co. v. Herrfeldt, 4 P. R. 478; Apollinaris Brunnen v. Somborn, 14 Blatchf. 380; Fed. Case No. 496.

<sup>6</sup>Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

<sup>7</sup>Lockwood v. Bostwick, 2 Daly, 521.

<i>The Trade-mark.</i>	<i>Held to be infringed by</i>
"Burgess."	"Burgiss." <sup>1</sup>
"Canadian Club Whisky."	"Canadian Rye Whisky." <sup>2</sup>
"Celluloid."	"Cellonite." <sup>3</sup>
"Chatterbox."	"Chatterbook." <sup>4</sup>
"Cocoaine."	"Cocaine." <sup>5</sup>
"Cocoatina."	"Cacaotine." <sup>6</sup>
"Coe's Superphosphate of Lime."	"Andrew Coe's Superphosphate of Lime." <sup>7</sup>
"Cottolene."	"Cottoleo." <sup>8</sup>
"Derby."	"Derwent." <sup>9</sup>
"Dyspepticure."	"Dyspepticide." <sup>10</sup>
"El Destino."	"El Divino" and "El Destinacion." <sup>11</sup>
"Electro-Silicon."	"Electric-Silicon." <sup>12</sup>
"Flor de Margaretta."	"Margarita." <sup>13</sup>
"Genuine Durham Smoking Tobacco," with the picture of a bull.	"The Durham Smoking Tobacco," with the picture of a bull's head. <sup>14</sup>
"German."	"Germania." <sup>15</sup>
"German Household Dyes."	"Excellent German Household Dyes." <sup>16</sup>
"Germea."	"Germ." <sup>17</sup>
"Gold Dust."	"Gold Drop." <sup>18</sup>

<sup>1</sup>Burgess v. Hills, 26 Beavan, 244.

<sup>2</sup>Walker v. Mikolas, 79 Fed. Rep. 955.

<sup>3</sup>Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

<sup>4</sup>Estes v. Leslie, 29 Fed. Rep. 91.

<sup>5</sup>Burnett v. Phalon, 9 Bos. 192.

<sup>6</sup>Schweitzer v. Atkins, 37 L. J. Ch. 847.

<sup>7</sup>Coe v. Bradley, 9 Off. Gaz. 541.

<sup>8</sup>N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

<sup>9</sup>Derby Dry Plate Co. v. Pollard, 2 Times L. R. 276.

<sup>10</sup>Ex parte Foley & Co., 87 Off. Gaz. 1957.

<sup>11</sup>Pinto v. Trott, 8 P. R. 173.

<sup>12</sup>Electro-Silicon Co. v. Trask, 59 How. Pr. 189.

<sup>13</sup>Benedictus v. Sullivan, 12 P. R. 25.

<sup>14</sup>Blackwell v. Armistead, 3 Hughes, 163; Fed. Case No. 1474.

<sup>15</sup>Walter Baker & Co. v. Baker, 77 Fed. Rep. 181.

<sup>16</sup>Oppermann v. Waterman, 94 Wis. 583; 69 N. W. Rep. 569.

<sup>17</sup>Sperry v. Percival Milling Co., 81 Cal. 252.

<sup>18</sup>N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 102 Fed. Rep. 327; reversing s. c., 88 Fed. Rep. 694.

*The Trade-mark.**Held to be infringed by*

"Golden Crown."	"Golden Chain." <sup>1</sup>
"Guinness."	"Genuine." <sup>2</sup>
"Home."	"Home Delight." <sup>3</sup>
"Hostetter Bitters."	"Host-Style Bitters." <sup>4</sup>
"Hostetter & Smith."	"Holsteter & Smyte." <sup>5</sup>
"Humphreys' Homœo- pathic Specifics."	"Reeves' Improved Homœo- opathic Specifics." <sup>6</sup>
"Lacto-Peptide."	"Lactopepsine." <sup>7</sup>
"Leopoldshall."	"Leopoldsalt." <sup>8</sup>
"Lightning Hay Knives."	"Lightning Pattern Hay Knives." <sup>9</sup>
"Maizena."	"Maizharina." <sup>10</sup>
"Maryland Club Rye."	"Maryland Jockey Club Rye." <sup>11</sup>
"Mechanics' Store."	"Mechanical Store." <sup>12</sup>
"Miller's Chicken Cock Whiskey."	"Miller's Game Cock Rye." <sup>13</sup>
"Momaja."	"Mojava." <sup>14</sup>
"Morse's Compound Syrup of Yellow Dock Root."	"Dr. Morse's Improved Yellow Dock and Sar- saparilla Compound." <sup>15</sup>
"Mottled German Soap," with a circle, moon and stars.	"S. W. McBride's German Mottled Soap," with a crescent and star. <sup>16</sup>

<sup>1</sup> Parlett v. Guggenheimer, 67 Md. 542; 10 Atl. Rep. 81.<sup>2</sup> Guinness v. Heap, Seb. 617.<sup>3</sup> New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.<sup>4</sup> Hostetter v. Becker, 73 Fed. Rep. 297.<sup>5</sup> Hostetter v. Vowinkle, 1 Dill. 329.<sup>6</sup> Humphreys' Specific Med. Co. v. Wenz. 14 Fed. Rep. 250-253.<sup>7</sup> Carnrick v. Morson, L. J. N. of C. (1877), p. 71.<sup>8</sup> Radde v. Norman, L. R. 14 Eq. 348.<sup>9</sup> Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.<sup>10</sup> Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; 23 Blatchf. 46.<sup>11</sup> Cahn v. Gottschalk, 2 N. Y. Supp. 13.<sup>12</sup> Weinstock, Lubin & Co. v. Marks, 109 Cal. 529.<sup>13</sup> G. G. White Co. v. Miller, 50 Fed. Rep. 277.<sup>14</sup> American Grocery Co. v. Sloan, 68 Fed. Rep. 539.<sup>15</sup> Alexander v. Morse, 14 R. I. 153.<sup>16</sup> Proctor v. McBride, Fed. Case No. 11441.

*The Trade-mark.**Held to be infringed by*

"Moxie Nerve Food."	"Standard Nerve Food." <sup>1</sup>
"Nickel-In."	"Nickel Saved." <sup>2</sup>
"Old Crow."	"White Crow." <sup>3</sup>
"Portland."	"Famous Portland." <sup>4</sup>
"Pride."	"Pride of Syracuse." <sup>5</sup>
"Pride of Rome."	"Pride of the Home." <sup>6</sup>
"Roberts' Parabola Gold-Burnished Sharps."	"William Clark & Sons' Parabola Gold-Burnished Sharps." <sup>7</sup>
"Roy Watch-Case Co."	"Camm-Roy Watch-Case Co." <sup>8</sup>
"Sanitas."	"Condisanitas." <sup>9</sup>
"Sawyer's Crystal Blue and Safety Box."	"Sawin's Soluble Blue and Pepper Box." <sup>10</sup>
"Shawknit."	"Seamless." <sup>11</sup>
"Shrewsbury, Marshall & Co. Patent Thread."	"Schrewsbury-Marchal Patent Thread." <sup>12</sup>
"Six Little Tailors."	"Six Big Tailors." <sup>13</sup>
"Sorosis."	"Sartoris." <sup>14</sup>
"Southern Company, St. Louis."	"Southwestern, St. Louis." <sup>15</sup>
"Star."	"Lone Star." <sup>16</sup>
"Stark."	"Star." <sup>17</sup>

<sup>1</sup>Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205.<sup>2</sup>Schendle v. Silver, 70 N. Y. Sup. Ct. 330.<sup>3</sup>W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421; 25 Misc. Rep. 20.<sup>4</sup>Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788.<sup>5</sup>Hier v. Abrahams, 82 N. Y. 519.<sup>6</sup>Ft. Stanwix Canning Co. v. Wm. McKinley Canning Co., 63 N. Y. S. 704.<sup>7</sup>Roberts v. Sheldon, 8 Biss. 398; Fed. Case No. 11916.<sup>8</sup>Roy Watch-Case Co. v. Camm-Roy Watch-Case Co., 59 N. Y. Supp. 979.<sup>9</sup>Sanitas Co. v. Condry, 4 P. R. 195.<sup>10</sup>Sawyer v. Kellogg, 7 Fed. Rep. 721; 9 Fed. Rep. 601.<sup>11</sup>Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707; 21 Blatchf. 1.<sup>12</sup>Marshall v. Ross, L. R. 8 Eq. 651.<sup>13</sup>Mossler v. Jacobs, 65 Ill. App. 571.<sup>14</sup>Little v. Kellam, 100 Fed. Rep. 353.<sup>15</sup>Southern White Lead Co. v. Cary, 25 Fed. Rep. 125.<sup>16</sup>Hutchinson v. Covert, 51 Fed. Rep. 829; 61 Off. Gaz. 1017.<sup>17</sup>Gardner v. Bailey, Seb. 365; Fed. Case No. 5221.

*The Trade-mark.**Held to be infringed by*

"Steinway."

"Steinberg."<sup>1</sup>

"Stephens."

"Steel Pens."<sup>2</sup>

"Stuart's Dyspepsia Tablets."

"Dr. Stewart's Dyspepsia Tablets."<sup>3</sup>

"Sunlight."

"American Sunlight."<sup>4</sup>

"Swan."

"Black Swan."<sup>5</sup>

"Tonge's."

"Tung's."<sup>6</sup>

"Trafford."

"Stafford."<sup>7</sup>

"Uneda."

"Iwanta."<sup>8</sup>

"Vitae-Ore."

"Vitalizing Ore."<sup>9</sup>

"Wamsutta."

"Wamyesta."<sup>10</sup>

"Warren."

"Warranted."<sup>11</sup>

"Willoughby Lake."

"Willoughby Ridge."<sup>12</sup>

It follows that a word may infringe a symbol, or *vice versa*. Thus the figure of Columbia is an infringement of the word "Columbia," previously applied to the same class of merchandise.<sup>13</sup> But the use by a plaintiff of a conventional diamond-shaped design has been held not to confer a trade-mark right in the word "diamond," Judge Adams remarking: "If the complainant's goods had ever been known in the trade as 'diamond steel,' or generally as 'diamond' goods, it would undoubtedly be protected in the use of the word 'diamond' as a trade-name, even though such word nowhere appeared in connection with the symbol of a conventional diamond forming its trade-mark. Its use by a competitor, either as its cor-

<sup>1</sup>Steinway v. Henshaw, 5 P. R. 77.

<sup>2</sup>Stephens v. Peel, 16 L. T. N. S. 145.

<sup>3</sup>Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243.

<sup>4</sup>Lever Bros. v. Pasfield, 88 Fed. Rep. 484.

<sup>5</sup>Ex parte Caire, 15 Off. Gaz. 248.

<sup>6</sup>Tonge v. Ward, 21 L. T. N. S. 480.

<sup>7</sup>Smith v. Carron Co., 13 P. R. 108.

<sup>8</sup>National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

<sup>9</sup>Noel v. Ellis, 89 Fed. Rep. 978.

<sup>10</sup>Wamsutta Mills v. Allen, 12 Phila. 535.

<sup>11</sup>Frost v. Rindskopf, 42 Fed. Rep. 408.

<sup>12</sup>Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

<sup>13</sup>Morgan Envelope Co. v. Walton, 82 Fed. Rep. 469; 81 Off. Gaz. 1615. In this connection see Kann v. Diamond Steel Co., *supra*, and Re Thewlis & Blakey's Trade-mark, *supra*.

porate name or trade-name for its product, under such circumstances would undoubtedly tend to deceive, and fall within the condemnation of the cases of complainant's counsel. See, especially, *Johnson v. Bauer*, 82 Fed. Rep. 662."<sup>1</sup>

The addition of other symbols, words or initials to the trade-mark of another will not operate to avoid a charge of infringement. "No one who has counterfeited a legitimate trade-mark and applied the spurious symbol in competition with the genuine can avoid the charge of infringement by showing that the false mark has in practice been so accompanied, on labels, capsules or otherwise, by trade-names, designations, descriptions or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may affect the nature or measure of the relief to be granted, cannot defeat a suit for infringement."<sup>2</sup>

In the absence of proof of any deception of the public, the courts have not been inclined to declare a dissimilar mark an infringement unless the similarity was close. Thus it has been held that the word "Pudding" does not infringe the word "Puddine;"<sup>3</sup> that the word "Bacocuro" does not infringe the word "No-to-bac;"<sup>4</sup> that the mark "B. & S." does not infringe the mark "S. B.;"<sup>5</sup> that the mark "Filofloss," applied to silk, is a valid trade-mark notwithstanding the prior use of the mark "Filoselle" applied to silk of a different character;<sup>6</sup> that the mark "Beeshore One-Night Cough Cure" does not infringe the mark "One Night Cure;"<sup>7</sup> that the mark "Elastic Tolu" does not infringe the mark "Sappota

<sup>1</sup>*Pittsburg Crushed Steel Co. v. Diamond Steel Co.*, 85 Fed. Rep. 637-642.

<sup>2</sup>*Bradford, J., in Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206-212.

<sup>3</sup>*Clotworthy v. Schepp*, 42 Fed. Rep. 62.

<sup>4</sup>*Sterling Remedy Co. v. Eureka Chem. & Mfg. Co.*, 80 Fed. Rep. 105.

<sup>5</sup>*Burt v. Smith*, 71 Fed. Rep. 161-163.

<sup>6</sup>*Rawlinson v. Brainard & Armstrong Co.*, 59 N. Y. Supp. 880; 28 Misc. Rep. 287.

<sup>7</sup>*Kohler Mfg. Co. v. Beeshore*, 59 Fed. Rep. 572-576.

Tolu;"<sup>1</sup> that the mark "Star" and an uncolored tin star is not infringed by "Starlight" and a red paper star;<sup>2</sup> that "Everyday Soap" was not so clearly infringed by "Everybody's Soap" as to warrant a preliminary injunction.<sup>3</sup>

It is important to note in this connection the expression of Lord Cranworth, that "It would be a mistake to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rules so restricted would be of no practical use."<sup>4</sup>

And another rule is that a defendant cannot evade the charge of infringement by "showing that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways."<sup>5</sup>

**§ 91. Miscellaneous matters relating to infringement.**—In the cases of infringement it is manifest that the policy of the law is clear, and that difficulty in determining questions of infringement arises only out of the facts.

It was asked in the English House of Lords, "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?"<sup>6</sup> Analogies will, however, frequently be found in the adjudicated cases which may assist in classifying the character of infringement under consideration.

Infringements which display the name or initials of the defendant are none the less infringements if any substantial portion of the mark is taken from the plaintiff's mark.<sup>7</sup> This principle has been applied to a case where the defendant had washed plaintiff's labels off his bottles, leaving only the marks blown or moulded in the

<sup>1</sup> *Adams v. Heisel*, 31 Fed. Rep. 279.

<sup>2</sup> *Liggett & Myers Tobacco Co. v. Finzer*, 128 U. S. 182.

<sup>3</sup> *Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. Rep. 357; 34 C. C. A. 405.

<sup>4</sup> *Seixo v. Provezende*, L. R. 1 Ch. D. 192.

<sup>5</sup> *Lord Watson in Singer Mfg. Co. v. Loog* (3), 8 App. Cas. 39.

<sup>6</sup> *Lord Watson in Johnson v. Orr-Ewing*, H. L. 7 App. Cas. 219.

<sup>7</sup> *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. Rep. 388; *Anheuser-Busch Brewing Association v. Clarke*, 26 Fed. Rep. 410; *Garrett v. T. H. Garrett & Co.*, 78 Fed. Rep. 472; *Anheuser-Busch Brewing Association v. Piza*, 24 Fed. Rep. 149; *Hostetter v. Adams*, 10 Fed.

glass, and had pasted his own labels upon the bottles,<sup>1</sup> although in similar cases, where the name of the defendant was conspicuously displayed on the new label, injunction was refused.<sup>2</sup> But the fact that the defendant does display his name upon his goods is always to be considered as a circumstance in his favor.<sup>3</sup>

*Infringement applied to goods of equal quality.*—It is settled that the fact that the defendant's goods are equal in quality to the plaintiff's is no defense to the action of infringement. As said by Judge McLean: "To entitle a complainant to protection against a false representation it is not essential that the article should be inferior in quality."<sup>4</sup> And in a English case involving the manufacture of metallic hones, Lord Denman instructed the jury that "even if the defendant's hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendant."<sup>5</sup> It may be regarded as settled that it is immaterial, in the language of Judge Morris, whether the defendant's goods "be better or worse in quality."<sup>6</sup>

**§ 92. The use of letters and numerals.**—The principle that there can be trade-mark in letters or numerals cannot be considered as finally settled. *Gillott v. Ester-*

Rep. 838; *Pepper v. Labrot*, 8 Fed. Rep. 29; *Shaw Stocking Co. v. Mack*, 12 Fed. Rep. 707; *McCann v. Anthony*, 21 Mo. App. 83; *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206.

<sup>1</sup>*Hostetter v. Anderson*, 1 W. W. & A'B. Eq. 7; Seb. 652; *Rose v. Loftus*, 47 L. J. Ch. 576; 38 L. T. N. S. 409; Seb. 608; *Rose v. Henly*, Seb. 551.

<sup>2</sup>*Welch v. Knott*, 4 K. & J. 747; *Barret v. Gomm*, 74 L. T. (Journal) 388.

<sup>3</sup>"This is one of the important means of identification." *Severens, J.*, in *Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. Rep. 357-362. And see *Kann v. Diamond Steel Co.*, 89 Fed. Rep. 706; *P Lorillard Co. v. Peper*, 86 Fed. Rep. 956-959; *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Beard v. Turner*, 13 L. T. N. S. 746.

<sup>4</sup>*Coffeen v. Brunton* (2), 5 McLean, 256.

<sup>5</sup>*Blofield v. Payne*, 4 B. & Ad. 410; Seb. 50. See also *Taylor v. Carpenter* (2), 2 W. & M. 1; *Cox*, 32; *Taylor v. Carpenter* (3), 2 Sandf. Ch. 603; *Edelsten v. Edelsten*, 1 DeG. J. & S. 185; Seb. 213.

<sup>6</sup>*Sawyer v. Horn*, 1 Fed. Rep. 24-38. To the same effect see *Cutter v. Gudebrod Bros. Co.*, 55 N. Y. Supp. 298.



*brook*,<sup>1</sup> in which the defendant was enjoined from using the numerals "303," was for a time regarded as upholding their use as a trade-mark, but the case is known and recognized as a case of unfair competition.<sup>2</sup> The leading English case, *Ainsworth v. Walmsley*, is very similar to *Gillott v. Esterbrook*, *supra*, in that while the imitation of a series of numbers was considered as one of the elements justifying injunction, Vice-Chancellor Wood carefully distinguished them as not being a technical trade-mark.<sup>3</sup> There is no case, however, in England in which the courts have recognized "a mere numeral or combination of numerals, standing alone, as sufficiently arbitrary and distinctive to constitute a trade-mark."<sup>4</sup>

Of course numerals may form a part of a trade-mark, in combination or collocation with words, figures or designs, and many cases in which their imitation has been restrained turned upon this point;<sup>5</sup> they will also be protected when used in an arbitrary and distinctive manner which conveys no idea of number, although they would probably not be so used except in collocation with designs or words.<sup>6</sup> In one case it was held that a complainant was entitled to the exclusive use of a trade-mark consisting of the figures  $\frac{1}{2}$ , only in the form, size, color and style in which it had been registered and used.<sup>7</sup>

The strongest case holding that numerals alone may form a valid technical trade-mark is *Shaw Stocking Co. v. Mack*,<sup>8</sup> in which Judge Coxe ably reviews the decisions

<sup>1</sup>47 Barb. 455; Cox, 340.

<sup>2</sup>Browne on Trade-marks (2d ed.), sec. 228.

<sup>3</sup>*Ainsworth v. Walmsley*, L. R. 1 Eq. 518-527.

<sup>4</sup>Sebastian on Trade-marks (4th ed.), p. 79.

<sup>5</sup>*Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Lawrence Mfg. Co. v. Lowell*, 129 Mass. 325; *Humphreys' Specific Med. Co. v. Wenz*, 14 Fed. Rep. 250; *Carver v. Pinto Leite*, L. R. 7 Ch. App. 90; *Robinson v. Finlay*, L. R. 9 Ch. D. 487; *Broadhurst v. Barlow*, W. N. 1872, p. 212; *Carver v. Bowker*, Seb. 581; *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417.

<sup>6</sup>*Kinney v. Basch*, 16 Am. Law Reg. N. S. 596; Seb. 542—properly a case of unfair competition.

<sup>7</sup>*Kenney v. Allen*, 1 Hughes, 106; Seb. 557; Fed. Case No. 7826.

<sup>8</sup>12 Fed. Rep. 707. See also *Smith & Davis Mfg. Co. v. Smith*, 89 Fed. Rep. 486.

and argues that the rejection of numerals as trade-mark was invariably because of their use indicating quality rather than origin or ownership; but he finally bases the reason of his decree of injunction flatly upon the defendant's fraudulent competition.

The practical difficulty in the way of constructing a trade-mark from numerals alone is that the defendant could always find a multiplicity of excuses for selecting the same numerals, and the cases indicate that the courts grant ample protection to their use as against their fraudulent imitation.<sup>1</sup>

Even where numerals were originally indicative of origin and ownership, if they have come to be used to indicate quality, any one having the right to make or sell the article in connection wherewith such numerals are so used may designate the article by the numerals.<sup>2</sup>

In regard to letters, standing alone or in initial combinations, the English courts have from an early period treated them as trade-marks,<sup>3</sup> although it appears that under the English act of 1875, 38 and 39 Vict., c. 91, Vice-Chancellor Hall has held a single letter cannot be registered as a trade-mark.<sup>4</sup>

The use of a single letter would appear to be at least unsafe, although it might in the United States be re-

<sup>1</sup>Gillott v. Kettle, 3 Duer, 624; American Solid Leather Button Co. v. Anthony, 15 R. I. 338; Collins v. Reynolds Card Mfg. Co., 7 Abb. N. C. 17; India Rubber Comb Co. v. Jewelry Co., 45 N. Y. Sup. Ct. 258; Sohl v. Geisendorf, 1 Wills. (Ind.) 60; Hazard v. Caswell, 57 How. Pr. 1; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 226; 19 Am. Rep. 278; Seb. 443.

<sup>2</sup>Smith & Davis Mfg. Co. v. Smith, 89 Fed. Rep. 486.

<sup>3</sup>Ransome v. Bentall, 3 L. J. Ch. 161; Motley v. Downman, 3 My. & Cr. 1; Millington v. Fox, 3 My. & Cr. 338; Crawshay v. Thompson, 4 M. & G. 357; Kinahan v. Bolton, 15 Ir. Ch. 75; Hopkins v. Hitchcock, 14 C. B. N. S. 65; Hall v. Barrows, 4 DeG. J. & S. 150; Barrows v. Pelsall, Seb. 530; Re Barrows, L. R. 5 Ch. D. 353; Cartier v. Carlile, 31 Beav. 292; Cartier v. Westhead, Seb. 199; Cartier v. May, Seb. 200; Moet v. Clybonn, Seb. 533; Moet v. Pickering, L. R. 8 Ch. D. 372; Ex parte Young, Seb. 537; Ransome v. Graham, 51 L. J. Ch. 897; Bondier v. Depatie, 3 Dorion, 233; Re Brook, 26 W. R. 791.

<sup>4</sup>Re Mitchell, L. R. 7 Ch. D. 36; 46 L. J. Ch. 876; 26 W. R. 326; Cartmell, 226.

garded as a trade-mark; and Judge Bradford in a recent opinion suggests that a single letter or figure may be "so peculiar and unusual in form or ornamentation" as to be a valid trade-mark.<sup>1</sup>

Combinations of letters, used as initials, have been frequently approved as trade-marks in the American decisions,<sup>2</sup> and in the case of *Amoskeag Mfg. Co. v. Trainer*,<sup>3</sup> in the federal supreme court, the decision, which held the letters "A C A" were not a valid trade-mark, was based upon the theory that those letters as used by the complainant were indicative of quality, and not of origin or ownership, as Judge Coxe has pointed out.<sup>4</sup> There can scarcely be a doubt that both numerals and letters of the alphabet may sometimes be technical trade-marks, and the objection to their use in that capacity has been well stated by Judge Colt in the supreme court of Massachusetts to be "the difficulty of giving to bare numbers the effect of indicating origin or ownership, and of showing that the numbers used were originally designed for that purpose."<sup>5</sup> And the same practical suggestion was offered by the supreme court of Connecticut in these words: "It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, and that they have had that effect, it may not be easy to assign a reason why they should not receive the same protection, as trade-marks, as any other symbol or device."<sup>6</sup>

A review of the cases indicates that the use of numerals or letters has been restrained sometimes on the theory that they were technical trade-mark, but never where they were merely used to indicate quality;<sup>7</sup> and

<sup>1</sup> *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-658.

<sup>2</sup> *Geron v. Gartner*, 47 Fed. Rep. 467; *Frank v. Sleeper*, 150 Mass. 583.

<sup>3</sup> 101 U. S. 51.

<sup>4</sup> *Shaw Stocking Co. v. Mack*, 12 Fed. Rep. 707.

<sup>5</sup> *Lawrence Mfg. Co. v. Lowell*, 129 Mass. 325; *Price & Steuart*, 418.

<sup>6</sup> *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Cox*, 490.

<sup>7</sup> *Re Eagle Pencil Co.*, 10 Off. Gaz. 981; *Amoskeag Co. v. Trainer*, 101 U. S. 51.

where injunction has issued, the facts show that the infringing figures or letters were used in fraudulent competition.<sup>1</sup>

In this connection it is well to note that "there can be no doubt, and indeed it is not disputed, that two letters may constitute a trade-mark."<sup>2</sup> So the American courts have uniformly held that monograms or groups of two or more letters not indicative of quality constitute valid trade-marks; thus we find that the following marks have been held valid: "A. G." applied to cigars and coffee;<sup>3</sup> "B. B. B." applied to a medicine;<sup>4</sup> "B. B. H." applied to iron;<sup>5</sup> "S. B." applied to cough-drops;<sup>6</sup> "G. F." applied to velvet ribbon;<sup>7</sup> "A. C. A." applied to ticking.<sup>8</sup> And we find that similar groups of letters and monograms have been treated as valid by the later English decisions.<sup>9</sup>

§ 93. **The judicial test of infringement.**—It may be said, generally, that the courts will apply to the facts, in the class of cases that we are considering, any and all tests which are necessary to determine whether or not the competition established by the defendant is fraudulent. In delivering the opinion of the federal supreme court in *Coats v. Merrick Thread Co.*, Mr. Justice Brown observed: "The differences are less conspicuous than the general resemblance between the two. At the same time,

<sup>1</sup>Ransome v. Bentall, 3 L. J. Ch. N. S. 161; Gillott v. Kettle, 3 Duer, 624; Ainsworth v. Walmsley, L. R. 1 Eq. 518; Gillott v. Esterbrook, 47 Barb. 455; Cox, 340; 48 N. Y. 374; 8 Am. Rep. 553; Broadhurst v. Barlow, W. N. 1872, p. 212; Seb. 411; Kinney v. Basch, Seb. 542; Avery v. Meikle, 81 Ky. 75.

<sup>2</sup>Kinahan v. Bolton, 15 Ir. Ch. 75.

<sup>3</sup>Godillot v. American Grocery Co., 71 Fed. Rep. 873.

<sup>4</sup>Foster v. Blood Balm Co., 77 Ga. 216; 3 S. E. Rep. 284.

<sup>5</sup>Hall v. Barrows, 4 DeG. J. & S. 150.

<sup>6</sup>Burt v. Smith, 71 Fed. Rep. 161.

<sup>7</sup>Giron v. Gartner, 47 Fed. Rep. 467.

<sup>8</sup>Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51 (dissent of Mr. Justice Clifford). To the same effect see *Burton v. Stratton*, 12 Fed. Rep. 696; *Smith v. Imus*, 32 Alb. L. J. 455; *Frank v. Sleeper*, 150 Mass. 583.

<sup>9</sup>Hopkins v. Hitchcock, 14 C. B. N. S. 65; *Paul v. Barrows*, 4 DeG. J. & S. 150; *Re Barrows*, L. R. 5 Ch. D. 353; *Cartier v. Carlile*, 31 Beavan, 292; *Moet v. Pickering*, L. R. 8 Ch. D. 372; *Frankau v. Pope*, 11 Cape of Good Hope, 209.

they are such as could not fail to impress themselves upon a person who examined them with a view to ascertain who was the real manufacturer of the thread."<sup>1</sup> And in all cases the court will inspect not only the differences but the resemblances, as both must be considered in ascertaining whether the competition between the parties is fair or fraudulent. As said by Judge Severens: "It has been said that it is the resemblances that should be looked at, rather than the differences. But the existence of the latter negatives the former, and it is necessary to take both into view, in order to get a correct picture of the whole."<sup>2</sup>

Of course the defendant cannot avail himself of dissimilarities which become apparent only upon comparison of the plaintiff's and defendant's packages or marks. This is because purchasers do not have the opportunity of making comparisons. "A specific article of approved excellence comes to be known by certain catchwords easily retained in memory, or by a certain picture which the eye readily recognizes. The purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect. He acts upon the moment. He is without the opportunity of comparison. It is only when the difference is so gross that no sensible man acting on the instant would be deceived, that it can be said that the purchaser ought not to be protected from imposition. Indeed, some cases have gone to the length of declaring that the purchaser has a right to be careless,<sup>3</sup> and that his want of caution in inspecting brands of goods with which he supposes himself to be familiar ought not to be allowed to uphold a simulation of a brand that is designed to work fraud upon the public. However that may be, the imitation need only be slight if it attaches to what

<sup>1</sup>Coats v. Merrick Thread Co., 149 U. S. 562.

<sup>2</sup>Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357-362.

<sup>3</sup>It has been held on circuit that the careless purchaser will not be protected. N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 88, Fed. Rep. 694; but the case was reversed on appeal: s. c., 102 Fed. Rep. 327-332.

is most salient; for the usual inattention of a purchaser renders a good will precarious, if exposed to imposition."<sup>1</sup>

The foregoing extract very fully expresses the character of supervision over fairness in trade exercised by our courts of equity. When an article has become known by a catchword or a peculiar package, any one seeking to use that form of package, or a mark or name that suggests the catchword, must take care to keep within the bounds of fairness in trade in so doing.<sup>2</sup>

Mere colorable distinctions, so arranged as to escape notice,<sup>3</sup> the use of labels which may be removed by retail dealers, leaving the imitated marks free to effect deception,<sup>4</sup> and all the other devices and schemes of fraudulent competition disclosed by the reports, are taken into consideration in determining the right to equitable relief. One of the most important tests is the existence of similarities of detail, whether of design, form, size, color or material. Relief will always be granted when "it is manifest from a comparison (of the two articles in controversy) that one was copied from the other."<sup>5</sup> The court does not search for dissimilarities, but for points of resemblance.<sup>6</sup>

<sup>1</sup>Jenkins, J., in *Pillsbury v. Flour-Mills Co.*, 64 Fed. Rep. 841-847.

<sup>2</sup>*Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243. So the use of the word "Iwanta" has been enjoined as being a fraud upon the owner of the trade-mark "Uneeda," both words being applied to biscuit. *National Biscuit Co. v. Baker*, 95 Fed. Rep. 135.

<sup>3</sup>*Taylor v. Taylor*, L. R. 2 Eq. 290; 23 L. J. Ch. 255.

<sup>4</sup>*Barlow v. Johnson*, 7 R. P. C. 395.

<sup>5</sup>*Shipman, J.*, in *Dixon Crucible Co. v. Benham*, 4 Fed. Rep. 527-530.

<sup>6</sup>*Hostetter v. Adams*, 10 Fed. Rep. 838-842. Thus Judge Lacombe, in considering conflicting liquor labels, said: "Inspection of the labels must carry conviction to any unbiased and unprejudiced mind that the later label was prepared by some one who had seen the earlier one, and that it was designed, not to differentiate the goods to which it was affixed, but to simulate a resemblance to complainant's goods sufficiently strong to mislead the consumer, although containing variations sufficient to argue about should the designer be brought into court. This is the usual artifice of the unfair trader." *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693. In another recent case the same court says: "There are as usual a number of minor differences between the form and the dress of the two packages, which are

No matter what minor differences may exist in the tests of infringement applied by various courts, it has been uniformly noted that the fact that purchasers have no opportunity of comparison must be considered, and the genuine and alleged infringing marks must be judged by the court, therefore, in the light of that fact.<sup>1</sup>

In conclusion it is important to bear in mind that courts of equity have always avoided laying down any hard and fast rules by which to determine what constitutes fraud. The reason for this absence of set rules has been well stated as follows: "Were courts of equity to once declare rules prescribing the limitations of their power in dealing with it, the jurisdiction would be perpetually cramped and eluded by new schemes which the fertility of man's invention would contrive."<sup>2</sup>

expatiated upon in the affidavits and the brief; but no one can look at both packages without perceiving that there are strong resemblances, which could easily have been avoided had there been an honest effort to give defendants' goods a distinctive dress." *National Biscuit Co. v. Baker*, 95 Fed. Rep. 135.

<sup>1</sup>*Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841-847; *Manhattan Med. Co. v. Wood*, 108 U. S. 218; *Alleghany Fertilizer Co. v. Woodside*, 1 Hughes, 115; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; *Sawyer v. Kellogg*, 9 Fed. Rep. 601; *Liggett & Myers Tob. Co. v. Hynes*, 20 Fed. Rep. 883; *Hostetter v. Adams*, 10 Fed. Rep. 838-842.

<sup>2</sup>*Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529-539.

## CHAPTER IX.

### REGISTRATION.

§ 94. **Introductory.**—The English Patents, Designs and Trade-marks Act, 1883–1888, provides that there can be no institution of proceedings to prevent or to recover damages for the infringement of a trade-mark capable of registration unless it has been registered.<sup>1</sup> This provision does not occur in the act of congress of March 3, 1881, and could have no force or effect if it did, as there can be no valid trade-mark legislation by congress except under and by virtue of the commerce clause of the federal constitution (clause 3 of sec. VIII). As stated by Mr. Justice Miller: “When, therefore, congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several states, or with the Indian tribes. If not so limited, it is in excess of the power of congress.”<sup>2</sup>

§ 95. **The invalid registration acts.**—In order to obtain a substantial idea of the difficulties which have attended our national legislation upon trade-marks, it is only necessary to read the text of the several enactments of congress, which are collated in the appendix to this book. The act of July 8, 1870, was based upon an entire misconception or disregard of the power resident in congress. Both it and the subsequent penal act of August 14, 1876, were framed with the evident intention of providing a uniform trade-mark law for the several states. As will be seen by reference to the annotations to those acts, in the appendix, their validity was questioned and

<sup>1</sup>46 and 47 Vict., c. 57, sec. 77; *Hazzopulo v. Kaufmann*, 23 Sol. J. 819; *Goodfellow v. Prince*, L. R. 35 Ch. D. 9.

<sup>2</sup>*Trade-mark Cases*, 100 U. S. 82.



negatived upon circuit,<sup>1</sup> and it was finally settled by the supreme court that they were unconstitutional and therefore void.<sup>2</sup>

§ 96. **The power of congress to protect trade-marks.**—"The commerce clause of the federal constitution presents the remarkable instance of a national power which was comparatively unimportant for eighty years, and which in the last thirty years has been so developed that it is now, in its nationalizing tendency, perhaps the most important and conspicuous power possessed by the federal government."<sup>3</sup>

It is fortunate that with the judicial determination that the act of July 8, 1870, was void, came the realization by congress that within the scope of authority contained in the words "The congress shall have power . . . to regulate commerce with foreign nations, and among the several states, and with the Indian tribes," lay the foundation for its future trade-mark legislation. With this fact before it, congress proceeded to the enactment of the act of March 3, 1881, now embodied in the supplement to the Revised Statutes as section 322. No reason appears for the fact that under that act protection and the benefits of registration were extended only to "owners of trade-marks used in commerce with foreign nations or with the Indian tribes," and not to owners of trade-marks used in interstate commerce. But such is the fact, which it was left to future legislation to remedy.<sup>4</sup>

<sup>1</sup>Leidersdorf v. Flint, 8 Biss. 327.

<sup>2</sup>Trade-mark Cases, 100 U. S. 82.

<sup>3</sup>Prentice & Egan, Commerce Clause of the Federal Constitution, p. 1.

<sup>4</sup>"The laws of the United States now in force . . . relate only to trade-marks specially used in commerce with foreign nations, or with the Indian tribes. Act of March 3, 1881 (21 St. at Large, ch. 137, sec. 1). They are particularly restricted so as not to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe." Wheeler, J., in Luyties v. Hollender, 21 Fed. Rep. 281.

The full text of the present federal trade-mark act,<sup>1</sup> and the rules of the Patent Office in reference to the registration of trade-marks, will be found in the appendix.

§ 97. **The advantages of registration.**—The local registration statutes of the several states are too numerous and involved to be treated here.<sup>2</sup> As to federal registration, Judge Hawley has said that “registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts.”<sup>3</sup> Federal registration is, therefore, practically useless, owing to the failure of congress to cover, in the purview of the act of 1881, trade-marks employed in commerce between the states. As against a citizen of the same state, a registrant under that act has not even the right to sue in a court of the United States, unless it can be shown that both the original and infringing marks are being used in commerce with foreign nations or the Indian tribes.<sup>4</sup>

Registration under that act is only *prima facie* evidence of ownership of the trade-mark registered, and is not conclusive or binding upon the courts as to the right of a party to its exclusive use.<sup>5</sup> The certificate of regis-

<sup>1</sup>This act has been usually treated as valid. *South Carolina v. Seymour*, 153 U. S. 353; 67 Off. Gaz. 1191; *Hennessy v. Braunschweiler & Co.*, 89 Fed. Rep. 664. But in a late case Judge Jenkins said: “There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful.” *Illinois Watch Case Co. v. Elgin National Watch Co.*, 94 Fed. Rep. 667-669; 87 Off. Gaz. 2323.

<sup>2</sup>Some of the state legislation is referred to *post*, pp. 231, 232.

<sup>3</sup>*Hennessy v. Braunschweiler & Co.*, 89 Fed. Rep. 664-668. Quoted and followed in *Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co.*, 85 Off. Gaz. 1905. To the same effect see *Einstein v. Sawhill*, 65 Off. Gaz. 1918; *Sherwood v. Horton, Cato & Co.*, 84 Off. Gaz. 2018.

<sup>4</sup>*Ryder v. Holt*, 128 U. S. 525; *Luyties v. Hollender*, 22 Blatchf. 413; *Schumacher v. Schwenke*, 26 Fed. Rep. 816; *Gravely v. Gravely*, 42 Fed. Rep. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493.

<sup>5</sup>*Hennessy v. Braunschweiler*, *supra*; *Brower v. Boulton*, 53 Fed. Rep. 389; *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 824-826.

In the latter case Judge Wallace observed: “The act of congress

tration is only *prima facie* evidence of an admission on the part of the government that the applicant for registration is the owner of a valid trade-mark, is not a grant of any right or privilege, and does not, therefore, conclude a third party;<sup>1</sup> but it is conclusive as against the registrant, as limiting and restricting what he can claim as his trade-mark.<sup>2</sup> Notwithstanding its registration under the act, the trade-mark of an insolvent will be conveyed by a general assignment for the benefit of creditors.<sup>3</sup>

makes the registration of the mark only *prima facie* evidence of ownership. Sec. 7. The inquiry is therefore always open as to the validity of the title to a trade-mark evidenced by the registration. The registration could not confer a title to the trade-mark upon the complainant if some other corporation or individual had acquired a prior right by adoption and use; nor could it vest defendant with a title as against the complainant's common-law title. In this view the only office of a registration is to confer jurisdiction upon the court to protect a trade-mark when the proprietor has obtained the statutory evidence of title, and the only function of the commissioner of patents is to determine whether an applicant has a presumptive right to the trade-mark."

<sup>1</sup>United States v. Braun, 39 Fed. Rep. 775.

<sup>2</sup>Kohler Mfg. Co. v. Beeshore, 59 Fed. Rep. 572; Richter v. Reynolds, 59 Fed. Rep. 577; 8 C. C. A. 220; Adams v. Heisel, 31 Fed. Rep. 279-281; Kohler Mfg. Co. v. Beeshore, 53 Fed. Rep. 262-264; Richter v. Anchor Remedy Co., 52 Fed. Rep. 455; Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637.

<sup>3</sup>Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624.

## CHAPTER X.

### COURTS, PARTIES AND CAUSES.

§ 98. **Introductory.**—In the preceding chapters we have discussed the rights of owners or assignees of trade-marks, and the wrongs occurring when these rights are infringed, or, as against persons not the owners of technical trade-marks, other methods of unfair competition are resorted to. The remainder of this work will deal with the means by which infringers are restrained from a continuance of their wrongdoing and forced to make reparation for the damage they have occasioned. In this chapter we will confine our attention to the courts whose power may be invoked, the parties who may seek a remedy or against whom it may be sought, and the causes of action which may properly be brought to determine the rights of both parties.

§ 99. **Jurisdiction of United States circuit courts.** Section 7 of the act of 1881 provides that courts of the United States shall have original and appellate jurisdiction in cases involving a registered trade-mark, without regard to the amount in controversy. It has been held in this connection (prior to the statutes of 1887 and 1888, which raised the "amount in controversy" necessary to federal jurisdiction from \$500 to \$2,000) that the federal courts were not limited in their trade-mark jurisdiction to cases in which the defendant's profits had exceeded five hundred dollars.<sup>1</sup> And a later decision has held that "The statute of 1881, which gives them (*i. e.*, owners of registered trade-marks) the right to commence a suit without alleging the amount in controversy, was not repealed by the statutes of 1887 and 1888, which make it necessary, in order to give jurisdiction to the United

<sup>1</sup>Symonds v. Greene, 28 Fed. Rep. 834.

States circuit court, that the amount involved be two thousand dollars."<sup>1</sup>

In cases where there is diverse citizenship it does not appear to be necessary to allege that the plaintiff uses his trade-mark on goods intended for commerce with foreign nations or with the Indian tribes; but it has been held that the federal courts have no jurisdiction in a trade-mark action between citizens of the same state unless the pleadings affirmatively show that the complainant uses his trade-mark on goods intended for commerce with foreign nations or with the Indian tribes.<sup>2</sup> One decision declares it necessary, where both parties are citizens of the same state, to aver that the defendant has applied the simulated mark to goods intended to be used in such foreign commerce, or trade with the Indian tribes.<sup>3</sup> Such a requirement, however, would practically invalidate the act of 1881, and the reasoning of one of the cases tends to show that logically no such averment in the pleadings is necessary.<sup>4</sup> It is not necessary to show that either party has used the mark in commerce with foreign nations or with the Indian tribes where the parties are of diverse citizenship.<sup>5</sup>

Of course, in cases involving the right to an unregistered trade-mark, jurisdiction can only be acquired by the federal courts because of the diverse citizenship of the parties,<sup>6</sup> and the amount in controversy, which must be over \$2,000 exclusive of interest and costs; as to trade-marks, their jurisdiction is concurrent with that of the state courts. By virtue of the act of congress of

<sup>1</sup> *Glottin v. Oswald*, 65 Fed. Rep. 151; *Garland & Ralston*, Federal Practice, sec. 122; *Hennessy v. Herrmann*, 89 Fed. Rep. 669.

<sup>2</sup> *Ryder v. Holt*, 128 U. S. 525; *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 823; *Gravely v. Gravely*, 52 Off. Gaz. 1538; 42 Fed. Rep. 265; *Schumacher v. Schwenke*, 26 Fed. Rep. 818; *Luyties v. Hollender*, 27 Blatchf. 413.

<sup>3</sup> *Gravely v. Gravely*, 52 Off. Gaz. 1538; 42 Fed. Rep. 265.

<sup>4</sup> *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 823.

<sup>5</sup> *Hennessy v. Braunschweiler & Co.*, 89 Fed. Rep. 664.

<sup>6</sup> *Battle v. Finlay*, 50 Fed. Rep. 106; *Burt v. Smith*, 71 Fed. Rep. 161; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493.

March 3, 1887, ch. 373, as corrected by the act of August 13, 1888, ch. 866, suit cannot be brought against a corporation for infringement of a trade-mark except in the district where it is incorporated.<sup>1</sup>

Where a bill was brought to restrain infringement of a registered trade-mark and to restrain the defendants from unfair competition in simulating the form, size, color and shape of cough-drops manufactured by the complainants (both parties being citizens of the same state), the United States circuit court of appeals for the second circuit held that the fact that the trade-mark had not been infringed deprived the circuit court of jurisdiction, and that court had therefore erred in granting an injunction to restrain the unfair competition complained of.<sup>2</sup>

In a suit for injunction the "amount in controversy" is the value of the object to be gained by the bill, and not the amount of damages already suffered by the complainant.<sup>3</sup> In actions for infringement of trade-mark or for unfair competition, therefore, the amount of profits sought to be recovered does not determine this jurisdictional question. In trade-mark cases it is the value of the trade-mark that determines and fixes the "amount in controversy."<sup>4</sup> This must be specifically pleaded, because "the requisite value of the matter in controversy is a jurisdictional fact, and it must necessarily be averred in the declaration or bill. There are no presumptions in favor of the jurisdiction of the federal courts, as they are specially constituted with jurisdiction in certain cases; and the facts upon which it rests must appear in

<sup>1</sup>Re Keasbey & Mattison Co., 160 U. S. 221; Garland & Ralston, Federal Practice, sec. 161.

<sup>2</sup>Burt v. Smith, 71 Fed. Rep. 161. To the same effect see Goldstein v. Whelan, 62 Fed. Rep. 124; Luyties v. Hollender, 30 Fed. Rep. 632.

<sup>3</sup>Foster, Federal Practice (2d ed.), sec. 16. Citing Mississippi & Mo. R. R. Co. v. Ward, 2 Black, 485; Market Co. v. Hoffman, 101 U. S. 112; Symonds v. Greene, 28 Fed. Rep. 834; Whitman v. Hubbell, 30 Fed. Rep. 81.

<sup>4</sup>Symonds v. Greene, 28 Fed. Rep. 834; Hennessy v. Herrmann, 89 Fed. Rep. 669.

some form in the record of all suits prosecuted before them. They have no jurisdiction except such as the statute confers."<sup>1</sup>

When the parties are citizens of different states, so that the case comes within the general grant of jurisdiction in the first part of the act of March 3, 1887, the defendant, by entering a general appearance in a suit brought against him in a district of which he is not an inhabitant, waives the right to object that it is brought in the wrong district.<sup>2</sup> But a corporation, by doing business or appointing a general agent in a district other than that in which it is created, does not waive its right, if seasonably availed of, to insist that the suit should have been brought in the latter district.<sup>3</sup>

The court of appeals of the District of Columbia has no jurisdiction of trade-mark cases under section 3 of the law of 1881.<sup>4</sup>

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts cannot entertain such an action arising between citizens of the same state except in so far as the respondent's wrongful acts affect commerce with foreign nations or the Indian tribes; at least that is the express holding of the circuit court of appeals for the seventh circuit.<sup>5</sup>

**§ 100. Jurisdiction of the state courts.**—The state courts have a jurisdiction concurrent with that of the federal courts in trade-mark cases.<sup>6</sup> It may, at times,

<sup>1</sup>Garland & Ralston, Federal Practice, sec. 122.

<sup>2</sup>Re Keasbey & Mattison Co., 160 U. S. 221-229.

<sup>3</sup>Re Keasbey & Mattison Co., 160 U. S. 221-229. This reverses the ruling in *Gray v. Taper-Sleeve Pulley Works*, 16 Fed. Rep. 436-443, where it was held that the service of an agent of a foreign corporation was binding, the infringement having been perpetrated in the district where the action was instituted.

<sup>4</sup>*Einstein v. Sawhill*, 65 Off. Gaz. 1918.

<sup>5</sup>*Illinois Watch Case Co. v. Elgin Nat. Watch Co.*, 94 Fed. Rep. 667-672.

<sup>6</sup>The supreme court of Indiana seems to have held at one time that the jurisdiction of the state courts was exclusive. *Small v. Sanders*, 118 Ind. 105. It is well settled law that the jurisdiction of state and federal courts over suits for infringement of trade-marks is concurrent. The act of March 3, 1881, conferring jurisdiction upon the

be advisable for a non-resident plaintiff who has secured state registration for his mark or label to sue in the state court in preference to the federal court; this will be determined by the character of the matter for which state registration has been secured. Several of the states have by statute extended the definition of trade-mark to include tickets, labels, wrappers, and other wrappings or packages not properly trade-mark, and frequently it will be a benefit to a complainant to avail himself of such statutory provisions.<sup>1</sup> The courts of every state of the Union have, with the exception of California,<sup>2</sup> always been open to the owners of trade-marks seeking redress and protection against piracy, without requiring state registration as a prerequisite.

**§ 101. The elements whereon jurisdiction must be predicated.**—Lord Chancellor Brady, in the Irish high court of chancery, in 1893, speaking of trade-mark causes, said: "In such suits, in order to found the jurisdiction of this court, there must be established, first, the existence of the trade-mark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the court must regard them as merely colorable; and thirdly, the fact that the imitations were made without license, or anything that this court could regard as acquiescence in their use."<sup>3</sup> Mr. Sebastian refers to the remark of Vice-Chancellor Bacon, in England, that "the

courts of the United States, in no way impaired the jurisdiction of the state courts. *Re Keasbey & Mattison Co.*, 160 U. S. 221; *Reeder v. Brodt*, (C. P.) 4 Ohio N. P. 265; 6 Ohio Dec. 248.

<sup>1</sup>"The phrase trade-mark as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods of some particular class or description or the designation or name for any mill, hotel, factory or other business." And see sec. 366, Penal Code of New York, 1893; Montana Codes, 1895, vol. I, sec. 3160.

<sup>2</sup>*Whittier v. Dietz*, 66 Cal. 78. This exception to the rule has since been removed by statutory enactment.

<sup>3</sup>*Kinahan v. Bolton*, 15 Ir. Ch. 75-79. See also *Thedford Medicine Co. v. Curry*, 96 Ga. 89.



law of Scotland does not in this respect differ from the law of England"<sup>1</sup> (referring to trade-marks), as establishing, in conjunction with the above dicta of the learned Irish chancellor, the fact that the jurisdictional principles in the three kingdoms are the same.<sup>2</sup> The supreme court of New York has held it error to dismiss a complaint upon the pleadings and the opening of counsel where the complaint showed the ownership of a tobacco sample ticket used in trade by the plaintiffs, and the wrongful use of an imitation thereof by the defendants.<sup>3</sup> For reasons discussed elsewhere, it is not necessary to confer jurisdiction that it be alleged that any one has in fact been misled or deceived by the use of the simulated mark. But the pleadings must be drawn to suit the exigencies of the case; and where the facts plainly showed that the simulated mark did not and could not deceive either the jobber or retailer, and the fraud, if any, was upon the ultimate purchaser, the consumer, it was proper to aver the fact that the infringement was calculated to deceive the consumer,<sup>4</sup> and it is probably always a better course to aver that the imitation is calculated to deceive the ultimate purchaser.

The real and simulated marks should be submitted with the bill of complaint or accurately described in appropriate terms, the main test of the alleged resemblance being inspection by the court;<sup>5</sup> with the qualification that the resemblance need not be such as to deceive persons seeing the two marks side by side.<sup>6</sup>

<sup>1</sup>*Singer Mfg. Co. v. Loog* (3), L. R. 18 Ch. D. 395-404.

<sup>2</sup>*Sebastian, Trade-marks* (4th ed.), 170.

<sup>3</sup>*Linde v. Bensel*, 22 Hun (29 N. Y. Sup. Ct.), 601.

<sup>4</sup>*Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10-25. The court adds: "The consumer of the particular article is to be considered almost exclusively in determining the question of infringement, because, in the case of an attempted deception, he is substantially the only party likely to be deceived." Citing *Sykes v. Sykes*, 3 B. & Cr. 541; *Farina v. Silverlock*, 1 K. & J. 509; *Rose v. Loftus*, 47 L. J. Ch. 576; *Singer Mfg. Co. v. Loog* (3), 18 Ch. D. 395-412.

<sup>5</sup>*Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10-26.

<sup>6</sup>*Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896; *McCann v. Anthony*, 21 Mo. App. 83; *Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10; *Hier v. Abrahams*, 82 N. Y. 519.

§ 102. **The parties plaintiff.**—The action to protect a trade-mark may be brought by its owner or a licensee.<sup>1</sup> Trusts, constructive, implied or expressed, may arise,<sup>2</sup> in which case the name of the trustee would be necessary in all suits at law affecting the legal title to the trade-mark, and it would be his duty at all times to protect and defend the title or allow his name to be used for that purpose, under the established principles of law affecting trusts.<sup>3</sup>

Individuals and corporations having a common interest may join as parties complainant in a bill in equity to restrain an unfair competition in trade. Thus in a recent case we find seven corporations located in the city of Minneapolis joined in a bill to restrain the fraudulent use of names peculiar to their business and locality, by a dealer in Chicago,<sup>4</sup> and the owners of two separate "Blue Lick Water" springs in Kentucky joined in a bill to restrain the use of the words "Blue Lick Water" by a third party who had no right to their use.<sup>5</sup> During the period of administration the personal representative of the deceased owner of a trade-mark holds the mark, as we have seen, although it has been held in one case that it may pass

<sup>1</sup>Kidd v. Johnson, 100 U. S. 617; Kidd v. Mills, 5 Off. Gaz. 337. Where there is an exclusive licensee he must be made a party, or no injunction can issue. Wallach v. Wigmore, 87 Fed. Rep. 469.

<sup>2</sup>Re Mitchell, L. R. 28 Ch. D. 666. Thus where the use of a trade-mark is improperly obtained by one member of a partnership for his own use, he being bound to obtain it for the partnership, he is held to be the trustee of the mark for the benefit of the firm. Webster v. Ketcham (1), 39 N. Y. Sup. Ct. 54. Compare *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; 29 W. R. 392; *Re Rust*, 29 W. R. 393; *Re Farina*, 29 W. R. 391. The three cases last named are cases in which one partner registered a mark in his own name by mistake.

<sup>3</sup>Perry, *Trusts* (4th ed.), sec. 520.

<sup>4</sup>Pillsbury-Washburn Flour Mills Co. v. Eagle, 86 Fed. Rep. 608. See also *Gravel Roofers' Exchange v. Turnbull*, 64 Off. Gaz. 441.

<sup>5</sup>Northcutt v. Turney, 101 Ky. 314; 41 S.W. Rep. 21. See also *Society of Accountants v. Corporation of Accountants*, 20 Scot. Sess. Cas. (4th ser.), 750, in which three chartered societies joined in an action to prevent the use of the letters "C. A." (Chartered Accountants) by the defendant, those letters having been used only to designate members of the three complaining societies. See also *Pratt's Appeal*, 117 Pa. St. 401.

without administration.<sup>1</sup> Where there is an administrator, it is his duty to defend the trade-mark from infringement, and he can recover all accrued profits and damages from the infringer, as actions to restrain infringement and recover profits and damages are held not to come within the rule *actio personalis moritur cum persona*.<sup>2</sup> The owner of real estate and improvements thereon may have such a right in a trade-mark used to identify the product of his tenants as to entitle him to prevent his tenants from using the mark after they have removed to other premises.<sup>3</sup>

Where copartners dissolve partnership, each retaining the right to use the trade-marks of the firm, each can assert his right to the exclusive use of such trade-marks as to all persons except his associates in ownership.<sup>4</sup> But in all cases where the right to a trade-mark is vested severally in two or more persons, either of them will be enjoined from advertising or claiming that his is the "only genuine" article.<sup>5</sup>

§ 103. **The parties defendant.**—We have seen in a previous chapter that the liability for injunction against infringement extends to the manufacturer of dies from which counterfeits of the mark are to be made; and it may accurately be said that every one who deals with the simulated trade-mark or the means of producing it will be restrained in equity.

In a case where a temporary injunction had been granted against a person since deceased, without opposition, and the defendant in his life-time had never moved to vacate it, it was held in New York that the

<sup>1</sup>Pratt's Appeal, 117 Pa. St. 401. See *Stewart v. Einstein*, 64 Off. Gaz. 1533.

<sup>2</sup>Woerner, Administration, sec. 299; *Oakey v. Dalton*, L. R. 35 Ch. D. 700; 35 W. R. 709; *Hatchard v. Mege*, L. R. 18 Q. B. D. 771; *Gibblett v. Read*, 9 Mod. 459; *Croft v. Day*, 7 Beav. 84.

<sup>3</sup>*Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217; *Armstrong v. Kleinhaus*, 82 Ky. 803; *Harper v. Pearson*, 3 L. T. N. S. 547; *Car-michael v. Latimer*, 11 R. I. 395; *Motley v. Downman*, 3 My. & Cr. 1; *Dickson v. McMaster*, 18 Ir. Jur. 202.

<sup>4</sup>*New York Cement Co. v. Coplay Cement Co.*, 45 Fed. Rep. 212.

<sup>5</sup>*Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co.*, 87 Fed. Rep. 203.

cause would not be continued as against the administratrix of the defendant, because it was not shown that the defendant had acquired any rights in the litigation or that any prejudice would result to the estate by not continuing the action.<sup>1</sup>

The question who may be parties defendant involves necessarily a discussion of some of the principles applied by the courts in infringement proceedings.

Where the plaintiff, the sole owner of a mineral spring, leased it to one who adopted a name to indicate its waters, the concessionaire was enjoined at the instance of the owner from applying the name so used to water from another spring;<sup>2</sup> and in a case where the owner of a spring granted concessions to another conveying the selling privileges in certain countries, the concessionaire was enjoined from interfering with the sale in those countries of water from the spring sold through parties other than the concessionaire.<sup>3</sup>

A manufacturer may delegate the right to use his trademark to sales merchants, giving them that right only so long as they buy goods, of the class to which the trademark belongs, from him. Upon their ceasing to so purchase their goods they will be enjoined from the use of the mark.<sup>4</sup>

A firm of shippers of merchandise who applied the name "The Keystone Line" to vessels they did not own, but of which they had the exclusive management in loading and unloading, were held to have acquired such an exclusive right in the name that the owners of the vessels so used were enjoined from using the name when the shippers transferred their business to other vessels, the property of other ship-owners.<sup>5</sup>

One who is merely a forwarding agent may be enjoined. In an English case a firm of forwarding agents in London

<sup>1</sup> Republic of Peru v. Reeves, 40 N. Y. Sup. Ct. 316.

<sup>2</sup> Hill v. Lockwood, 32 Fed. Rep. 389.

<sup>3</sup> Apollinaris Co. (Ltd.) v. Scherer, 23 Blatchf. 459.

<sup>4</sup> Re Riviere, 53 L. T. N. S. 237. See also Lavergne v. Hooper, Ind. L. R. 8 Mad. 149.

<sup>5</sup> Winsor v. Clyde, 9 Phila. 513.

received from foreign correspondents several packages of cigars bearing forged brands. They were enjoined, but costs were not assessed against them because they had, prior to suit, given the makers of the brands so counterfeited full information as to the consignees and offered to return the cigars to the consignors or to erase the brands.<sup>1</sup>

The managers of an infringing corporation, who are themselves substantially the corporation, are properly joined as co-defendants with the corporation in a bill to restrain the infringement.<sup>2</sup> The directors of an infringing corporation may be joined as co-defendants with it.<sup>3</sup>

Servants, agents, and employees generally, may be joined as defendants; they are personally liable to injunction.<sup>4</sup> American agents of foreign houses will be enjoined from selling counterfeits or imitation goods received from their principals.<sup>5</sup> The same rule obtains in regard to English<sup>6</sup> or Australian<sup>7</sup> agents of foreign principals, and in regard to commission merchants.<sup>8</sup>

The principal is, of course, liable for the acts of his servants or agents, whether or not he can be shown to have knowledge of those acts.<sup>9</sup>

Difficulty arises in considering the rights and liabilities of innocent parties through whose hands counterfeit goods pass in transit, who hold them only as bailees and have no actual or imputed knowledge of their fraudulent

<sup>1</sup>Upmann v. Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. Ap. 130.

<sup>2</sup>California Fig Syrup Co. v. Improved Fig Syrup Co., 61 Off. Gaz. 155; 51 Fed. Rep. 296.

<sup>3</sup>Armstrong & Co. v. Savannah Soap Works, 61 Off. Gaz. 1018.

<sup>4</sup>Estes v. Worthington (2), 30 Fed. Rep. 465; Sawyer v. Kellogg (1), 7 Fed. Rep. 721; Sawyer v. Kellogg (2), 9 Fed. Rep. 601.

<sup>5</sup>Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625; Roberts v. Sheldon, 8 Biss. 398.

<sup>6</sup>Siegert v. Ehlers, Seb. 432; Siegert v. Findlater, L. R. 7 Ch. D. 801; Farina v. Cathery, L. J. N. C. 1867, p. 134.

<sup>7</sup>Siegert v. Lawrence, 11 Vict. L. R. 47.

<sup>8</sup>Coats v. Holbrook, 2 Sandf. 586; Cox, 20; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70.

<sup>9</sup>Low v. Hart, 90 N. Y. 457; Atkinson v. Atkinson, 85 L. T. Jour. 229; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Tonge v. Ward, 21 L. T. N. S. 480.

nature. In the case of wharfingers so situated, who offered to act in regard to falsely marked wine in their possession as the court might direct, but asked to have their charges provided for, the court ruled that they were entitled to a lien upon the wine for their charges; that plaintiffs must pay defendant's costs; and if the plaintiffs had any lien for their own costs as against the wine, it must be subject to the lien of the wharfingers for their charges.<sup>1</sup>

An innocent mortgagee of wines bearing a simulated mark was held to have a valid lien thereon, and it was directed that the spurious marks should be effaced and the wines delivered to him.<sup>2</sup>

In no case, however, will relief in equity stop short of protecting the owner of a trade-mark of which imitations or counterfeits are found in the hands of a common carrier or warehouseman.<sup>3</sup> It is the duty of the bailee so situated to give the owner of the trade-mark full information in regard to the goods which are or have been in his hands by virtue of the bailment, and where he refuses so to do, even after the goods have gone beyond his control, it has been held that a bill will lie against him to compel discovery.<sup>4</sup>

If, on the other hand, the bailee gives the owner of the mark full information, he will be allowed costs if, notwithstanding his disclosures, proceedings are instituted against him.<sup>5</sup> The wrongs of which this book treats being torts, and all participants in torts being principals, a person who assists in conducting an unfair competition by furnishing fraudulent packages or labels is

<sup>1</sup>Moet v. Pickering, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372.

<sup>2</sup>Ponsardin v. Peto, 33 Beav. 642.

<sup>3</sup>Ponsardin v. Peto, 33 Beav. 642; Hunt v. Maniere, 34 Beav. 157; Del Valle v. Mayer, Seton (4th ed.), 236; Seb. 326; Rivero v. Nonis, Seton (4th ed.), 236; Seb. 299; Moet v. Pickering, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372; Upmann v. Elkan, L. R. 12 Eq. 140.

<sup>4</sup>Orr v. Diaper, L. R. 4 Ch. D. 92. See also Carver v. Pinto Leite, L. R. 7 Ch. D. 90; 41 L. J. Ch. 92; 25 L. T. N. S. 722; 20 W. R. 134.

<sup>5</sup>Upmann v. Currey, 29 Sol. J. 735; Upmann v. Forester, L. R. 24 Ch. D. 231; Moet v. Pickering, L. R. 8 Ch. D. 372; Upmann v. Elkan, L. R. 12 Eq. 140.

liable for the injury resulting to the plaintiff from the unfair competition.<sup>1</sup>

§ 104. **Forms of action.**—The most usual form of civil action to secure redress for trade-mark piracy in this country is by bill in equity, praying for an injunction, discovery, account of profits, and damages. The remedy at law is by an action on the case, for deceit; that form of action being both the form known to the common law and that prescribed by the act of March 3, 1881.

An action of deceit may be brought by a purchaser who has been deceived by the vendor of the fraudulent article, but such actions are seldom, if ever, brought, and are practically unheard of.

One action in a federal court will lie for the infringement of a patent and the infringement of a trade-mark, where the trade-mark and the patent were both infringed together.<sup>2</sup>

<sup>1</sup>Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

<sup>2</sup>Walker, Patents (3d ed.), sec. 417; Jaros Underwear Co. v. Fleece Underwear Co., 60 Fed. Rep. 622.

## CHAPTER XL.

### THE CRIMINAL PROSECUTION—FEDERAL AND STATE.

§ 105. **The act of 1876.**—The prosecutions under which the decision styled the *Trade-mark Cases*<sup>1</sup> was rendered were instituted under the act of congress of 1876. This was a penal act applicable to infringers of trade-marks registered under the registration act of 1870. Mr. Justice Miller says, in the conclusion of his opinion: "While we have, in our references in this opinion, had mainly in view the act of 1870, and the civil remedy which that act provides, it was because the criminal offenses described in the act of 1876 are, by their express terms, solely referable to frauds, counterfeits, and unlawful use of trade-marks which were registered under the provisions of the former act. If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it."<sup>2</sup>

After the enactment of the act of March 3, 1881, some able lawyers inclined to the belief that the act of 1876 was by the passage of a valid registration act given new life, or, as stated by one eminent jurist: "This is not an instance of revival; for the penal act was not dead, but simply dormant. Its sleep was ended by the birth of the act of 1881. No words were required in the latter to set the penal law in motion. That which is implied in a statute is just as much a part of it as is that which is expressed. Nor is it repealed by the civil act of 1881."<sup>3</sup>

This reasoning, however, has not been followed by the courts. The proposition was first submitted to Judge Thayer, but in his opinion he expressly refrained from

<sup>1</sup>100 U. S. 82.

<sup>2</sup>Trade-mark Cases, 100 U. S. 82-99.

<sup>3</sup>Browne, Trade-marks (2d ed.), sec. 371.



deciding it, sustaining demurrers to indictments based upon the act of 1876 upon other grounds.<sup>1</sup> Subsequently the question was squarely presented to Mr. Justice Brewer, sitting as circuit judge, who said in substance: "While the act of 1870 was a nullity, it must be assumed as a matter of fact that in framing the act of 1876 the penalties imposed were with reference to the terms of the statute of 1870. . . . Again, when the act of 1881 was passed, if congress had intended that penalty should be imposed for a trespass upon the rights conferred by that statute, or if it had intended that the act of 1876 should be revived and operate upon the act of 1881, it was very easy to say so. Its silence in this respect is cogent evidence that it did not understand or intend that the penal statute should be considered a part of present and valid law. And that assumption is strengthened by the fact that it had before it for consideration this passage from the opinion of the supreme court (quoted above) in which it is broadly stated that the act of 1876 had fallen with the act of 1870. Whatever may be true as to the full meaning of that decision, or as to the general power of congress to impose penalties for trespasses upon rights having no existence, it had before it the general affirmance by the court that the law of 1876 had fallen, and it must be assumed that if it meant that it should stand and be revived, or that any penalties should be imposed for violations of the law of 1881, it would have so stated. These considerations convince me very strongly that the act of 1876 has, as the supreme court said, fallen with the act of 1870, and it is as much a dead letter as the act of 1870, and was not revived or given operative force by the act of 1881."<sup>2</sup>

The act of 1876, then, is no longer of force, and there is no federal relief by criminal prosecution to be had; except that under certain conditions, which we will examine in the next section, the owners of trade-marks applied to

<sup>1</sup>United States v. Braun, 39 Fed. Rep. 775-777.

<sup>2</sup>United States v. Koch, 40 Fed. Rep. 250-252.

spirituous liquors and wines may be measurably protected by federal prosecution under the internal revenue laws.

§ 106. **Section 3449, Revised Statutes.**—In the last paragraph of section 29 of the act of congress approved July 13, 1866, and entitled “An act to reduce internal taxation and to amend an act entitled ‘An act to provide internal revenue to support the government, to pay interest on the public debt, and for other purposes,’ approved June 30, 1864” (now section 3449, Revised Statutes of the United States), it is provided as follows:

“Whenever any person ships, transports, or removes any spirituous or fermented liquors or wines, under any other than the proper name or brand known to the trade as designating the kind and quality of the contents of the casks or packages containing the same, or causes such act to be done, he shall forfeit said liquors or wines, and casks or packages, and be subject to pay a fine of five hundred dollars.”

This enactment is constitutional, being within the authority delegated to congress by the first clause of section 8 of article 1 of the constitution, being to “levy and collect taxes,” and to “make all laws which shall be necessary and proper for carrying into execution that power.” It is no objection to the validity of the act that its enforcement incidentally protects the owners of trademarks. As stated by Mr. Justice Nelson in another connection: “It will not do to say that the exercise of an admitted power of congress conferred by the constitution is to be withheld, if it appears, or can be shown, that the effect and operation of the law may incidentally extend beyond the limitation of the power. Upon any such interpretation the principal object of the framers of the instrument in conferring the power would be sacrificed to the subordinate consequences resulting from its exercise.”<sup>1</sup> It has therefore been held constitutional by

<sup>1</sup> *State of Pennsylvania v. Wheeling & Belmont Bridge Co.*, 59 U. S. 421-433.

Judges Lacombe,<sup>1</sup> Thayer, Sanborn, Caldwell<sup>2</sup> and Hawley.<sup>3</sup> Under this section the term "package" includes every box, barrel, or other receptacle into which distilled spirits have been placed for shipment or removal, either in quantity or in separate small packages, as bottles or jugs.<sup>4</sup> The phrase "proper name or brand" does not refer to the trade-mark or make of a certain distiller, but to a removal under an improper or misleading title, as where the fraud on the government is attempted of removing brandy under the name of whiskey.<sup>5</sup>

What will constitute transportation or removal under the terms of this act is not determined, and will probably depend upon the facts in each particular case. The act includes in its purview any person who ships, transports or removes liquors in violation of its provisions.<sup>6</sup>

This act is capable of protecting to a great extent the owners of trade-marks used in the liquor trade.

§ 107. **Criminal liability at common law.**—The counterfeiter of a trade-mark is not guilty of forgery.<sup>7</sup> His offense is comprehended under some division of the various fraud acts. Probably it will always be found to fall within the limits of the acts defining the offense of obtaining money under false pretenses.<sup>8</sup> But under the English decisions it is not a forgery, even where the trade-mark counterfeited consists of a signature.<sup>9</sup> In the United States, however, prosecutions have been very

<sup>1</sup>United States v. Loeb, 49 Fed. Rep. 636.

<sup>2</sup>United States v. 132 Packages of Spirituous Liquors and Wines, 76 Fed. Rep. 364; reversing same case, 65 Fed. Rep. 930.

<sup>3</sup>United States v. Campe, 89 Fed. Rep. 697.

<sup>4</sup>United States v. 132 Packages of Spirituous Liquors and Wines, 76 Fed. Rep. 364-368.

<sup>5</sup>United States v. 132 Packages of Spirituous Liquors and Wines, 76 Fed. Rep. 364-368.

<sup>6</sup>United States v. Campe, 89 Fed. Rep. 697-699.

<sup>7</sup>White v. Wagar, 185 Ill. 195-202. He may be, where the counterfeited mark contains a guaranty, expressed or implied. White v. Wagar, 83 Ill. App. 592-596.

<sup>8</sup>Regina v. Smith, D. & B. 566; 8 Cox, 32.

<sup>9</sup>Regina v. Closs, D. & B. 460; 7 Cox, 494; Regina v. Smith, 8 Cox, 37; Regina v. Dundas, 6 Cox, 380; Regina v. Gray, Seb. 183; Regina v. Sutter, 10 Cox, 577.

seldom resorted to. The prosecutor in actions sounding in false pretenses should, of course, be the customer who has been defrauded, and as a rule he is little inclined to prosecute.

**§ 108. The penal statutes of the several states.**—There are three general classes of state penal acts relating to violations of trade-mark rights.<sup>1</sup> The first covers offenses against all trade-marks. Sometimes these statutes are limited to offenses against trade-marks registered in the state; while in other instances there is no such limitation, and no registration is required. In the foot-note is a list of statutes comprising examples of the general penal legislation of the several states affecting trade-marks.<sup>2</sup>

<sup>1</sup>The so-called "flag" law of Illinois (Laws 1889, p. 234), prohibiting the use of the national flag or emblem for commercial purposes, was held unconstitutional in *Ruhrstrat v. People*, 185 Ill. 133.

<sup>2</sup>Arizona.—Revised Statutes, 1887, Penal Code, ch. 11, secs. 574–578.

Arkansas.—Sandels & Hill's Digest of the Statutes, 1894, sec. 7352.

California.—Deering's Penal Code, 1897, secs. 350, 351.

Colorado.—Mills' Annotated Statutes, 1896, vol. III, secs. 2985c, 2985d.

Connecticut.—General Statutes, 1898, secs. 3961–3963.

Delaware.—Act of March 29, 1893, ch. 699, vol. XIX, Laws, secs. 1–6.

Georgia.—Code, 1895, vol. III, secs. 252, 253.

Idaho.—Revised Statutes, 1887, secs. 6862, 6863.

Illinois.—Starr & Curtis, Annotated Statutes (2d ed.), 1896, p. 1288, pars. 232, 233; p. 3955, par. 7; p. 3957, par. 10.

Indiana.—Burns, Annotated Statutes, 1894, secs. 8686, 8690–8692.

Iowa.—Code, 1897, secs. 5047, 5048.

Kansas.—General Statutes, 1897, vol. II, ch. 100, sec. 421.

Maine.—Revised Statutes, 1883, ch. 126, sec. 7; Laws of 1893, ch. 276.

Massachusetts.—Acts 1895, ch. 462 (Supp. Public Statutes, 1897, p. 1398), secs. 4, 5.

Michigan.—Act 1891, p. 39, sec. 3.

Minnesota.—General Laws, 1895, ch. 122, sec. 2.

Missouri.—Revised Statutes, 1889, secs. 8571–8574.

Montana.—Penal Code, 1894, sec. 636.

New York.—Penal Code, 1893, sec. 364.

The second class of statutes comprehends the use of trade-names, labels and trade-marks by trades unions.<sup>1</sup>

The third class of state penal legislation consists of acts intended to protect the owners of syphons and bottles from the refilling or malicious destruction of such packages by others. A number of these acts are cited in the foot-note.<sup>2</sup>

In several of the states there are statutory provisions for the issuance of search-warrants in aid of prosecutions.<sup>3</sup>

The protection offered by these various state enactments is inconsiderable. Practically without exception it is necessary to prove fraudulent intent to sustain a conviction. Such proof is difficult. Thus under the Illinois acts it was held that the proof that two persons, strangers to the defendant, had told him that the mark or label on the goods he was selling was counterfeit, was not necessarily sufficient to prove his guilty knowledge.<sup>4</sup>

<sup>1</sup> Illinois.—Laws 1891, p. 202. See *Vogt v. People*, 59 Ill. App. 684.

Kentucky.—Public Acts 1889, ch. 823, p. 99.

Maryland.—Acts 1892, ch. 357.

Massachusetts.—Statutes 1895, ch. 462, sec. 3. See *Tracy v. Banker*, 170 Mass. 266.

Nebraska.—Laws 1891, ch. 15, p. 214.

New Jersey.—Acts 1889, p. 107. Held constitutional in *Schmalz v. Wooley*, 57 N. J. Eq. 303.

New York.—Laws 1889, ch. 385, p. 533. Held valid in *Perkins v. Heert*, 158 N. Y. 306; 53 N. E. Rep. 18.

Ohio.—Laws 1890, p. 141.

Wisconsin.—Laws 1891, p. 353.

<sup>2</sup> Arkansas.—Acts 1895, p. 232.

California.—Deering's Penal Code, 1897, sec. 354.

Colorado.—Mills, Annotated Statutes, 1896, vol. III, secs. 2985g-2985k.

Connecticut.—Act of April 25, 1895, Acts 1895, p. 490.

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<sup>3</sup> Illinois.—See *White v. Wagar*, 83 Ill. App. 592; affirmed s. c., 185 Ill. 195; holding warrant improperly issued under general search-warrant act.

Indiana.—Burns, Annotated Statutes, 1897, sec. 8680*d*.

Massachusetts.—Acts 1893, ch. 440, sec. 4.

Missouri.—Acts 1893, p. 259.

New York.—Penal Code, 1893, sec. 369. See *People v. Hogan*, 29 N. Y. State, 110.

<sup>4</sup> *Vogt v. The People*, 59 Ill. App. 684.

This fact, combined with the great uncertainty of trial by jury in criminal causes, renders the owner of a trade-mark very reluctant to intrust his trade-mark's protection to the criminal courts. The state of Massachusetts has made a marked advance in this direction by an act requiring a defendant charged with the sale of goods bearing a spurious mark to show that he bought them innocently.<sup>1</sup> There is no reason why these acts should in any case require proof of fraudulent intent as a prerequisite to a conviction.<sup>2</sup>

Illinois.—Act of May 2, 1873, Starr & Curtis, Annotated Statutes (2d ed.), 1896, p. 3953, pars. 1-5.

Indiana.—Burns, Annotated Statutes, 1894, secs. 8678-8680; Burns, Annotated Statutes, 1897, secs. 8680a-8680g.

Iowa.—Code, 1897, sec. 5052.

Kansas.—General Statutes, 1897, vol. II, ch. 100, sec. 422.

Louisiana.—Acts 1896, p. 169.

Maine.—Acts 1891, ch. 125, secs. 1-3.

Massachusetts.—Acts 1893, ch. 440; Supplement to Public Statutes, 1897, p. 909.

Missouri.—Acts 1893, p. 256.

New York.—Penal Code, 1893, sec. 369. Heydecker's Gen. Laws, 1900, ch. XXXIV, sec. 28. See *Mullins v. People*, 23 How. Pr. 289; 24 N. Y. 399.

<sup>1</sup>Massachusetts Acts of 1895, ch. 462, sec. 5.

<sup>2</sup>*Wood v. Burgess*, L. R. 24 Q. B. D. 162; holding proof of fraudulent intent immaterial in a prosecution under Merchandise Marks Act, 1887 (50 and 51 Vict., c. 28).

## CHAPTER XII.

### ACTIONS AT LAW.

§ 109. **The form of action.**—An action of trespass on the case is prescribed by the act of March 3, 1881, as the proper legal remedy for infringements of trade-marks.<sup>1</sup> It is against the policy of the law that the owner of a valid trade-mark should lose by reason of its infringement. To prevent such a result, the action of trespass on the case is well adapted, because it measures the plaintiff's recovery by the plaintiff's loss. But it is also against the policy of the law that an infringer should gain by reason of his infringement. To prevent such a result, the action of trespass on the case is not well adapted, because an infringer may often gain much more than the owner of the trade-mark loses by reason of the infringement.

Section 914 of the Revised Statutes of the United States provides that "The practice, pleadings, and forms and modes of proceeding in civil causes, other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the state within which such circuit or district courts are held, any rule of court to the contrary notwithstanding."

The majority of the states have now abolished all common-law forms of action. The provision of the act of 1881 providing trespass on the case as the appropriate remedy for trade-mark infringement is in apparent conflict with the section above recited. What form of action must the pleader use? The law of trade-marks, in this regard, is identically the same as the law of patents, for the action of trespass on the case is provided by Revised

<sup>1</sup>Act of March 3, 1881, sec. 7.

Statutes, section 4919, as the remedy at law for patent infringement. And it seems very clear that the rule laid down by the federal courts in patent cases is the rule which must govern actions at law in trade-mark cases, namely, that the pleadings in an action at law for trade-mark infringement must conform to the common-law rules, even in a code state.<sup>1</sup>

The history of this form of action has been succinctly described by English jurists. Lord Blackburn said: "The original foundation of the whole law is this: that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established (alike at law<sup>2</sup> and in equity<sup>3</sup>) that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."<sup>4</sup>

The development of the action on the case, and the manner in which it became adapted to the exigencies of trade-mark issues, are thus admirably stated by Mellish, L. J.: "In my opinion all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in respect of the improper use of a trade-mark arose out of the common-law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect: that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade-mark, the common-law courts noticed that the false representation which is made by putting another man's trade-mark, or the trade name of another manufacturer, on the goods which the

<sup>1</sup>Myers v. Cunningham, 44 Fed. Rep. 349.

<sup>2</sup>Blofield v. Payne, 4 B. & Ad. 410.

<sup>3</sup>Edelsten v. Edelsten, 1 DeG. J. & S. 185.

<sup>4</sup>Singer Mfg. Co. v. Loog (3), L. R. 8 A. C. 15-29.



wrong-doer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade-mark is imitated; and, therefore, the common-law courts held that such a manufacturer had a right of action for the improper use of his trade-mark. Then the common-law courts extended that doctrine one step further; first, if I recollect rightly, in the case of *Sykes v. Sykes*.<sup>1</sup> There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods and therefore was not deceived into believing that he had bought goods manufactured by another person, yet if the trade-mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade-mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade-mark a right of action. That was the common-law right."<sup>2</sup>

§ 110. **The declaration.**—On account of the provision of the act of March 3, 1881, establishing the action of trespass on the case as the proper remedy at law for infringement of registered trade-marks, it becomes important to give attention to the pleadings necessary in that form of action.

The proper parts of a declaration in an action on the case are, in their order, as follows:

1. The title of the court.
2. The title of the term.
3. The name.
4. The commencement.
5. The statement of the right of action.
6. The conclusion.

<sup>1</sup>3 B. & Cr. 541.

<sup>2</sup>*Singer Mfg. Co. v. Wilson*, L. R. 2 Ch. D. 434-453.

The correct title of the United States circuit court established in the northern district of California is "The Circuit Court of the United States for the Northern District of California," and the titles of the various other circuit courts are the same, except as to the name of the district,<sup>1</sup> to which should be added the name of the division of the district, where the judicial districts are subdivided.

The term in which the declaration should be entitled is the term to which the defendant is summoned.<sup>2</sup> It is unnecessary to entitle a declaration in the name of the case in which it is filed; the style of the case may be indorsed upon the back of the declaration as a matter of convenience.<sup>3</sup>

The venue should be laid in the district where the declaration is filed, regardless of the district or districts wherein the infringement was committed.<sup>4</sup>

The commencement sets forth the names of the parties and the capacity in which they respectively sue or are sued, if it is other than a natural capacity.<sup>5</sup>

A corporation cannot be or become a citizen of a state,<sup>6</sup> and therefore an averment of its citizenship is improper. When a corporation is a party the corporate name should be set forth, followed by the averment that the said corporation "is a corporation created under the laws of the state of —, and having its principal place of business at —." <sup>7</sup>

The courts of the United States having a limited jurisdiction, the jurisdictional facts must be expressly pleaded in the declaration. Diverse citizenship, if it exists, must be shown. If the trade-mark involved is reg-

<sup>1</sup> Revised Statutes, sec. 608.

<sup>2</sup> Chitty, Pleading (15th Am. ed.), p. 263.

<sup>3</sup> Walker, Patents (3d ed.), sec. 422.

<sup>4</sup> Ibid.

<sup>5</sup> Ibid.

<sup>6</sup> Paul v. Virginia, 8 Wall. 168; Ducat v. Chicago, 10 Wall. 410.

<sup>7</sup> Shiras, Equity Practice (2d ed.), sec. 34. Citing Lafayette Ins. Co. v. French, 18 How. 404; Railroad Co. v. Harris, 12 Wall. 65; *Ex parte Schollenberger*, 96 U. S. 369; *Pennsylvania Co. v. Railroad Co.*, 118 U. S. 290; *Goodlet v. Railroad*, 122 U. S. 391.

istered under the act of March 3, 1881, that fact must be pleaded, because, first, it establishes a *prima facie* right to the use of the mark, and second, confers jurisdiction upon the federal court regardless of the amount in controversy.<sup>1</sup>

If the action is between citizens of the same state, even though involving a registered trade-mark, the declaration must aver that the plaintiff uses the trade-mark and the defendant the infringing mark upon goods intended for commerce with foreign nations or with the Indian tribes.<sup>2</sup> If the action is based upon a common-law trade-mark, the declaration must set forth the amount in controversy, which is not the amount sought to be recovered, but the value of the trade-mark, and that value must be not less than two thousand dollars.<sup>3</sup> The commencement of the declaration should close with a recital that the form of action is that of trespass on the case.<sup>4</sup>

Fraud is essential to recovery at law. Lord Westbury said, "Proof of fraud on the part of the defendant is of the essence of the action."<sup>5</sup> Furthermore, at law it is necessary to show, and plead, that an injury has actually been done by the defendant's act of infringement.<sup>6</sup>

The averment of infringement should set forth, then, in what the infringement consisted, and that it was done wilfully and with fraudulent intent on the part of the

<sup>1</sup>Act of March 3, 1881, sec. 7. *Symonds v. Greene*, 28 Fed. Rep. 834; *Glottin v. Oswald*, 65 Fed. Rep. 151; *Hennessy v. Herrmann*, 89 Fed. Rep. 669; *Re Keasbey & Mattison Co.*, 160 U. S. 221-227.

<sup>2</sup>*Luyties v. Hollender* (1), 22 Blatchf. 413; *Schumacher v. Schwenke* (1), 26 Fed. Rep. 818; *Ryder v. Holt*, 128 U. S. 525; *Gravely v. Gravely*, 42 Fed. Rep. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493.

<sup>3</sup>*Symonds v. Greene*, 28 Fed. Rep. 834.

<sup>4</sup>*Walker, Patents* (3d ed.), sec. 422.

<sup>5</sup>*Edelsten v. Edelsten*, 1 DeG. J. & S. 185; *Hargraves v. Smith*, Seb. 338; *Lawson v. Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188; 2 Jur. N. S. 716; 27 L. T. 134; 4 W. R. 481; Seb. 140; *Rodgers v. Nowill*, 6 Hare, 325; 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; Seb. 82; *Crawshay v. Thompson*, 4 Man. & G. 357; 5 Scott, N. R. 562; 11 L. J. C. P. 301; Seb. 72.

<sup>6</sup>*Singer Mfg. Co. v. Loog* (3), L. R. 8 App. Cas. 15-30.

defendant. The statement of the right of action should describe the trade-mark in exact and appropriate terms, and where possible the real and simulated marks should be reproduced in fac-simile.

The conclusion of the declaration should pray for the actual damage sustained by the plaintiff and for punitive damages if the facts justify. Some adjudications in the past have held that there can be no recovery of punitive damages,<sup>1</sup> but such a conclusion is at variance with the fundamental principles of the law of torts. The more wholesome and better reasoned doctrine is to the contrary.<sup>2</sup>

The conclusion ends with the formal allegation of bringing suit.

It is necessary at common law in drafting the declaration to directly allege that the injury has been committed by continuation from one given time to another or that it was committed on divers days and times. Thus, one pleader alleged in his declaration as follows: "Since the 1st day of November, 1888, knowingly, wilfully, and fraudulently offered for sale, and is now selling, glue in packages." Upon the trial, in the federal circuit court for the district of Massachusetts, the complainant was permitted to introduce proof of sales by the defendant of infringing goods between November 1, 1888, and November 30, 1889, amounting to \$56,318.24. The circuit court of appeals of the fourth circuit set aside a judgment of \$8,000, entered upon the verdict of a jury, saying, by Putnam, J., "There is no *continuando* with reference to the matter of selling; so that, according to the common law, the plaintiff could properly prove only one actual sale as an independent basis of damages. The defendant insisted at all necessary points on the enforcement of the rule, and exceptions were carefully taken and allowed; so that this court, however much it may regret it, is compelled to meet this issue. There is no doubt

<sup>1</sup>Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; 9 L. T. 514; Seb. 83.

<sup>2</sup>Warner v. Roehr, Fed. Case No. 17189A; Day v. Woodworth. 13 How. 363; Browne, Trade-marks (2d ed.), secs. 519, 520.

that at common law the position of the defendant would be correct on this point, and the Massachusetts statutes relating to pleading have not changed this rule."<sup>1</sup>

§ 111. **Defenses.**—The defenses to actions for trade-mark infringement may be divided into two classes. The first class embraces defenses which attack the plaintiff's right to sue. It may be that the owner of a trade-mark who sues for infringement has conveyed the right to use the mark to an exclusive licensee for a term of years. In such a case no injunction can issue unless the licensee joins in the action.<sup>2</sup> It may be advisable to set up laches or acquiescence, or that there are facts to justify a plea that whatever rights the complainant once had he has lost by abandonment; which matters have been discussed in a preceding chapter. In an exceptional case the complainant's recovery may be precluded by an estoppel,<sup>3</sup> which should, of course, be pleaded. The complainant's mark may have become invalid because its assignment to him from its former owner has not been sufficiently advertised, and tends to mislead the public into a belief that the former owner is still the producer of the goods.<sup>4</sup> The complainant's label may contain misrepresentations of fact,<sup>5</sup> or his alleged trade-mark may be a word that, once distinctive, has become *publici juris*.<sup>6</sup> It is a good defense to the action at law to show either of these matters. The fact that the complainant's trade-mark is registered does not deprive the public of the right to use a similar mark which was common to the trade before the registration. Thus, where "La Normandi" was registered as a mark for cigars, but "La Normanda" was already in common use for a like purpose,

<sup>1</sup> Le Page Co. v. Russia Cement Co., 51 Fed. Rep. 941-949.

<sup>2</sup> Wallach v. Wigmore, 87 Fed. Rep. 469.

<sup>3</sup> Laverne v. Hooper, Ind. L. R. 8 Mad. 149.

<sup>4</sup> Alaska Packers' Ass'n v. Alaska Imp. Co., 60 Fed. Rep. 103; Siegert v. Abbott (1), 61 Md. 286.

<sup>5</sup> Piso Co. v. Voight, 4 Ohio N. P. 347; Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585.

<sup>6</sup> Siegert v. Abbott (4), 25 N. Y. Supp. 590; 72 Hun, 243.

injunction to restrain the use of the latter was denied.<sup>1</sup> In fact the registration of a trade-mark does not prevent its being attacked as a word *publici juris*, or as being itself a colorable imitation of another trade-mark.<sup>2</sup> The English decisions upon this point are in harmony with those of the courts of the United States.<sup>3</sup>

The defendant may plead a license from the owner of the mark. This, of course, presumes that the license was lawful, and that the licensee has not so used the mark as to perpetrate a fraud upon the public.<sup>4</sup> Where two or more persons have an equal right in the use of the mark the defendant may plead a license from either of them.<sup>5</sup>

The second class of defenses that may be interposed are pleas that deny the infringement—either denying that any infringement has been perpetrated by the defendant, or, if the infringing mark has been handled or dealt with by the defendant, denying that guilty knowledge which the complainant must prove to sustain his suit at law.

In the foregoing portion of this section we have noted the defenses which, if sustained by the proof, will relieve the defendant from liability at law. The action at law is much easier of defense than that in equity, and in another section, after we have considered the action in equity, will be found enumerated a number of defenses

<sup>1</sup>Stachelberg v. Ponce, 23 Fed. Rep. 430; Price & Steuart, 967; 128 U. S. 686.

<sup>2</sup>Moorman v. Hoge, 2 Sawyer, 78; Decker v. Decker, 52 How. Pr. 218; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; Cox, Manual, 695; 23 Blatchf. 46; Schumacher v. Schwenke (2), 36 Off. Gaz. 457.

<sup>3</sup>Re Palmer, L. R. 21 Ch. D. 47; Bodega Co. (Ltd.) v. Owens, 23 L. R. Ir. 371; Wolfe v. Lang, 13 Vict. L. R. 752; Wolfe v. Alsop (2), 12 Vict. L. R. (E.), 421; Lewis v. Klapproth, 11 Vict. L. R. (E.), 214.

<sup>4</sup>The goods to which a licensee applies the mark must be equal in quality to the goods to which the licensor applied them. Lawrence Mfg. Co. v. Tennessee Mfg. Co., 31 Fed. Rep. 776; 138 U. S. 537; Oldham v. James, 13 Ir. Ch. 393; 14 Ibid. 81; Bloss v. Bloomer, 23 Barb. 604; Cox, 200; Samuel v. Berger, 24 Barb. 163; Cox, 178; Rodgers v. Philp, 1 Off. Gaz. 29; Re Tolle, 2 Off. Gaz. 415.

<sup>5</sup>Marshall v. Pinkham, 52 Wis. 572; Price & Steuart, 497.

which have proved ineffective in equity, many of which would doubtless be adequate at law.

§ 112. **Damages.**—The courts of the United States have signally failed to agree upon any fixed rule as to the measure of damages in actions at law for the infringement of trade-marks. To the student of the decisions the only apparent cause for this fact lies in two practical reasons. The first, that the remedy offered by equity is more complete. The second is that the bulk of the trade-mark piracy, of this country at least, is conducted by insolvents, who offer no inducement to the vigilant prosecution which should be visited upon them. In 1846, in the United States circuit court for the district of Massachusetts, Woodbury, J., said: "In a case like this (an action of trespass on the case for trade-mark infringement), if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory. There is nothing peculiarly atrocious in the conduct of the defendant, to be punished by damages, and in no other way, as a public example, considering the blamable usages which exist on this subject."<sup>1</sup> In a Missouri case, the St. Louis court of appeals, by Lewis, P. J., held that it was error in the trial court to instruct the jury that they might find exemplary damages if from the evidence they believed that the acts of the defendant were wilful or malicious. The reasoning of the court is that "If the plaintiffs had demanded an accounting of the profits made by the defendants, on the equitable ground that those profits were made by the use of the plaintiffs' property, the instructions might have been substantially applicable."<sup>2</sup>

An eminent text-writer thus states the rule: "The jury are to give actual damages which the plaintiff has sustained—not vindictive or speculative damages, but

<sup>1</sup>Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; Fed. Case No. 13785. The passage quoted is a mere dictum, uttered in the course of an opinion upon a motion for a new trial where a jury had been directed that they might find punitive damages. The verdict was not disturbed.

<sup>2</sup>Addington v. Cullinane, 28 Mo. App. 238-241.

such as his proof has shown to their satisfaction he has actually sustained by the infringement.”<sup>1</sup>

To the author's mind the better rule is announced in the case of *Warner v. Roehr*, in which the instructions of Judge Blodgett to a jury said in part: “In cases of this character, where you are satisfied from the proof and from the admissions in the case that the fraud—the intention to defraud—is at the bottom of the matter, . . . the jury are not confined to the exact monetary damages, but may give what are known as vindictive or exemplary damages, for the purpose of deterring others from embarking in the same schemes of fraud and deception.”<sup>2</sup> It is not to be doubted that this doctrine is more reasonable and just, and better adapted to protect society from the ravages of trade-mark infringers, than the rule stated in *Taylor v. Carpenter*<sup>3</sup> and *Addington v. Cullinane*.<sup>4</sup> It is difficult to see how the result stated in those cases has been attained. They are wholly without precedent and opposed to the rule of damages which obtained at common law. What that rule was, and is, so far as our federal courts are concerned, is nowhere more clearly stated than by Mr. Justice Grier in an opinion in which he speaks for the federal supreme court. He says:

“It is a well-established principle of the common law that in actions of trespass and all actions on the case for torts a jury may inflict what are called exemplary, punitive or vindictive damages upon a defendant, having in view the enormity of his offense rather than the measure of compensation to the plaintiff. We are aware that the propriety of this doctrine has been questioned by some writers; but if repeated judicial decisions for more than a century are to be received as the best exposition of what the law is, the question will not admit of argument. By the common as well as by statute law men are often pun-

<sup>1</sup> Sutherland, *Damages* (2d ed.), vol. III, sec. 1202. Citing *Ransom v. Mayor*, 1 Fisher, 252; *Parker v. Hulme*, 1 Fisher, 44; *Addington v. Cullinane*, 28 Mo. App. 238.

<sup>2</sup> *Warner v. Roehr*, Fed. Case No. 17189A.

<sup>3</sup> *Supra*.

<sup>4</sup> *Supra*.



ished for aggravated misconduct or lawless acts by means of a civil action, and the damages, inflicted by way of penalty or punishment, given to the party injured. In many civil actions, such as libel, slander, seduction, etc., the wrong done to the plaintiff is incapable of being measured by a money standard; and the damages assessed depend on the circumstances, showing the degree of moral turpitude or atrocity of the defendant's conduct, and may properly be termed exemplary or vindictive rather than compensatory. .

"In actions of trespass where the injury has been wanton and malicious, or gross and outrageous, courts permit juries to add to the measured compensation of the plaintiff which he would have been entitled to recover, had the injury been inflicted without design or intention, something further by way of punishment or example, which has sometimes been called 'smart money.' This has always been left to the discretion of the jury, as the degree of punishment to be thus inflicted must depend on the peculiar circumstances of each case."<sup>1</sup>

Judge Thayer has said: "Punitive damages may be awarded when a wrongful act is done wilfully, in a wanton or oppressive manner, or even when it is done recklessly,—that is to say, in open disregard of one's civil obligations and of the rights of others."<sup>2</sup>

We find the rule sanctioned and reaffirmed repeatedly by the supreme court of the United States.<sup>3</sup> It has been the doctrine adhered to by that court ever since Mr. Justice Story in a case of marine tort spoke of exemplary damages as "the proper punishment which belongs to such lawless misconduct."<sup>4</sup> It is manifest that in a case of

<sup>1</sup>Day v. Woodworth, 54 U. S. (13 Howard), 363-371. See Press Pub. Co. v. Monroe, 73 Fed. Rep. 196-201.

<sup>2</sup>Fotheringham v. Express Co., 36 Fed. Rep. 252-253.

<sup>3</sup>Philadelphia R. R. Co. v. Quigley, 62 U. S. (21 Howard), 213; Milwaukee R. R. Co. v. Arms, 91 U. S. 487-492; Missouri Pacific Railway v. Humes, 115 U. S. 512-521; Barry v. Edmunds, 116 U. S. 550-562; Denver Railway v. Harris, 122 U. S. 597-609. Exemplary damages may be allowed even where no actual damage is proven. Press Publishing Co. v. Monroe, 73 Fed. Rep. 196-201.

<sup>4</sup>The Amiable Nancy, 16 U. S. (3 Wheat.) 546-558.

deliberate counterfeiting of a trade-mark there should be a recovery of punitive damages, or at least an opportunity given the jury to assess punitive damages.

As to the award of actual damages at law, it has been held that nominal damages will be awarded where a fraudulent intent is shown, even though no specific injury is pleaded or proven.<sup>1</sup> The St. Louis court of appeals has said, by Bakewell, J., in an action of deceit based upon trade-mark infringement: "As to the damages, the facts present a case of fraud on plaintiff and violation of his rights for which the action lies without proof of specific damages. And the damage was not confined to the loss of such actual sales as could be specifically shown to be lost, but the jury might make such inferences as to the loss and injury sustained by plaintiff as they might think warranted by the whole evidence in the case."<sup>2</sup> Much to the same effect is the holding of the Massachusetts supreme court.<sup>3</sup>

In California the rule of assessing damages would seem to give the plaintiff the profits made by the defendant in his sale of goods bearing the infringing mark.<sup>4</sup>

But it is very doubtful if that course is proper in a trial at law. Damages were the appropriate, and indeed the only, remedy at law, while the account of profits was peculiar to courts of equity.<sup>5</sup>

Under the English practice a custom has grown up by which a complainant in equity may pray for an account of profits and an inquiry as to damages (and it has been held in Wisconsin that this is the proper course in pleading),<sup>6</sup> but before any order for discovery can be made he

<sup>1</sup>Le Page Co. v. Russia Cement Co., 51 Fed. Rep. 941-949; Taylor v. Carpenter, 11 Paige, 292; 2 Sandf. 603; Coffeen v. Brunton, 4 McLean, 516-520; Fed. Case No. 2946; Blofield v. Payne, 4 Barn. & Ad. 410, 411; Marsh v. Billings, 7 Cushing, 322-331; Conrad v. Brewing Co., 8 Mo. App. 277-285; El Modello Cigar Co. v. Gato, 25 Fla. 886-915; 9 So. Rep. 23.

<sup>2</sup>Conrad v. Brewing Co., 8 Mo. App. 277-285.

<sup>3</sup>Marsh v. Billings, 7 Cushing, 322-332.

<sup>4</sup>Graham v. Plate, 40 Cal. 593-598.

<sup>5</sup>Sebastian, Trade-marks (3d ed.), p. 255.

<sup>6</sup>Leidersdorf v. Flint (2), 50 Wis. 401.

must elect between the accounting of profits and the inquiry of damages. He cannot have both.<sup>1</sup> As said by Cotton, L. J., in the English court of appeal, in refusing discovery asked by a complainant before he had elected between profits and damages: "At the time when the order was made, the plaintiff had not elected to waive his account of profits. Would it then be right to allow the plaintiff to get a jury to determine what damages he was entitled to before he had made his election between damages and profits? Should the jury award him a large sum for damages, he would probably accept it; but if they gave him a small sum only, then he might say 'No, I would rather have an account of profits, as I see by the defendant's books that he has made a much larger sum.'"<sup>2</sup>

It would seem that the damages at law must be based upon the injury sustained by the complainant by loss of sales and injury to the reputation of his trade-mark. Evidence of the extent of the defendant's sales may be proper,<sup>3</sup> but only as proof of injury to the complainant, and not with a view to measuring the plaintiff's damages by the defendant's profits.

Of course the fact that the defendant has discontinued his infringement is no defense to an action of damages,<sup>4</sup> which would be barred only by the operation of the statute of limitations. It is competent to show that plaintiff's sales have fallen off because of the infringement.<sup>5</sup>

<sup>1</sup>Neilson v. Betts, L. R. 5 H. L. R. 1.

<sup>2</sup>Fennessy v. Clark, L. R. 37 Ch. D. 184-187.

<sup>3</sup>Le Page Co. v. Russia Cement Co., 51 Fed. Rep. 941-949.

<sup>4</sup>Lemoine v. Gauton, 2 E. D. Smith, 343; Cox, 142; Seb. 125.

<sup>5</sup>Shaw v. Pilling, 175 Pa. St. 78-84. It is competent to show that a diminution of plaintiff's sales occurred concurrently with defendant's infringement. Whether the latter is the cause of the former is a question for the jury. Ibid.

## CHAPTER XIII.

### THE ACTION IN EQUITY.

§ 113. **The basis of equitable jurisdiction.**—Lord Westbury said: “Imposition on the public occasioned by one man selling his goods as the goods of another cannot be the ground of private action or suit. In the language of Lord Thurlow in *Webster v. Webster*,<sup>1</sup> note, ‘The fraud upon the public is no ground for the plaintiff coming into court.’ It is, indeed, true, that, unless the mark used by the defendant be applied by him to the same kind of goods as the goods of the plaintiff, and be in itself such that it may be and is mistaken in the market for the trade-mark of the plaintiff, the court cannot interfere, because there is no invasion of the plaintiff’s right; and thus the mistake of the buyers in the market, under which they, in fact, take the defendant’s goods as the goods of the plaintiff, that is to say, imposition on the public, becomes the test of the property in the trade-mark having been invaded, and not the ground on which the court rests its jurisdiction.”<sup>2</sup>

In quoting the extract given above, Vice-Chancellor Van Vleet has said: “The rule as thus stated I understand to be the established doctrine now in force on this subject both in this country and in England.”<sup>3</sup>

In the early English practice the chancellor had power to refuse or postpone the application of equitable remedies in trade-mark cases until the title to the trade-mark

<sup>1</sup>3 Swanst. 490.

<sup>2</sup>*Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 137-141.

<sup>3</sup>*Schneider v. Williams*, 44 N. J. Eq. 391-393. To the same effect see *Weener v. Brayton*, 152 Mass. 101-103; *Avery v. Meikle*, 81 Ky. 73-91; *Liggett & Myers Tobacco Co. v. Sam Reid Tobacco Co.*, 104 Mo. 53-60; *McLean v. Fleming*, 96 U. S. 245-251; *Shaver v. Shaver*, 54 Iowa, 208-209; *Barrows v. Knight*, 6 R. I. 434-438; *Handy v. Commander*, 49 La. Ann. 1119.

had been determined in a court of law. This practice continued until November 1, 1862, when the "Chancery Regulation Act, 1862"<sup>1</sup> went into effect. The first section of that act provides that "In all cases in which any relief or remedy within the jurisdiction of the said courts of chancery respectively is or shall be sought in any cause or matter instituted or pending in either of said courts, and whether the title to such relief or remedy be or be not incident to or dependent upon a legal right, every question of law or fact, cognizable in a court of common law, on the determination of which the title to such relief or remedy depends, shall be determined by or before the same court."

It is important to bear this enactment in mind in examining the earlier English trade-mark cases, as it explains the many failures of equity to act, or the deferring of relief by injunction until the determination of the right to the use of the trade-mark by trial at law.

Equity first extended its beneficent protection to the owners of trade-marks because of the inadequacy of the remedy at law. This inadequacy arose from the absence of the power in courts of law to act *in personam*—the injunctive power. But there were other reasons why cognizance of trade-mark causes belonged peculiarly to equity. Prominent among these was the power of the chancellor in granting discovery—the right to discovery being, as Mr. Bispham says, one of the peculiar advantages of a complainant in equity, enjoyed by him in every case in which he was entitled to come into chancery, either for the purpose of asserting an equitable title, or setting up an equitable right or applying an equitable remedy;<sup>2</sup> though the right was always conditioned by the necessary restriction that the person brought in on discovery need not disclose matters tending to incriminate him or expose him to penalty or forfeiture. And there was yet another reason why this litigation found its way to the chancellor. One of the most ancient forms of action at the

<sup>1</sup>25 and 26 Victoria, c. 42, p. 154.

<sup>2</sup>Bispham, *Equity* (4th ed.), p. 600, sec. 557.

common law was the action of account. "But," in the words of Mr. Justice Story, "the modes of proceeding in that action, although aided from time to time by statutable provisions, were found so very dilatory, inconvenient and unsatisfactory, that as soon as courts of equity began to assume jurisdiction in matters of account, as they did at a very early period, the remedy at law began to decline; and although some efforts have been made in modern times to resuscitate it, it has in England fallen into almost total disuse."<sup>1</sup> So, when it became apparent that an account of profits must be sought as, at least, the basis of a proper money judgment against an infringer, the parties litigant were forced to enter the domain of equity. But, above all, there was that power in equity described by Blackstone as the power "to detect latent frauds and concealments, which the process of the courts of law is not adapted to reach."<sup>2</sup> While not exclusive of the courts of law, the courts of equity had original, independent and inherent jurisdiction to relieve against every species of fraud.<sup>3</sup>

§ 114. **The bill in equity.**—The bill for an infringement of a trade-mark or unfair competition properly consists of six parts:

1. The title of the court.
2. The introduction.
3. The statement.
4. The prayer for relief.
5. The interrogating part.
6. The prayer for process.

By the twenty-first federal equity rule, the plaintiff is given liberty to omit, at his option, the jurisdiction clause (*i. e.*, that the acts complained of are contrary to equity, and that the complainant is without any remedy at law), the charging part of the bill, setting forth the matters or excuses which the defendant is supposed to intend to set up by way of defense to the bill, and the

<sup>1</sup>Story, *Equity Jurisprudence* (13th ed.), sec. 442.

<sup>2</sup>1 Blackstone, *Commentaries*, 92.

<sup>3</sup>Kerr, *Fraud and Mistake* (Bump's ed.), p. 43.

common confederacy clause. The title of the court is given substantially as indicated in the preceding section on declarations at law, and rule 20 of the federal equity rules prescribes the form of the introductory part, which is a formal address to the judges of the court in which the bill is filed, together with the names and averments of the citizenship of the parties.

The stating part of the bill should show: (1) The ownership of the trade-mark, describing it and the mode of its application to merchandise. (2) The registration of that trade-mark under the act (if registered), and the value of the trade-mark. (3) The facts in relation to the infringement of the trade-mark by the respondent. This part of the bill differs from the corresponding part of the declaration at law in this, that it need not be averred that the defendant had guilty knowledge,<sup>1</sup> although that fact should be averred where it is true. Where profits are sought to be recovered there should be a direct averment that such profits have been realized by the defendant on account of the infringement.

In every case where the value of the complainant's trade-mark is over two thousand dollars, that fact should be pleaded,<sup>2</sup> as a jurisdictional safeguard, independent of the fact of registration under the act of congress. A matter of paramount importance where the parties are citizens of the same state is an averment that the complainant uses his trade-mark in application to merchandise intended for commerce with foreign nations or with the Indian tribes,<sup>3</sup> and one court has held that it must be averred and proven in such a case that the defendant has used the infringement in commerce with foreign nations or with the Indian tribes.<sup>4</sup> Where the parties are of diverse citizenship no such averment is necessary.<sup>5</sup>

<sup>1</sup>McLean v. Fleming, 96 U. S. 245.

<sup>2</sup>Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823.

<sup>3</sup>Ryder v. Holt, 128 U. S. 525; Luyties v. Hollender (1), 22 Blatchf. 413; Schumacher v. Schwenke (1), 26 Fed. Rep. 818; Schumacher v. Schwenke (2), 36 Off. Gaz. 457; Gravely v. Gravely, 42 Fed. Rep. 265.

<sup>4</sup>Gravely v. Gravely, 42 Fed. Rep. 265; 52 Off. Gaz. 1538.

<sup>5</sup>Hennessy v. Braunschweiler & Co., 89 Fed. Rep. 669.

The prayer for relief should be both special and general, under the directions given in the twenty-first federal equity rule. The special portion of the prayer should ask for a preliminary injunction (if it is desired), a perpetual injunction, for an account of the defendant's profits, and for an assessment of the damages sustained by the complainant by reason of the injuries he has sustained through the loss of reputation of his trade-mark or otherwise. A bill is not demurrable on the ground that it prays for damages in addition to profits, because both can be recovered where fraudulent intent is established.<sup>1</sup> But punitive or exemplary damages should not be prayed for, as they cannot be assessed in equity.<sup>2</sup>

The prayer for general relief should be in the form usual in equity pleading.<sup>3</sup>

The form to be used in the interrogating part of the bill is prescribed by the forty-third federal equity rule. Rule 41 provides that the interrogatories be separated and numbered consecutively, and the interrogatories which each defendant is required to answer must be specified in a note at the foot of the bill. And that rule further provides that where the complainant in his bill waives an answer under oath, or only requires an answer under oath with regard to certain specified interrogato-

<sup>1</sup>El Modello Cigar Co. v. Gato, 25 Fla. 886-915; 7 So. Rep. 23; Benkert v. Feder, 34 Fed. Rep. 534.

<sup>2</sup>Hennessy v. Wilmerding-Loewe Co., 103 Fed. Rep. 90.

<sup>3</sup>A bill to enjoin unfair competition must expressly charge that the defendant has attempted or intended to practice fraud upon the public. Lamont v. Leedy, 88 Fed. Rep. 72-74. But this rule is hardly broad enough. The better doctrine would seem to be that the bill need only charge that the defendant's merchandise is calculated to deceive the public. Judge Lacombe, referring to the practice of the federal courts in cases of unfair trade, has said: "Nor do these courts require specific proof of purchases by individuals actually deceived, when the labels themselves show an attempt at deception which appears to be well calculated to deceive." Collinsplatt v. Finlayson, 88 Fed. Rep. 693. And the same learned court indicates the same rule in Burnett v. Hahn, 88 Fed. Rep. 694.

A bill to enjoin the manufacturer or vendor of spurious labels must contain an express charge that the defendant is actually engaged in assisting third persons to palm off their goods upon the public as the



ries, the answer of the defendant, though under oath, except such part thereof as shall be directly responsive to such interrogatories, shall not be evidence in his favor unless the cause be set down for hearing on bill and answer only.

The twenty-third federal equity rule provides that the prayer for process of subpoena shall contain the names of the defendants named in the introductory part of the bill, and if any of them are known to be infants under age, or otherwise under guardianship, shall state the fact so that the court may take order thereon, as justice may require, upon the return of the process.

The bill must contain the signature of counsel, as provided in the twenty-fourth federal equity rule.

Unless a preliminary injunction is prayed for the bill need not be verified.

These suggestions for the most part relate to bills in the federal circuit courts. The decisions of those courts are so harmonious that the great bulk of the trade-mark litigation is before them. As to the state courts, reference must necessarily be had to the local forms of action (or absence of such form) created by legislative enactment.

goods of the complainant's, or a substantially equivalent averment. *De Kuyper v. Witteman*, 23 Fed. Rep. 871; *Hennessy v. Herrmann*, 89 Fed. Rep. 669.

A bill to enjoin the infringement of a technical trade-mark must set up facts showing an exclusive right to the use of the mark in the plaintiff. He "must recover upon the strength of his own title, and not upon the weakness of the defendant's." *Brown, J., in O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576-579.

*Improper joinder of causes of action.*—A bill is multifarious that joins with a charge of unfair competition by the use of a trade-name a claim for damages under the Sherman anti-trust act of July 2, 1890. *Block v. Standard Distilling & Distributing Co.*, 95 Fed. Rep. 978.

A bill is multifarious that joins with a charge of unfair competition (by passing off the defendant's goods in unmarked packages as and for plaintiff's goods) a charge of patent infringement. *Ball & Socket Fastener Co. v. Cohn*, 90 Fed. Rep. 664.

§ 115. **The defenses in equity.**—All defenses good in the action at law are good in the action in equity except that of the innocence of the defendant of wrongful intent. In a case where both parties have the right to use the trade-mark, the defendant will be enjoined from using the words “the only genuine” in connection with the trade-mark.<sup>1</sup> The plaintiff must, of course, be actually entitled to use the trade-mark having applied it commercially. Thus Sir James Clark’s application to restrain one Freeman from advertising or selling pills under the name of “Sir J. Clark’s Consumption Pills” was denied because the plaintiff was not engaged in the sale of pills.<sup>2</sup> The plaintiff may not be entitled to recover because of his not having an exclusive right to the mark; or because he has, without authority, used the words “patent” or “patented” in connection with or as a part of what he claims as his trade-mark. Or he may have made fraudulent representations in connection with his trade-mark which will prevent his recovering the relief sought for. A single act done at the suggestion of the plaintiff’s agent will not be treated as an infringement.<sup>3</sup>

It often happens that the defendant may plead by way of mitigation of damages or so as to avoid his liability

<sup>1</sup>James v. James, L. R. 13 Eq. Cas. 421; Cocks v. Chandler, L. R. 11 Eq. Cas. 446.

<sup>2</sup>Clark v. Freeman, 11 Beav. 112. This decision is criticised in Maxwell v. Hogg, L. R. 2 Ch. App. 307; but it is manifestly correct in principle, considered as a trade-name case. Lord Justice Cairns says (L. R. 2 Ch. App. 310): “It has always appeared to me that Clark v. Freeman might have been decided in favor of the plaintiff on the ground that he had a property in his own name,” *i. e.*, a right of privacy, which involves a discussion which it would be aside from our purpose to enter upon here. Lord Chancellor Selborne has criticised Clark v. Freeman from another standpoint, saying: “That case has been seldom cited but to be disapproved. Could not a professional man be injured in his profession by having his name associated with a quack medicine?” *Re Riviere’s Trade-mark*, L. R. 26 Ch. D. 53.

<sup>3</sup>Hennessy v. Kennet, Seb. 556; Gorham Mfg. Co. v. Emery-Bird-Thayer Co., 92 Fed. Rep. 774.

for an accounting or for costs. Thus, in an English case, the defendants purchased five hundred cigarettes, worth only 17s. 6d., and which bore a mark which was an infringement of the plaintiff's. The court granted the application for injunction, but refused to order the defendants to pay costs, saying by Sterling, J.: "I confess I think this is not a sort of action that ought to be encouraged. If persons find a trade-mark is being pirated, surely it is not the small retailers who ought to be punished. . . . I cannot think that it is the duty of the court in every case in which a small dealer who has innocently happened to purchase a small quantity of the spurious goods, to fix him with the costs of an action."<sup>1</sup> A defendant who was printing labels for a third party did not know that the labels bore counterfeits of plaintiff's trade-marks. On being notified of the fact of infringement, defendant offered to surrender the lithograph stone and promised to desist from further printing the counterfeit labels. The court adopted the same course as that taken by the English court in the last named case—granted an injunction but at complainant's costs.<sup>2</sup> This case shows that it is not wise to notify a defendant before suing. It has been expressly and repeatedly held that the defendant is not entitled to notice,<sup>3</sup> and it is related by Chitty, J., that when that very learned jurist, the late Sir G. Jessel, master of the rolls, was at the bar, it was his custom to advise his clients in trade-mark actions not to give any notice but to move at once.<sup>4</sup>

These suggestions are given here to call the attention of the practitioner whose duty is to defend the alleged infringer to the very serious question of avoiding costs.

It may be possible to defend successfully on the ground that, although the plaintiff has applied his trade-mark in

<sup>1</sup>American Tobacco Co. v. Guest, 9 R. P. C. 218; L. R. (1892) 1 Ch. D. 630; 61 L. J. Ch. 242; 66 L. T. 257; 40 W. R. 364; Cartmell, 45.

<sup>2</sup>Bass v. Guggenheimer, 69 Fed. Rep. 271.

<sup>3</sup>Upmann v. Forester, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28.

<sup>4</sup>Upmann v. Forester, L. R. 24 Ch. D. 231-235.

commerce, he has not applied it to the same character or class of merchandise as that to which the defendant is applying it. We have touched upon this question before, but a more extended consideration of it may be advisable. To answer the question of whether the defendant's use of the complainant's trade-mark is such an unlawful use that it should be restrained, "the extent of the owner's property in a trade-mark, and the character of the act which is held to injuriously affect his property rights, and to call for the interposition of a court of equity, must be ascertained. . . . The deceit of the public and the subsequent injury to it are as much to be regarded by a court of equity as an injury to a plaintiff's business. It therefore follows that the right of an owner of a trade-mark is not a right to its exclusive use everywhere and under all circumstances."<sup>1</sup> Thus, an iron manufacturer using a lion's head as his trade-mark cannot enjoin a linen manufacturer from using a lion's head as his mark.<sup>2</sup> It was held that "Fruit Salt" as a trade-mark for an effervescing drink, a registered mark, might be interfered with by the words "Fruit Salt" designating a baking powder. In this case it was shown that the "Fruit Salt" used in producing the effervescing drink had been used as a baking powder, in exceptional cases; but the court remarked that if it were proposed to so employ the words "Fruit Salt" that "no reasonable person could suppose that they had reference to the appellant's preparation, such a use would be perfectly unobjectionable. For example, I cannot conceive any one imagining that a "Fruit Salt Umbrella" was in any way connected with the article manufactured by Mr. Eno (the effervescing drink)."<sup>3</sup> So it has been held in this country that the word "Celluloid" is a valid trade-mark as applied to articles actually composed of celluloid,<sup>4</sup> but

<sup>1</sup>Shipman, J., in *Celluloid Mfg. Co. v. Read*, 47 Fed. Rep. 712-714.

<sup>2</sup>*Ainsworth v. Walmsley*, 35 L. J. Ch. 352.

<sup>3</sup>*Lord Herschell in Eno v. Dunn*, L. R. 15 App. Cas. 252-260.

<sup>4</sup>*Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. Rep. 94.

that the use of the word "Celluloid" to designate a starch is not an infringement, because celluloid had never been used in making starch and there was no testimony to show that the plaintiff had intended ever to use it in making starch. There was expert testimony to the effect that it was highly probable that a method might be devised by which celluloid could be converted into a starch-like body fit for use as a substitute for starch, but the court held this statement of probabilities "too indefinite to be the foundation of an injunction."<sup>1</sup> The whole question depends upon how closely related are the classes of goods to which the complainant and respondent apply the mark.<sup>2</sup>

The other defenses, beside those thus far indicated, such as license from the owner or his co-proprietor in the mark, delay, acquiescence or abandonment, have been treated in connection with the defenses at law. But it is proper to note here that where the complainant has been guilty of serious laches his relief will be limited to the injunction, and an accounting will be refused.<sup>3</sup>

Where the bill of complaint makes profert of the plaintiff's trade-mark and exhibits the alleged infringement, a demurrer will be sustained if an inspection of the exhibits satisfies the court that there is no infringement.<sup>4</sup>

But the courts are not inclined to sustain demurrers upon the ground that the plaintiff's mark is not a valid technical trade-mark, where the bill contains the specific charge that the defendant has, by its conduct in the premises, deceived and misled the public into buying its goods as and for the plaintiff's goods.<sup>5</sup> A defect upon the face of the bill, such as a failure to show a title to

<sup>1</sup>Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712-716.

<sup>2</sup>Collins Co. v. Ames, 20 Blatchf. 542; 18 Fed. Rep. 561; Amoskeag Mfg. Co. v. Garner, 54 How. Pr. 297; Carroll v. Ertheiler, 1 Fed. Rep. 688; Hecht v. Porter, 9 Pac. C. L. J. 569; Osgood v. Rockwood, 11 Blatchf. 310; Smith v. Reynolds, 10 Blatchf. 100; 13 Blatchf. 458.

<sup>3</sup>Holt v. Menendez, 23 Fed. Rep. 869-871.

<sup>4</sup>Collins Chemical Co. v. Capital City Mfg. Co., 42 Fed. Rep. 64.

<sup>5</sup>Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800.

the mark in a complainant, must be met by demurrer and cannot be raised by a plea.<sup>1</sup>

There are a number of lines of defense which have been ineffective. Among them are to be particularly noted the following:

- A. Infancy.<sup>2</sup>
- B. The registration of defendant's mark, because registration is only *prima facie* evidence of ownership.<sup>3</sup>
- C. Laches or delay, except in unusual cases.<sup>4</sup>
- D. Showing that defendant always placed his own address upon his goods, in conjunction with the infringing mark.<sup>5</sup>
- E. Showing that defendant has always used his own name or initials in conjunction with the infringing mark. This is not, of itself, a good defense.<sup>6</sup>
- F. Showing that defendant has always used the word "Improved" in addition to the alleged infringing words.<sup>7</sup>
- G. Showing that the defendant's goods are not inferior in quality to the complainant's.<sup>8</sup>

<sup>1</sup>Hostetter Co. v. E. G. Lyons Co., 99 Fed. Rep. 734.

<sup>2</sup>Chubb v. Griffiths, 35 Beav. 127.

<sup>3</sup>Glen Cove Mfg. Co. v. Ludeling (or Ludeman), 22 Fed. Rep. 823; 23 Blatchf. 46; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206, 209, 212.

<sup>4</sup>McLean v. Fleming, 96 U. S. 245; Lee v. Haley, L. R. 5 Ch. App. 155. See *ante*, § 57.

<sup>5</sup>Gray v. Taper-Sleeve Pulley Works, 16 Fed. Rep. 436-442.

<sup>6</sup>Menendez v. Holt, 128 U. S. 521; Battle v. Finlay, 50 Fed. Rep. 106; N. K. Fairbank Co. v. Central Lard Co., 70 Off. Gaz. 635; 64 Fed. Rep. 133; Boardman v. Meriden Britannia Co., 35 Conn. 402; Hier v. Abrahams, 82 N. Y. 519; Fleischmann v. Schuckmann, 62 How. Pr. 92; Lea v. Wolff, 15 Abb. Pr. N. S. 1; Carroll v. Ertheiler, 1 Fed. Rep. 388; Hegeman v. O'Byrne, 9 Daly, 264; Pratt's Appeal, 117 Pa. St. 401; Walter Baker & Co. v. Baker, 87 Fed. Rep. 209; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206-210; Leonard v. White's Golden Lubricator Co., 38 Fed. Rep. 922.

<sup>7</sup>Russia Cement Co. v. LePage, 147 Mass. 206; Gage v. Canada Pub. Co., 11 Can. S. C. R. 306; Improved Fig Syrup Co. v. California Fig Syrup Co., 54 Fed. Rep. 175; 4 C. C. A. 264.

<sup>8</sup>Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-436; Taylor v. Carpenter (3), 11 Paige, 292; Coats v. Holbrook, 2 Sandf. Ch. 586;

- H. Showing that the goods sold are goods made by the complainant, if they are goods to which the complainant did not intend the mark to be applied.<sup>1</sup>
- I. Showing that the defendant did not intend to sell the goods bearing the infringing mark.<sup>2</sup>
- J. Showing that the complainant's mark has been used by others without his knowledge, consent or acquiescence.<sup>3</sup>
- K. Showing that the same mark has been used by others on goods of another class.<sup>4</sup>
- L. Showing that a third person used the trade-mark prior to its appropriation by the complainant, when that third person has been refused relief in equity against infringers, because of fraudulent representations made by him in using the mark.<sup>5</sup>
- M. Showing that the infringing act was done by the defendant's servants, agents or employees without his knowledge.<sup>6</sup>

*Partridge v. Menck*, 2 Sandf. Ch. 622; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Shaver v. Shaver*, 54 Iowa, 203; *Coffeen v. Brunton*, 5 McLean, 256; *Gillott v. Esterbrook*, 47 Barb. 455; 48 N. Y. 374; *Singer Mfg. Co. v. Loog* (3), L. R. 8 App. Cas. 15; *Edelsten v. Edelsten*, 1 DeG. J. & S. 185; *Blofield v. Payne*, 4 B. & Ad. 410.

<sup>1</sup>*Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225; *Gillott v. Kettle*, 3 Duer, 624; *Hennessy v. Kennett*, Seb. 556.

<sup>2</sup>*Upmann v. Forester*, L. R. 24 Ch. D. 231; *Upmann v. Curry*, 29 Sol. J. 735.

<sup>3</sup>*Cuervo v. Jacob Henkell Co.*, 50 Fed. Rep. 471; *Filley v. Fassett*, 44 Mo. 173; *Cox*, 530; *Taylor v. Carpenter* (1), 3 Story, 453; *Cox*, 14; Seb. 78; *Ford v. Foster*, L. R. 7 Ch. App. 611.

<sup>4</sup>*Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. Rep. 94; *Colman v. Crump*, 70 N. Y. 573; *Hegeman v. O'Byrne*, 9 Daly, 264; *Somerville v. Schembri*, L. R. 12 App. Cas. 453-457; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Hall v. Barrows*, 4 DeG. J. & S. 150; *George v. Smith*, 52 Fed. Rep. 830.

<sup>5</sup>*Parlett v. Guggenheimer*, 67 Md. 542-544. The rights of the third party had been so adjudicated in *Palmer v. Harris*, 60 Pa. St. 156.

<sup>6</sup>*Low v. Hart*, 90 N. Y. 457; *Twentsche Stoom Bleekery Goor v. Ellinger*, 26 W. R. 70; *Tonge v. Ward*, 21 L. T. N. S. 480; *Atkinson v. Atkinson*, 85 L. T. Jour. 229. But see *Leahy v. Glover*, 10 R. P. C. 141, where a single sale by defendant's clerk was held insufficient to warrant injunction.

- N. Showing that defendant partners have incorporated after the institution of the suit.<sup>1</sup>
- O. Showing that the complainant gave the defendant no notice of his intention to bring suit.<sup>2</sup>
- P. Showing that a proper name alleged to be an infringement is the name of a person connected with defendant's business, when in fact such person has only given defendant permission to use his name as a means of attracting trade from the complainant, in pursuance of defendant's scheme to fraudulently take away complainant's business.<sup>3</sup>
- Q. Showing that plaintiff has added words, figures or designs, such as a coat-of-arms, to the trade-mark as registered.<sup>4</sup>
- R. Showing that the complainant's trade-mark or package is only partially copied or imitated in defendant's mark or package.<sup>5</sup>

<sup>1</sup>American Fibre Chamois Co. v. De Lee, 67 Fed. Rep. 329.

<sup>2</sup>Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Sawyer v. Kellogg, 9 Fed. Rep. 601-602; Upmann v. Forester, L. R. 24 Ch. D. 231-235; Cartmell, 331; Upmann v. Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130; Burgess v. Hately, 26 Beav. 249; Seb. 169; Field v. Lewis, Seton (4th ed.), 237; Seb. 280; Re Kuhn, 53 L. J. Ch. 238; Barrett v. Goom, 74 L. T. Jour. 388; Fennessy v. Day, 55 L. T. N. S. 161; Siegert v. Lawrence, 11 Vic. L. R. 47. See, *contra*, Wallis v. Wallis, 4 Dr. 458; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Chappell v. Davidson, 2 K. & J. 123; Williams v. Osborne, 13 L. T. N. S. 498; Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co., 92 Fed. Rep. 774-778.

<sup>3</sup>Sawyer v. Kellogg, 7 Fed. Rep. 720; Price & Steuart, 493; 9 Fed. Rep. 601; Rogers Mfg. Co. v. Rogers Mfg. Co., 11 Fed. Rep. 495; Williams v. Brooks, 50 Conn. 278; Meriden Britannia Co. v. Parker, 39 Conn. 450; 12 Am. Rep. 401; Garrett v. T. H. Garrett & Co., 78 Fed. Rep. 472; Phalon v. Wright, 5 Phila. 464; Cox, 307; Wolfe v. Barnett, 24 La. Ann. 97; 13 Am. Rep. 111; Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Perks v. Hall, W. N. 1881, p. 111; Williams v. Johnson, 2 Bos. 1.

<sup>4</sup>Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Newman v. Pinto, 4 R. P. C. 508; 57 L. T. N. S. 31; Cartmell, 242; Carroll v. Ertheiler, 1 Fed. Rep. 688-691.

<sup>5</sup>McCann v. Anthony, 21 Mo. App. 83; Enoch Morgan's Sons Co. v. Edler, Cox, Manual, 714; Taendsticksfabriks Aktiebolaget Vulcan v. Myers, 139 N. Y. 364; Pillsbury v. Pillsbury-Washburn Mills Co., 64 Fed. Rep. 841; Centaur Co. v. Killenberger, 87 Fed. Rep. 725.



- S. Showing that complainant has been guilty of misrepresentation in connection with his use of the trade-mark, where that misrepresentation consists only in harmless exaggeration of the merits of his product (puffing);<sup>1</sup> or in purely collateral representation, as by newspaper advertising;<sup>2</sup> or in regard to the size of packages used by him, where the sizes of those packages are the ordinary sizes known to the trade, the capacity of which is generally understood.<sup>3</sup>
- T. Showing that the infringement has ceased.<sup>4</sup>
- U. Showing that the complainant has made a third party his licensee for the territory in which the infringement was committed.<sup>5</sup>
- V. Showing that the defendant has made no sales of goods bearing the infringing mark, where it appears that he would have done so had the suit not been instituted.<sup>6</sup>
- W. Showing that the defendant is merely a dealer who has purchased from the originator of the infringement,<sup>7</sup> or merely the agent of another in the sale of the infringing goods.<sup>8</sup>
- X. Showing that the defendant once held a license from the plaintiff, permitting the use of the mark, when that license has been revoked for failure to pay royalties and other breaches of the licensing contract.<sup>9</sup>

<sup>1</sup>Comstock v. White, 18 How. Pr. 421; Cox, 232; Metzler v. Wood, L. R. 8 Ch. D. 606; Seb. 587; Holloway v. Holloway, 13 Beav. 209; Seb. 106; Ellis v. Zeilen, 42 Ga. 91.

<sup>2</sup>Curtis v. Bryan, 36 How. Pr. 33; 2 Daly, 212; Cox, 434; Seb. 291.

<sup>3</sup>Hennessy v. Wheeler, 51 How. Pr. 457; 69 N. Y. 271; 15 Alb. L. J. 454; Seb. 483.

<sup>4</sup>Frese v. Bachof, 13 Blatchf. 234; Burnett v. Hahn, 88 Fed. Rep. 694; Hutchinson v. Blumberg, 51 Fed. Rep. 829-831.

<sup>5</sup>Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205.

<sup>6</sup>Cuervo v. Landauer, 63 Fed. Rep. 1003.

<sup>7</sup>Burnett v. Hahn, 88 Fed. Rep. 694.

<sup>8</sup>Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889.

<sup>9</sup>Martha Washington Creamery Buttered Flour Co. v. Martien, 44 Fed. Rep. 473.

Y. Showing that there has been an adjudication against the plaintiff in a court of a foreign country. The subject-matter, in cases of the classes treated in this work, is a tort. Such subjects are not concluded by foreign adjudications, even when the acts referred to are the same identical acts.<sup>1</sup>

§ 116. **The relief in equity.**—In regard to making an application for a preliminary injunction in cases of unfair trade or trade-mark infringement, it should be remembered that wherever there is any doubt as to the plaintiff's right or the defendant's infringement, the application *pendente lite* will be denied.<sup>2</sup> Accordingly the courts have refused to grant the preliminary injunction where it appeared probable that the plaintiff had never acquired the exclusive right to use the mark, but held it as a tenant in common with another;<sup>3</sup> where there existed a doubt whether the words claimed as trade-marks by the plaintiff ("Pile Leclancha" and "Disque," applied to electric batteries) were or were not merely descriptive words;<sup>4</sup> where the facts indicated that the complainant was possibly guilty of laches;<sup>5</sup> and where the defendant's affidavits created a doubt in the mind of the court

<sup>1</sup>Hohner v. Gratz, 50 Fed. Rep. 369; City of Carlsbad v. Kutnow, 68 Fed. Rep. 794.

<sup>2</sup>"An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question it is at times an appropriate remedy in the prevention of great wrong, but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and generally, where the injury may be measured in money, the alleged wrong-doer should be shown to be unable pecuniarily to respond." Jenkins, J., in American Cereal Co. v. Eli Pettijohn Cereal Co., 76 Fed. Rep. 372-374.

In refusing to grant a preliminary injunction Mr. Justice Bradley, on circuit, said: "My great reluctance to grant a preliminary injunction for suppressing the use of a business name or trade-mark, in

<sup>3</sup>American Cereal Co. v. Eli Pettijohn Cereal Co., 76 Fed. Rep. 372.

<sup>4</sup>Leclancha Battery Co. v. Western Electric Co., 21 Fed. Rep. 538. Same of "air-cell" and "fire-board" applied to fire-proofing material. New York Asbestos Mfg. Co. v. Amber Asbestos Air-cell Covering Co., 99 Fed. Rep. 85.

<sup>5</sup>Estes v. Worthington, 22 Fed. Rep. 822.

as to whether the plaintiff had been the exclusive user of the symbols claimed by him as his trade-mark.<sup>1</sup> A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case.<sup>2</sup> A mandatory injunction pending the suit is not granted except in extreme cases where the right thereto is clearly established and it appears that irreparable injury will follow from its refusal.<sup>3</sup>

So when the court has reason to doubt that the defendant has been guilty of acts amounting to an invasion of the plaintiff's trade rights, a preliminary injunction will not be issued.<sup>4</sup> But while refusing the interlocutory injunction, the court may, in its discretion, require the defendant to keep an account, pending the suit, of all his dealings in goods bearing the alleged infringing mark; as Judge Treat said in making such an order: "It will not hurt him to keep an account."<sup>5</sup>

It is sufficient to sustain the application for the preliminary injunction (so far as the plaintiff's title to the mark is concerned) if he has established his right to the trade-mark in a former proceeding.<sup>6</sup> While the decision in such former proceeding is not conclusive and binding upon the court in the later case, it is persuasive and of great weight, and on the motion for a preliminary injunction, especially where it sustains the impression of

any case in which the matter in issue is a subject for fair discussion, induces me to withhold the order." *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. Rep. 94-102. And to the same effect see *Van Camp Packing Co. v. Cruikshanks Bros. Co.*, 90 Fed. Rep. 814; 33 C. C. A. 280; *Charles E. Hires Co. v. Consumers' Co.*, 100 Fed. Rep. 899-813; *Goldstein v. Whelan*, 62 Fed. Rep. 124.

<sup>1</sup>*French v. Alter & Julian Co.*, 74 Fed. Rep. 788; *Leclancha Battery Co. v. Western Electric Co.*, 21 Fed. Rep. 533; *Portuondo v. Monne*, 28 Fed. Rep. 16; *Davis v. Davis*, 27 Fed. Rep. 490.

<sup>2</sup>*New York Asbestos Mfg. Co. v. Amber Asbestos Air-cell Covering Co.*, 99 Fed. Rep. 85; *Lare v. Harper & Bros.*, 86 Fed. Rep. 481; 30 C. C. A. 373.

<sup>3</sup>*Hagen v. Beth*, 118 Cal. 330.

<sup>4</sup>*Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44.

<sup>5</sup>*Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44.

<sup>6</sup>*Symonds v. Greene*, 28 Fed. Rep. 834, 835; *Moxie Nerve Food Co. v. Beach*, 33 Fed. Rep. 248.

the court upon the hearing, is decisive.<sup>1</sup> Where a demurrer is interposed to the bill, upon the application for preliminary injunction, the allegations of fraud in the bill are confessed thereby; and if the demurrer is overruled the complainant is entitled to the preliminary injunction.<sup>2</sup>

It is a fundamental principle in the law of unfair trade, as well as in patent law, that where the infringement is admitted or proven the plaintiff is entitled to a reference for an accounting as a matter of right.<sup>3</sup> But "cases frequently arise where a court of equity will refuse the prayer of the complainant for an account of gains and profits, on the ground of delay in asserting his rights, even when the facts proved render it proper to grant an injunction to prevent future infringement."<sup>4</sup>

"In England the rule is stringent in trade-mark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant."<sup>5</sup>

It is now the rule in England, as we have seen in our discussion of the question of damages at law, that upon the injunction being entered in the action in equity the complainant is compelled to elect between profits and damages; he cannot have both. If he elects to take his

<sup>1</sup>Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799.

<sup>2</sup>Enoch Morgan's Sons Co. v. Hunkele, 16 Off. Gaz. 1092, 1093.

<sup>3</sup>Oakes v. Tonsmierre, 49 Fed. Rep. 447-453; Campbell Printing Press Co. v. Manhattan R. Co., 49 Fed. Rep. 930-932; Fisk v. Mahler, 54 Fed. Rep. 528.

<sup>4</sup>Mr. Justice Clifford in McLean v. Fleming, 96 U. S. 245-257. To the same effect see Low v. Fels, 35 Fed. Rep. 361-363.

<sup>5</sup>Nixon, J., in Sawyer v. Kellogg, 9 Fed. Rep. 701.

damages, the issue is sent to the Queen's Bench division to be tried by a jury.<sup>1</sup> In our federal courts, however, there is no provision for transferring the case from the equity side to the law side after the entry of the interlocutory decree, nor any other provision for submitting the issue of damages, in an equity case, to a jury. The plaintiff is not compelled to elect between profits and damages, but the reference is made to the master in chancery to take an account of the defendant's profits and to make an assessment of the damages sustained by the plaintiff.<sup>2</sup> In assessing damages the master will consider the extent to which plaintiff's sales have fallen off, if the defendant's acts are the cause of such falling off.<sup>3</sup>

It was held in one case that the profits due to the use of the trade-mark only were the subject of inquiry.<sup>4</sup> But this was clear error, and the court laying down this rule cited in support of it only one precedent and that a patent case.<sup>5</sup> This question was considered very carefully by the supreme court of California, and its conclusion is as follows: "Every consideration of reason, justice and sound policy demands that one who fraudulently uses the trade-mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade-mark, on the plea that it is impossible to determine how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity." The supreme court held, therefore, that the trial court had not erred in awarding the plaintiff the whole profit made by the defendant.<sup>6</sup> In treating the same subject, Judge Sawyer said: "To adopt as the measure of compensation for such injuries the difference between the price for which the spurious goods would

<sup>1</sup>Fennessy v. Rabbits, 56 L. T. 138; Cartmell, 125.

<sup>2</sup>The Collins Co. v. Oliver Ames & Son Corporation, 18 Fed. Rep. 561-571; Benkert v. Feder, 34 Fed. Rep. 534, 535; Sawyer v. Kellogg, 9 Fed. Rep. 601, 602; Sawyer v. Horn, 1 Fed. Rep. 24-39.

<sup>3</sup>Hostetter v. Vowinkle, Fed. Case No. 6714; 1 Dill. 329; Cox, Manual, No. 207.

<sup>4</sup>Atlantic Milling Co. v. Rowland, 27 Fed. Rep. 241.

<sup>5</sup>Garretson v. Clark, 111 U. S. 120.

<sup>6</sup>Graham v. Plate, 40 Cal. 593-599.

sell without the trade-mark and for which they would sell with it imprinted thereon, would be a mockery of justice. In my judgment the infringer should at least account for the entire profits made upon the goods wrongfully sold with the trade-mark impressed upon them.”<sup>1</sup> This now appears to be the accepted rule. Punitive damages cannot be assessed in equity.<sup>2</sup>

Where the defendant carried on the infringing traffic in connection with his regular business, the master in chancery will not make any deduction for expenses in taking the account of profits.<sup>3</sup>

In jurisdictions where the master is permitted to assess damages, he may do so even in the absence of any direct proof of loss of profit.<sup>4</sup> As all participants in torts are principals, one who participates in unfair trade by furnishing fraudulent labels is liable in equity to the party injured for the whole damage resulting from the unfair competition.<sup>5</sup>

The United States circuit courts of appeals will review the action of the circuit courts in granting or refusing preliminary injunctions, for the purpose of reviewing the discretion of the court below and correcting error in its exercise. In a proper case it will enlarge the scope of a preliminary injunction which falls short of protecting the complainant's rights.<sup>6</sup>

<sup>1</sup>Benkert v. Feder, 34 Fed. Rep. 534.

<sup>2</sup>Hennessy v. Wilmerding-Loewe Co., 103 Fed. Rep. 90.

<sup>3</sup>Société Anonyme v. Western Distilling Co., 46 Fed. Rep. 921.

<sup>4</sup>Thus in a chancery case in New Zealand the court said: “First as to damages, I am of opinion that there has been no direct proof of loss of profit by Messrs. Littlejohn & Son, consequent upon the sale of the watches which improperly have their name inscribed upon them, but, as I have intimated during the course of the argument, it appears to me that, apart from any direct proof of loss of profit, there arises in cases of this class an inference of possible damage to the manufacturer whose name is improperly used—damage to his well established reputation. It is impossible that the quantum of damage in cases of this class can be mathematically ascertained; no account can possibly reach such a matter. It must always be a matter of discretion for the court and jury.” Littlejohn v. Mulligan, 3 New Zealand Rep. 446.

<sup>5</sup>Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

<sup>6</sup>Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-813.

## CHAPTER XIV.

### MATTERS OF PRACTICE AND EVIDENCE.

§ 117. **Matters of which courts will take judicial notice.**—This subject is of practical importance in the trial of trade-mark causes. The courts of the United States will take judicial notice of the statutes of the several states,<sup>1</sup> and of the decisions of the state courts upon the constitutionality of such statutes.<sup>2</sup> All courts will take judicial notice of the treaties or conventions with a foreign government or power.<sup>3</sup> It has been expressly held that judicial notice will be taken of the convention concerning trade-marks, of April 16, 1869, between the United States and France.<sup>4</sup> As in other classes of cases, the courts take judicial notice of political facts, legal facts, official facts, public history, natural history and the vernacular language, and all matters of common and ordinary knowledge, including matters of science.

§ 118. **Expert evidence on the question of infringement.**—Inspection by the court is the main, and indeed the final, test of the alleged resemblance in trade-mark cases.<sup>5</sup> The courts, as a rule, give little weight to expert testimony on questions of similitude.<sup>6</sup>

<sup>1</sup>Re Jordan, 49 Fed. Rep. 238; Gormley v. Bunyan, 138 U. S. 623.

<sup>2</sup>Knox v. Columbia Liberty Iron Co., 42 Fed. Rep. 378.

<sup>3</sup>Ex parte McCabe, 46 Fed. Rep. 363.

<sup>4</sup>La Croix v. Sarrazzin, 15 Fed. Rep. 489.

<sup>5</sup>Von Mumin v. Frash, 56 Fed. Rep. 830-838; Filley v. Fassett, 44 Mo. 173; Gail v. Wackerbarth, 28 Fed. Rep. 286; Drummond v. Addison-Tinsley Tob. Co., 52 Mo. App. 10; Collins Chemical Co. v. Capitol City Mfg. Co., 42 Fed. Rep. 64; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; Joseph Dixon Crucible Co. v. Benham, 4 Fed. Rep. 527.

<sup>6</sup>Cook v. Starkweather, 13 Abb. Pr. N. S. 392; Popham v. Wilcox, 66 N. Y. 69; Re Jelley, Son & Jones, 51 L. J. Ch. 639; Radam v. Destroyer Co., 81 Texas, 122; 16 S. W. Rep. 990; P. Lorillard Co. v. Peper, 86 Fed. Rep. 956.

Lord Esher, Master of the Rolls, has tersely said: "If a man was

Testimony of skilled witnesses to the effect that in their opinion the public is likely to be deceived by the similarity of two trade-marks, although valuable in a doubtful case,<sup>1</sup> is not of itself sufficient evidence of infringement.<sup>2</sup> When technical trade or scientific questions are involved, however, expert evidence is highly desirable,<sup>3</sup> and especially when the probability of the ultimate consumer being deceived by the defendant's goods rests on the character and habits of the people who use the product,<sup>4</sup> or the manner in which the goods are usually sold or exhibited by the retailer.<sup>5</sup>

Where the complainant's case rested on the testimony of hired witnesses that they had drunk bitters sold them by the defendant in his saloon as being complainant's bitters and that said bitters were imitation, the bill was dismissed on the conflicting testimony offered in defense, the court remarking that hired witnesses are not disinterested and their testimony for that reason should be scrutinized with unusual caution.<sup>6</sup> In dismissing a bill

to come and tell me that a horse was like a cat, he might swear it, and you might get fifty persons to swear it, but I should not act on such evidence, because it is pure nonsense." *Re Christiansen*, 3 R. P. C. 54-61.

<sup>1</sup>*Celluloid Mfg. Co. v. Read*, 47 Fed. Rep. 712-716.

<sup>2</sup>*Columbia Mill Co. v. Alcorn*, 40 Fed. Rep. 676; *Cope v. Evans*, L. R. 18 Eq. 138. But in one case such evidence was admitted and approved (*Williams v. Brooks*, 50 Conn. 478; 47 Am. Rep. 642), while in another its propriety was questioned (*Radam v. Capital Microbe Destroyer Co.*, 81 Texas, 122; 26 Am. St. Rep. 783).

<sup>3</sup>*Mitchell v. Henry*, L. R. 15 Ch. D. 181; 43 L. T. 186; *Cartmell*, 227; *Re Worthington*, 14 Ch. D. 8; 49 L. J. Ch. 646; *Cartmell*, 351; *Re Christiansen*, 3 R. P. C. 54; *Cartmell*, 95; *Gorham Co. v. White*, 14 Wall. 511; *Williams v. Brooks*, 50 Conn. 278; *Price & Steuart*, 654; *Celluloid Mfg. Co. v. Read*, 47 Fed. Rep. 712-716.

<sup>4</sup>*Drummond v. Addison-Tinsley Tob. Co.*, 52 Mo. App. 10; *Sperry v. Percival Milling Co.*, 81 Cal. 252-260.

<sup>5</sup>*Re Worthington*, L. R. 14 Ch. D. 8.

<sup>6</sup>*Hostetter Co. v. Bower*, 74 Fed. Rep. 235. The quantity of proof adduced, and its weight, necessarily must be fixed by the attendant circumstances of each case. Thus, in one case it was held that a single sale of the infringing article by the defendant's clerk was insufficient to warrant injunction. *Leahy v. Glover*, 10 R. P. C. 141. And in a patent case it was held that a single sale was not *per se* an



in which a defendant was charged with refilling genuine packages, where the evidence was conflicting, Judge Coxe remarked that "the burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."<sup>1</sup>

*Expert testimony on other issues.*—A witness familiar with the trade may testify to the catch-word or other peculiar designation by which an article is known to the trade,<sup>2</sup> or to consumers;<sup>3</sup> and of course other witnesses similarly qualified may testify to the contrary.<sup>4</sup>

Testimony of witnesses properly qualified is admissible to show that owing to the defendant's infringement, plaintiff's sales have fallen off; this is true both at law<sup>5</sup> and in equity.<sup>6</sup> In the action at law it is competent for the plaintiff's proof to show that his sales fell off concurrently with the defendant's infringement, from which the jury may infer that the falling off was the result of the defendant's acts.<sup>7</sup>

§ 119. **Exhibits.**—It is particularly desirable that the conflicting marks be at all times easily accessible to the court, and that they be filed as exhibits whenever possible. The practice of the courts of several states does not permit exhibits, other than documentary, to be filed as exhibits, as no provision has been made for their accommodation and safe-keeping. In Missouri, where this condition prevails, the St. Louis court of appeals has

infringement. *Byam v. Bullard*, 1 Curt. 100; Fed. Case No. 2262. But evidence of a single sale "may, in connection with other proof, be persuasive evidence of other sales, and convincing proof of an intention to sell whenever the opportunity of doing so without detection is presented." *Lacombe, J., in Lever Bros. (Ltd.) v. Pasfield*, 88 Fed. Rep. 484. Citing *De Florez v. Reynolds*, 14 Blatchf. 505.

<sup>1</sup>*Hostetter Co. v. Comerford*, 97 Fed. Rep. 585.

<sup>2</sup>*Pollen v. LeRoy*, 30 N. Y. 549-561.

<sup>3</sup>*Johnson & Johnson v. Bauer & Black*, 82 Fed. Rep. 662; *Read v. Richardson*, 45 L. T. N. S. 54; *Cox, Manual*, No. 698.

<sup>4</sup>*Wilkinson v. Greely*, Fed. Case No. 17671; 1 Curt. 63.

<sup>5</sup>*Shaw v. Pilling*, 175 Pa. St. 78-84; 34 Atl. Rep. 446.

<sup>6</sup>*Hostetter v. Vowinkle*, Fed. Case No. 6714; 1 Dill. 329; *Cox, Manual*, No. 207.

<sup>7</sup>*Shaw v. Pilling*, *supra*.

recommended the preservation of the brands or labels as a part of the record on appeal.<sup>1</sup>

The federal courts, however, afford every facility required for the care of exhibits, and the following rule is in effect in all the federal circuit courts of appeals:

"1. Models, diagrams and exhibits of material forming part of the evidence taken in the court below, in any case pending in this court on writ of error or appeal, shall be placed in the custody of the marshal of this court at least ten days before the case is heard or submitted.

"2. All models, diagrams and exhibits of material placed in the custody of the marshal for the inspection of the court on the hearing of a case must be taken away by the parties within one month after the case is decided. When this is not done, it shall be the duty of the marshal to notify the counsel in the case, by mail or otherwise, of the requirements of this rule, and, if the articles are not removed within a reasonable time after notice is given, he shall destroy them or make such other disposition of them as to him may seem best."<sup>2</sup>

§ 120. **Discovery.**—The resistance of discovery is usually met with by complainants in trade-mark causes.

Lord Romilly compelled a defendant to make a full discovery of all his sales, the prices, profits realized and the names of the purchasers, notwithstanding the objection of the defendant that he would thereby disclose his business secrets;<sup>3</sup> and full discovery has been compelled in other cases.<sup>4</sup> The power to compel discovery is inherent in equity, but is not vested in courts of law in the absence of statutory enactment.<sup>5</sup>

In actions at law production of books and papers is fully provided for, in federal practice, by section 724 of

<sup>1</sup>Alden v. Gross, 25 Mo. App. 123.

<sup>2</sup>The above rule is numbered rule 34 in each court of appeals but that of the seventh circuit, where it is numbered rule 32.

<sup>3</sup>Howe v. McKernan, 30 Beav. 547.

<sup>4</sup>Leather Cloth Co. v. Hirschfeld (2), 1 H. & M. 295; Seb. 224; Orr v. Diaper, L. R. 4 Ch. D. 92; 46 L. J. Ch. 41; Seb. 519.

<sup>5</sup>Colgate v. Compagnie Francaise, 23 Fed. Rep. 82-85.

the Revised Statutes. It has been held that inspection of books or writings may be ordered to be made before the trial.<sup>1</sup> Its provisions, when affording an adequate remedy, preclude resorting to equity to compel discovery,<sup>2</sup> and render the issuance of *subpoena duces tecum* unnecessary.<sup>3</sup>

In equitable proceedings discovery will not be enforced when it may tend to incriminate the person against whom discovery is sought;<sup>4</sup> and the same rule applies to the enforced production of books and papers by such person.<sup>5</sup>

Subject to this restriction discovery of material facts will be compelled.<sup>6</sup>

When a defendant professes to answer, he must answer fully. If he desires protection against discovery he must seek such protection by plea.<sup>7</sup>

**§ 121. Evidence of recognition by others of plaintiff's right to the mark.**—The rule is well settled that a former adjudication establishing a trade-mark, where there has been an adjudication after a *bona fide* contest on the merits, and the same issues were presented as in the later suit, is of persuasive if not binding force in a later case.<sup>8</sup> But a mere showing that the claimant of the trade-mark has by threats of legal prosecu-

<sup>1</sup>Lucker v. Phoenix Assurance Co., 67 Fed. Rep. 18; Exchange Bank v. Wichita Cattle Co., 61 Fed. Rep. 190; United States v. National Lead Co., 75 Fed. Rep. 94.

<sup>2</sup>Washburn & Moen Mfg. Co. v. Freeman Wire Co., 41 Fed. Rep. 410; Paton v. Majors, 46 Fed. Rep. 210. But see Colgate v. Compagnie Francaise, 23 Fed. Rep. 82.

<sup>3</sup>Kirkpatrick v. Pope Mfg. Co., 61 Fed. Rep. 46.

<sup>4</sup>Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

<sup>5</sup>Ibid. See also Union Paper Collar Co. v. Metropolitan Collar Co. (Ltd.), 3 Daly, 171.

<sup>6</sup>Benbow v. Low, L. R. 16 Ch. D. 93; Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

<sup>7</sup>Howe v. McKernan, 30 Beav. 547; Slater v. Banwell, 50 Fed. Rep. 150.

<sup>8</sup>Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; Symonds v. Greene, 28 Fed. Rep. 834; La Republique Francaise v. Saratoga Vichy Springs Co., 99 Fed. Rep. 733. But a decision of the English high court of chancery adverse to the claimant of a mark is not a bar to a suit for infringement of the mark brought in the United States. City of Carlsbad v. Kutnow, 68 Fed. Rep. 794. And to the same effect see Hohner v. Gratz, 50 Fed. Rep. 369.

tion compelled or induced others to enter into undertakings to desist from the use of the name, or that others have submitted to injunctions without a contest, is very slight, if any, evidence of the plaintiff's right to use the mark. In a recent case before the House of Lords, Lord Davey said in regard to evidence of cases in which other persons had submitted to injunctions and had paid the costs: "That does not appear to me to be very strong evidence in favor of the pursuers. Of course, a shop-keeper or a person in that position would hesitate a long time before he incurred the expense, which in the case of a trade-mark or in a patent case is not slight, of defending an action of this character; probably the value to him of the trade he would lose would not in any way compensate for the risk he would incur. Therefore, as evidence of the fact, I do not attach much importance to those cases."<sup>1</sup> An interlocutory decree of one court appears to be entitled to but little weight in a proceeding before another.<sup>2</sup>

**§ 122. Contempts.**—It has been held that a plaintiff who circulates matter prejudicial to the defense of a pending action for trade-mark infringement is guilty of a contempt,<sup>3</sup> as has also been held of a plaintiff who published a false and perverted construction of the purpose and effect of an injunction.<sup>4</sup>

By far the greater number of applications to commit for contempt in the class of cases under consideration are based upon the failure of the party enjoined to comply with the injunctive decree. Where no attempt has been made toward compliance with the decretal order, the respondent is, of course, in contempt and liable to commitment, like any other contemnor.<sup>5</sup> But where some effort has been made to comply with the order, but to an extent not satisfactory to the complainant, an issue of fact

<sup>1</sup>Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-346.

<sup>2</sup>Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889.

<sup>3</sup>Coats v. Chadwick, L. R. (1894) 1 Ch. D. 347.

<sup>4</sup>Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co., 92 Fed. Rep. 774-779.

<sup>5</sup>Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G. 614.

is raised for the determination of the trial court, and as a rule its findings and judgment will not be reviewed on appeal;<sup>1</sup> and where the contempt proceedings are referred, the court is reluctant to disturb the findings of fact made by the referee.<sup>2</sup>

It is a contempt, after decree, to offer the infringing goods for sale, even though no sale is actually effected;<sup>3</sup> nor does it exempt the defendant from commitment to show that he intended to comply with the decree, if in fact he has not complied with it.<sup>4</sup> But wherever the court determines that the defendant has so altered his marks or packages that there is no longer any danger of the public mistaking his goods for those of the plaintiff, he will be discharged.<sup>5</sup> Where, however, the change is only sufficient to avoid the letter of the decree, and the defendant's mark or package is still calculated to promote deception, under the English practice the injunction may be enlarged upon the hearing of the contempt proceedings so as to cover the new fraud, even though the motion to commit must be refused.<sup>6</sup> The rulings of the courts in this regard have taken a wide range. There have been cases in which the court has declined to commit upon the defendant making an offer to devise such changes in his mark as would meet with the approval of the court,<sup>7</sup> and others where the court has directed the defendant to make such changes with the alternative of being committed.<sup>8</sup> Where an injunction is in part mandatory and in part prohibitive, and the mandatory portion is suspended by an appeal, the court cannot punish the defendant for contempt for the violation of such mandatory portion, although his act is a joint violation of both portions.<sup>9</sup>

<sup>1</sup>Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

<sup>2</sup>Hennessey v. Budde, 82 Fed. Rep. 541.

<sup>3</sup>Marcovitch v. Bramble, Wilkins & Co., Cox, Manual, No. 595.

<sup>4</sup>Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

<sup>5</sup>Swift v. Dey, 4 Robertson, 611; Cox, 319.

<sup>6</sup>Cartier v. May, Cox, Manual, No. 200.

<sup>7</sup>Croft v. Day (2), Cox, Manual, No. 77.

<sup>8</sup>Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G. 614.

<sup>9</sup>Schwarz v. Superior Court, 111 Cal. 106.

The foregoing rulings have been made in unfair trade cases. It would be foreign to our purpose to go into an extended discussion of the law governing contempts, which applies to this as to all other classes of cases. It is well to note, however, that in the federal courts, at least, while proceedings in contempt are not reviewable on error or appeal, they may be reached by *certiorari*.<sup>1</sup>

§ 123. **Affidavits.**—Applications for restraining orders and preliminary injunctions are usually founded upon and resisted by affidavits. A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case.<sup>2</sup> The complainant's affidavits in chief must show all the facts necessary to establish a *prima facie* right to the injunction sought.<sup>3</sup> The defendant's affidavits may be by way of traverse, in which case no counter affidavits can be offered by the complainant; or they may set up matter by way of confession and avoidance, in which case the complainant may produce affidavits in reply. But where such affidavits are offered by the complainant in reply, no further affidavits can be offered by the defendant by way of rejoinder.<sup>4</sup>

All affidavits so used must be entitled in the cause; otherwise they are mere extrajudicial oaths, perjury could not be assigned upon them, and they cannot be considered as evidence.<sup>5</sup>

<sup>1</sup>Re Chetwood, 165 U. S. 443-462; Schwarz v. Superior Court, 111 Cal. 106.

<sup>2</sup>Lare v. Harper & Bros., 86 Fed. Rep. 481; 30 C. C. A. 373; New York Asbestos Mfg. Co. v. Ambler Asbestos Air-cell Covering Co., 99 Fed. Rep. 85.

<sup>3</sup>Leciancha Battery Co. v. Western Electric Co., 21 Fed. Rep. 538.

<sup>4</sup>Day v. New England Car Spring Co., 3 Blatch. 154-159.

<sup>5</sup>Hawley v. Donnelly, 8 Paige, 415; Buerk v. Imhaeuser, Fed. Case No. 2107a; 10 Off. Gaz. 907; Goldstein v. Whelan, 62 Fed. Rep. 124.

## CHAPTER XV.

### COSTS.

§ 124. **Generally.**—In cases of unfair trade the same rules as to costs obtain as in other actions. The general rule is that costs follow the event. A successful plaintiff will be awarded costs,<sup>1</sup> and costs will be refused to one who is unsuccessful.<sup>2</sup>

So costs will be awarded to the successful plaintiff, even though he is denied damages,<sup>3</sup> and against an infant,<sup>4</sup> or a married woman having a separate estate.<sup>5</sup>

§ 125. **Avoiding costs by submission.**—We have had occasion elsewhere to refer to the rule laid down by Sir George Jessel, that the complainant in actions of the character now under consideration should not give notice to the infringer before suit;<sup>6</sup> and it has been held in this country that no demand or notice is necessary.<sup>7</sup> It is of

<sup>1</sup>Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Seb. 79; Pierce v. Franks, 15 L. J. Ch. 122; Seb. 81; Rodgers v. Nowill, 6 Hare, 325; Seb. 82; Burgess v. Hately, 26 Beav. 249; Seb. 169; Burgess v. Hills, 26 Beav. 244; 28 L. J. Ch. 356; Seb. 170; Collins Co. v. Walker, 7 W. R. 222; Seb. 171; Jurgensen v. Alexander, 24 How. Pr. 269; Cox, 298; Seb. 211; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Seb. 213; McAndrews v. Bassett, 4 DeG. J. & S. 380; Seb. 234; Chubb v. Griffiths, 35 Beav. 127; Seb. 255; Field v. Lewis, Seton (4th ed.), 237; Seb. 280; Weed v. Peterson, 12 Abb. Pr. N. S. 178; Seb. 387; Compagnie Laferme v. Hendrick, Seb. 512; Sawyer v. Kellogg, 9 Fed. Rep. 601; Cox, Manual, 682; McLean v. Fleming, 96 U. S. 245; Chappell v. Davidson, 2 K. & J. 123; Seb. 136; Re Kuhn & Co's. Trade-mark, 53 L. J. Ch. 238.

<sup>2</sup>Bass v. Dawber, 19 L. T. N. S. 626; Seb. 310; Appeal of the Putnam Nail Co., Cox, Manual, No. 725; Weener v. Brayton, 152 Mass. 101.

<sup>3</sup>Weed v. Peterson, 13 Abb. Pr. N. S. 178; Seb. 387.

<sup>4</sup>Chubb v. Griffiths, 35 Beav. 127; Seb. 255; Cory v. Gertcken, 2 Madd. 49; Woolf v. Woolf, 43 Sol. J. 127.

<sup>5</sup>Nicholls v. Kimpton, 3 Times L. R. 674.

<sup>6</sup>Upmann v. Forester, L. R. 24 Ch. D. 231.

<sup>7</sup>Sawyer v. Kellogg, 9 Fed. Rep. 601.

the gravest importance to the practitioner to bear this rule in mind, whether he be for the plaintiff or defendant. A failure to observe it will oftentimes involve an innocent and injured client in the payment of costs which would otherwise fall upon the other party; for it is no defense to an assessment of costs against the defendant that no demand was made or notice served before suit.<sup>1</sup> A defendant who makes a full submission will not be mulcted in costs. Thus, a label manufacturer who had innocently made labels upon the order of a customer evaded costs by promising to desist from the manufacture, and offering to surrender the lithograph stone with which the work was done.<sup>2</sup> Lord Romilly, in a leading case in which the defendants were forwarding agents holding as bailee goods bearing a spurious mark, gave the doctrine this succinct expression: "It is his (the defendant's) duty at once to give all the information required, and to undertake that the goods shall not be removed or dealt with until the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose. If, after that, the person injured files a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendant the costs of the suit, and he may have to pay them."<sup>3</sup>

This rule has been uniformly followed.<sup>4</sup> A defendant may make such an offer of submission, by answer or otherwise, at any stage of the proceedings, and so throw upon the plaintiff all costs subsequently accruing.<sup>5</sup>

**§ 126. Submission to avoid costs must be complete.** It is the necessary correlative of the rule stated in the preceding section that no submission can avail a defend-

<sup>1</sup> Ibid.

<sup>2</sup> Bass, Ratcliff & Gretton v. Guggenheimer, 69 Fed. Rep. 271.

<sup>3</sup> Upmann v. Elkan, L. R. 12 Eq. 140; Seb. 369.

<sup>4</sup> Millington v. Fox, 3 Myl. & Cr. 338; Seb. 63; Burnett v. Leuchars, 13 L. T. N. S. 495; Seb. 253; Wharton v. Thurber, Cox, Manual, 663; Nunn v. D'Albuquerque, 34 Beav. 595.

<sup>5</sup> "If the defendant had offered the plaintiffs all they were entitled to, and after that the plaintiffs had proceeded in the suit, I most cer-



ant unless it is full, adequate and complete. Thus a submission, otherwise good, was rendered ineffective because the defendant did not couple with it an offer to pay all costs accrued.<sup>1</sup> An offer of submission on condition that each party pay his own costs was held ineffective.<sup>2</sup> Further adjudication in support of the general doctrine of this section will be found in the note.<sup>3</sup>

**§ 127. Costs refused successful defendant.**—There are a number of instances wherein a defendant against whom the plaintiff has been denied relief has been left to pay his own costs. These cases are not always predicated upon the defendant's absolute fraud, for, even where fraud could not be established, he may have been guilty of conduct so suspicious as to justify the imposition of his own costs.<sup>4</sup> Thus where the defendant had dealt in bitters, and assented to suggestions that they might be passed off on the public as the "Hostetter's Bitters" of the plaintiff, the court thought the facts did not warrant an injunction, but that the defendant had invited the litigation by his conduct and ought not to have his costs.<sup>5</sup>

tainly should not have given the plaintiffs a penny of the costs incurred after that period; indeed, I should have endeavored to make them pay them." Lord Romilly in *Burgess v. Hills*, 26 Beav. 244; Seb. 170. And to the same effect see the opinion of the same Master of the Rolls in *Moet v. Couston*, 33 Beav. 578; Seb. 235.

<sup>1</sup>*Hutchinson v. Blumberg*, 51 Fed. Rep. 829; *McAndrews v. Bassett*, 4 DeG. J. & S. 380; Seb. 234; *Burgess v. Hately*, 26 Beav. 249; Seb. 169; *Burgess v. Hills*, 26 Beav. 244; Seb. 170; *Collins Co. v. Walker*, 7 W. R. 222; Seb. 171; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178.

<sup>2</sup>*Moet v. Couston*, 33 Beav. 578.

<sup>3</sup>*Tonge v. Ward*, 21 L. T. N. S. 480; Seb. 321; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Cox*, 20; Seb. 79; *Fennessy v. Day*, 55 L. T. N. S. 161.

<sup>4</sup>*Talcott v. Moore*, 6 Hun, 106; Seb. 478; *Rose v. Loftus*, 47 L. J. Ch. 576; Seb. 608. Thus, where both plaintiff and defendant made cigars falsely marked "Habana," the English court of appeals dismissed the bill without costs and adjudged the costs of the appeal against the defendant. *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. N. S. 31.

<sup>5</sup>*Hostetter v. Van Vorst*, 62 Fed. Rep. 600.

§ 128. **Miscellaneous matters.**—Innocent wharfingers in whose possession was found champagne bearing a false brand, and who were made parties defendant to an action but at once submitted to act as the court might direct, were awarded their costs, and given a lien for their warehouse charges, and that lien given priority over the plaintiffs' claim for costs.<sup>1</sup>

Where the defendant is a retail dealer, who has acted innocently and handled only a small quantity of the infringing goods, a plaintiff may not be awarded costs even though the injunction issues.<sup>2</sup> Some courts apply this rule where it appears that the defendant's sales have not been large enough to justify the expense of taking an account.<sup>3</sup>

Where it appeared that the defendant had adopted plaintiff's trade-mark (which consisted of words understood by many simply to indicate quality), and did so in ignorance of the plaintiff's existence, the plaintiff was granted an injunction but without costs.<sup>4</sup> A plaintiff may be denied costs because of his delay in instituting suit.<sup>5</sup>

If in his bill the plaintiff makes specific charges against the defendant which he is unable to substantiate with

<sup>1</sup>Moet v. Pickering, L. R. 8 Ch. D. 372.

<sup>2</sup>Thus where a small retailer was charged with infringing a cigarette trade-mark, and it was shown that the transaction related only to five hundred cigarettes, valued at 17s. 6d., which the defendant had bought in ignorance of the infringement, it was said: "I think that this is not the kind of action which ought to be encouraged. If the owner of a trade-mark finds that it is being pirated, surely it is not the small retailer who ought to be punished, but an endeavor ought to be made to prosecute those who place the spurious goods on the market; and although I agree that the plaintiffs are entitled to an injunction, yet I cannot think it is the duty of the court in every case in which a small retail dealer who has innocently (and I think that the defendants in this case have acted innocently) happened to purchase a small quantity of the spurious goods, to say that he ought to be fixed with the costs of the action." Shilling, J., in *American Tobacco Co. v. Guest*, L. R. (1892) 1 Ch. D. 630-632.

<sup>3</sup>*Saxlehner v. Eisner & Mendelson Co.*, 88 Fed. Rep. 61-70.

<sup>4</sup>*Millington v. Fox*, 3 Myl. & Cr. 338; *Cox, Manual*, 642.

<sup>5</sup>*Amoskeag Mfg. Co. v. Garner* (2), 51 How. Pr. 298.

proof, he may, under the English practice, obtain an injunction with costs, but be adjudged to pay all of the defendant's costs occasioned by the making of the unfounded charge.<sup>1</sup>

Where the infringement was not innocent, but the defendants offered to pay costs and publish any reasonable advertisements announcing that they had no connection with the plaintiffs, it was held that by ignoring this offer the plaintiffs had lost their right to relief, and the action was dismissed. It is doubtful if this decision would be given much consideration by an American court.<sup>2</sup>

One who procures the preparation of an article being an infringement of another's trade-mark will be liable to refund to the manufacturer such reasonable sum as he may pay to the owner of the trade-mark in compromise of an action for the infringement, together with the costs of such action.<sup>3</sup>

In regard to appeals, the same general rules as to costs obtain as are applied by the inferior courts. Thus on an appeal from a committal for contempt, based on the violation of an injunction in a trade-mark case, the upper court sustained the ruling of the lower, but, because the violation seemed open to dispute, gave no costs of the appeal.<sup>4</sup>

In the leading case of *McLean v. Fleming* the defendant appealed from a decree awarding the plaintiff an injunction and accounting. The supreme court reversed the decree as to the accounting, on the ground that the plaintiff was guilty of laches, but let the decree of injunction stand. It then gave plaintiff his costs in the lower court, and the defendant the costs of the appeal.<sup>5</sup>

The costs of an unsuccessful motion to commit for contempt will be taxed against the moving party.<sup>6</sup> The

<sup>1</sup> *Saxlehner v. Apollinaris Co.*, L. R. (1897) 1 Ch. 893.

<sup>2</sup> *Valentine v. Valentine*, 31 L. R. Ir. 488.

<sup>3</sup> *Dixon v. Fawcus*, 3 Ell. & Ell. 537.

<sup>4</sup> *Devlin v. Devlin*, 69 N. Y. 212.

<sup>5</sup> *McLean v. Fleming*, 96 U. S. 245.

<sup>6</sup> *Hennessy v. Budde*, 82 Fed. Rep. 541.

costs of contempt proceedings can be taxed against a defendant only where, upon the facts, he might have been committed.<sup>1</sup> While it would seem the better practice to make no order as to costs upon the entry of interlocutory decrees, and to withhold such order until the entry of final decree upon the master's report, we find very respectable authority for the contrary practice.<sup>2</sup>

<sup>1</sup>Dence v. Brand, W. N. 1881, p. 31.

<sup>2</sup>The Collins Co. v. Oliver Ames & Son Corporation, 18 Fed. Rep. 561-571.

## APPENDIX.

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## APPENDIX A.

### RULES OF THE PATENT OFFICE RELATING TO TRADE-MARK REGISTRATION.

(Edition of November 1, 1898.)

#### RULES GOVERNING THE REGISTRATION OF TRADE- MARKS UNDER THE ACT APPROVED MARCH 3, 1881.

UNITED STATES PATENT OFFICE,  
WASHINGTON, D. C., November 1, 1898.

The following rules, designed to be in strict accordance with the provisions of the act approved March 3, 1881, for the registration of trade-marks, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on pages 19-22 (293-297).

C. H. DUELL,  
Commissioner of Patents.

#### CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. A complaint against the examiner of trade-marks, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered trade-marks should refer to the name of registrant, number or date of certificate, and the class of merchandise to which the trade-mark is applied.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, cannot generally be allowed.

9. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed. A copy of these rules with this paragraph marked is intended to be a courteous answer to all such inquiries.

10. Express charges, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

#### ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office cannot aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provi-



sions of rule 17 of the Rules of Practice of the Patent Office to prosecute applications for patents.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. No power of attorney, either original or associate, will be recognized unless it has revenue stamps to the value of twenty-five cents affixed thereto and canceled as provided for by the "Act to provide ways and means to meet war expenditures, and for other purposes," approved June 13, 1898.

14. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

15. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

16. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

#### WHO MAY REGISTER A TRADE-MARK.

17. A trade-mark may be registered by any person, firm, or corporation domiciled in the United States or located in any foreign country which, by treaty, conven-

tion, or law, affords similar privileges to citizens of the United States,<sup>1</sup> and who is entitled to the exclusive use of any trade-mark and uses the same in commerce with foreign nations or with Indian tribes.

Also by any citizen or resident of this country wishing the protection of his trade-mark in any foreign country the laws of which require registration in the United States as a condition precedent upon the payment of the fee required by law and other due proceedings had.

18. Owners of trade-marks for which protection has been sought by registering them in the Patent Office under the act of July 8, 1870 (declared unconstitutional by the supreme court of the United States, 16 O. G. 999), may register the same for the same goods without fee. With each application of this character a specific reference to the date and number of the former certificate is required.

19. Applicants whose cases were filed under the act of 1870, either prior to or since the decision of the supreme court declaring it unconstitutional, which are now pending before the office, must prepare their applications in conformity with the present law and rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only \$10 as a first fee are advised that the law does not provide for a division of the legal fee of \$25, and that the remainder of the entire fee is required before the application can be examined.

20. No trade-mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce between the United States and some foreign nation or Indian tribe, or is within the provisions of a treaty, convention, or declaration with a foreign power, or which is merely the name of the applicant, or which is identical with a known or registered trade-mark owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other

<sup>1</sup>Treaties and laws are tabulated in notes to sec. 1, act of 1881, appendix F. For list of the countries having treaties with the United States at this time see page 326, and for foreign laws see page 327.

person's lawful trade-mark as to be likely to cause confusion in the minds of the public or to deceive purchasers, or which is merely descriptive in its nature.

#### THE APPLICATION.

21. An application for the registration of a trade-mark must be made to the commissioner of patents and must be signed by the owner of the trade-mark.

22. A complete application comprises:

(a) A brief letter of advice requesting registration, signed by the applicant. (See form 1 on page 293.)

(b) A statement or specification which, in addition to the requirements of section 1 of the statute on pages 323-331, must also discriminate between the essential and the non-essential features of the trade-mark, and if the applicant be a corporation it must set forth under the laws of what state or nation incorporated. (See forms 2, 4 and 6, on pages 293-296.)

(c) A declaration or oath complying with section 2 of the statute on pages 331, 332. (See forms 3, 5 and 7, on pages 294-297.)

(d) A fac-simile or drawing of the mark. (See rules 27 and 28 and form on page 295.)

(e) A fee of twenty-five dollars.

23. The letter of advice, the statement, and the declaration must be in the English language and written on one side of the paper only.

24. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

#### DECLARATION OR OATH.

25. The declaration or oath may be made before any person in the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul or

commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, who is authorized by the laws of said country to administer oaths, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

26. The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration must be filed.

#### FAC-SIMILE OR DRAWING.

27. If for any reason a drawing does not constitute a satisfactory fac-simile of the trade-mark, two copies of the trade-mark as actually used must be deposited in addition to the required drawing, to be preserved in the office for reference.

28. (1) The drawing must be made upon pure white paper of a thickness corresponding to three-sheet bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than  $1\frac{1}{4}$  inches is to be left blank for the heading of title, name, number, and date. (See specimen of drawing on page 295.)

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, how-

ever fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4) The signature of the proprietor of the trade-mark must be placed at the lower right-hand corner of the sheet and the signatures of the witnesses at the lower left-hand corner, all within the marginal line, but in no instance should they encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading will be placed at the right and the signatures at the left, occupying the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6) Drawings should be rolled for transmission to the office—not folded.

An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

29. The office, at the request of applicants, will furnish the drawings at cost.

#### EXAMINATION OF APPLICATIONS.

30. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever on examination of an application registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application.

31. The examination of an application and the action thereon will be directed throughout to the merits; but in each letter the examiner shall state or refer to all his objections.

#### AMENDMENTS.

32. The statement may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination; but

no amendments will be admitted unless warranted by something in the statement or fac-simile as originally filed.

33. In every amendment the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. (See form 8, on page 297.) All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

34. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

35. Amendments will not be permitted after the notice of allowance of an application, and the examiner will exercise jurisdiction over such an application only by special authority from the commissioner.

Amendments not affecting the merits may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the commissioner, without withdrawing the case from issue.

36. After the completion of the application the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms.

#### INTERFERENCES.

37. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties

may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

#### APPEALS OR PETITIONS.

38. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the commissioner, on petition or appeal, without fee.

#### ISSUE, DATE, AND DURATION OF CERTIFICATE.

39. When the requirements of the law and the rules have been complied with, and the office has adjudged a trade-mark lawfully registrable, a certificate will be issued by the commissioner, under seal of the interior department, to the effect that applicant has complied with the law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a fac-simile of the trade-mark and a printed copy of the statement and declaration.

40. Before a trade-mark certificate will be delivered, the applicant must furnish a revenue stamp to the value of 10 cents, to be affixed thereto and canceled as required by the "Act to provide ways and means to meet war expenditures, and for other purposes," approved June 13, 1898.

41. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

42. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time

that such trade-mark ceases to be exclusive property elsewhere.

At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

#### ASSIGNMENTS.

43. The right to the use of any trade-mark is assignable by an instrument in writing, and provision is made for recording such instrument in the Patent Office. But no such instrument or conveyance will be recorded unless it is in the English language, and unless an application for the registration of a trade-mark shall have first been filed in the Patent Office, and such instrument must identify the application by serial number and date of filing, or, where the mark has been registered, by its certificate number and the date thereof. No particular form of instrument is prescribed.

#### COPIES AND PUBLICATIONS.

44. After a trade-mark has been registered printed copies of the statement and declaration in each case, with a fac-simile of the trade-mark, can be furnished by the office upon the payment of the fee.

45. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

46. The Official Gazette of the Patent Office will contain a list of all trade-marks registered, with the name and address of the registrant in each case, an illustration of the trade-mark, a brief statement of its essential features, and the particular description of goods to which it is applied.

#### FEES.

47. On filing an application for registration of a  
trade-mark..... \$25.00



For abstracts of title:	
For the certificate of search.....	\$ 1.00
For each brief from the digests of assignments.....	.20
For copies of matter in any foreign language, for every 100 words or fraction thereof.....	.10
For translation, for every 100 words or fraction thereof.....	.50
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less.....	1.00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words.....	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words.....	3.00
For assistance to attorneys and others in the examination of records, one hour or less.....	.50
Each additional hour or fraction thereof.....	.50
For single printed copy of statement, declaration, and fac-simile.....	.05
If certified, for the certificate, additional.....	.25

48. The person ordering any such certificate as specified in rule 46 must furnish a revenue stamp to the value of 10 cents to be affixed to the certificate and canceled as provided for by the "Act to provide ways and means to meet war expenditures, and for other purposes," approved June 13, 1898.

49. Money required for office fees may be paid to the commissioner, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the secretary of the treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount

inclosed. All money orders should be made payable to the "Commissioner of Patents."

50. All money sent by mail, either to or from the Patent Office, will be at the risk of the sender. All payments to the office must be made in specie, treasury notes, national-bank notes, certificates of deposit, post-office money orders, postal notes, or certified checks.

#### REPAYMENT OF MONEY.

51. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return.

## FORMS.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Applicants will find their business facilitated by following them closely:

### (1) LETTER OF ADVICE.

To the Commissioner of Patents:

The undersigned presents herewith a fac-simile of his lawful trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

A. B.

Dated ———, 19—.

### (2) STATEMENT BY AN INDIVIDUAL.

To all whom it may concern:

Be it known that I, A. B., a citizen [*or subject, as the case may be*] of the ——— ———, residing at ———, ———, and doing business at No. ——— ——— street, in said city, have adopted for my use a trade-mark for molasses, of which the following is a full, clear and exact description. My trade-mark consists of the word "Dove" and the representation of a dove. These have generally been arranged as shown in the accompanying fac-simile, in which the dove is represented as flying, and above it are arranged, on a curved line, the words "The Dove Brand" in plain block letters. The position of the dove may be changed and different styles of letters used, and the words "The" and "Brand" may be omitted, without altering the character of the trade-mark, the essential features of which are the word "Dove" and the representation of a dove. This trade-mark has been continuously used in my business since ——— ———, 18—. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which I use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

A. B.

Witnesses:

C. D.

E. F.

## (3) DECLARATION FOR AN INDIVIDUAL.

STATE OF ———, COUNTY OF ———, SS:

A. B., being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade-mark therein described; that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is used by him in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the descriptions and fac-similes presented for record truly represent the trade-mark sought to be registered.

A. B.

Sworn and subscribed before me, a ———, this ——— day of ———, 19—.

[L. S.]

G. H.

## (4) STATEMENT BY A FIRM.

To all whom it may concern:

Be it known that we, C. D. & Co., a firm domiciled in ———, county of ———, state of ———, and doing business at No. ——— street, in the said city, have adopted for our use a trade-mark for molasses, of which the following is a full, clear, and exact description. Our trade-mark consists of the word "Dove" and the representation of a dove. These have generally been arranged as shown in the accompanying fac-simile, in which the dove is represented as flying, and above it are arranged, on a curved line, the words "The Dove Brand" in plain block letters. The position of the dove may be changed and different styles of letters used, and the words "The" and "Brand" may be omitted, without altering the character of the trade-mark, the essential features of which are the word "Dove" and the representation of a dove. This trade-mark has been continuously used in our business since ———, 18—. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which we use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

C. D. & Co.

By C. D.,

A member of the firm.

Witnesses:

E. F.

G. H.



*Witnesses:*

*W.....G.....*

*R.....L.....*

*Proprietor.*

*T.....B.....*

*per*

*G.....C.....*

*Attorney.*

## (5) DECLARATION FOR A FIRM.

STATE OF ———, COUNTY OF ———, SS:

C. D., being duly sworn, deposes and says that he is a member of the firm of C. D. & Co., the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm at this time has a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade-mark is used by the said firm in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the description and fac-similes presented for record truly represent the trade-mark sought to be registered.

C. D.

Sworn and subscribed before me, a ———, this — day of——, 18—.

[L. S.]

E. F.

## (6) STATEMENT BY A CORPORATION.

To all whom it may concern:

Be it known that The E. & F. Company, a corporation duly organized under the laws of the state of ———, and located in the city of ———, county of ———, in said state, and doing business in said city of ———, has adopted for its use a trade-mark for molasses, of which the following is a full, clear and exact description. The trade-mark consists of the word "Dove" and the representation of a dove. These have generally been arranged as shown in the accompanying fac-simile, in which the dove is represented as flying, and above it are arranged, on a curved line, the words "The Dove Brand" in plain block letters. The position of the dove may be changed and different styles of letters used, and the words "The" and "Brand" may be omitted, without altering the character of the trade-mark, the essential features of which are the word "Dove" and the representation of a dove. This trade-mark has been continuously used in the business of the said corporation since ———, 18—. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which the said trade-mark is used is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

THE E. & F. COMPANY,

By G. H., Secretary.

Witnesses:

I. J.

K. L.

## (7) DECLARATION FOR A CORPORATION.

STATE OF ———, COUNTY OF ———, SS.

G. H., being duly sworn, deposes and says that he is secretary [*or other officer*] of the corporation The E. & F. Company, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation at this time has a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade-mark is used by the said corporation in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [*here name one or more foreign nations or Indian tribes, or both, as the case may be*], and that the description and fac-similes presented for record truly represent the trade-mark sought to be registered.

G. H., Secretary\* [*or other officer*]

Sworn and subscribed before me, a ———, this ——— day of ———, 18—.

[L. S.]

I. J.

\*If the corporation have a seal, it may be used to authenticate the signature of the officer.

## (8) AMENDMENT.

To the Commissioner of Patents:

In the matter of my application for the registration of trade-mark for molasses, No. ———, filed ——— —, 18—, I hereby amend my statement as follows:

Page ———, line ———, cancel the words "The Dove Brand," and insert in place thereof the following: "Dove" and the representation of a dove.

Same page, line ———, erase the words "about ten years" and insert, "since ——— —, 18—."

A. B.,

By J. K., His Attorney.

Dated ———, 18—.

APPENDIX B.  
TRADE-MARK PROVISION OF THE TARIFF  
ACT OF 1897.

(30 Statutes at Large, 151.)

Section 11 of this chapter provides: "That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or mark, which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in a book which shall be kept for that purpose in the department of the treasury, under such regulations as the secretary of the treasury shall prescribe, and may furnish to the department fac-similes of such trade-marks; and thereupon the secretary of the treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs." (30 Stats. at Large, p. 207.)

In this connection the following circular has been issued by the treasury department:

[1897. Department Circular No. 116. Division of Customs.]

TREASURY DEPARTMENT, OFFICE OF THE SECRETARY,  
Washington, D. C., August 3, 1897.

To Officers of the Customs and Others:

The attention of officers of the customs and others is invited to the following provision of section 11 of the act of July 24, 1897: [quoting above section.]

Applications for the recording of names or trade-marks in this department will state the name and residence of the domestic manufac-



turer, and furnish a description of the mark and the names of the ports to which the fac-similes should be sent. No such name or trade-mark will be received unless accompanied by the proper proof of ownership and proof that the owner is a domestic manufacturer, which must consist of the affidavit of the owner or one of the owners, certified by a notary public, or other officer entitled to administer oaths, and having a seal.

On the receipt by a customs officer of any such fac-similes, with information from the department that they have been recorded therein, he will properly record and file them, and will exercise care to prevent the entry at the custom-house of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trade-marks in the department and custom-houses.

A sufficient number of fac-similes should be forwarded to enable the department to send one copy to each port named in the application with ten additional copies for the files of the department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States," and collectors and other officers of the customs are instructed to use due diligence to prevent violations of this provision.

W. B. HOWELL,  
Assistant Secretary.

No fees are charged for recording trade-marks under this section. Applicants must state the name and residence of the domestic manufacturer and specify the ports to which fac-similes are to be sent. Synopsis Treasury Decisions, 1895, p. 926; Id., 1896, p. 70. The treasury department cannot determine the validity of a trade mark. Its powers are limited to the exclusion of articles which copy or simulate trade-marks filed for record with the department. Synopsis Treasury Decisions, 1895, p. 929.

Compare sec. 6, Tariff Act of Aug. 27, 1894; and sec. 7 of the Act of Oct. 1, 1890.

## APPENDIX C.

### ACT OF CONGRESS OF JULY 8, 1870.<sup>1</sup>

SECTION 77.<sup>2</sup> And be it further enacted, that any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any state or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to the citizens of the United States, and who are entitled

<sup>1</sup>Although this act is no longer in force, having been held unconstitutional, and the act of 1881 having been since enacted, it is thought advisable to set forth the earlier act, in order that the decisions under it may be understood. In *Leidersdorf v. Flint* (1), 8 Biss. 327, the validity of the act of 1870 was questioned by the United States circuit court, on the ground that the constitution of the United States did not authorize legislation by congress on the subject of trade-marks, except such as had been actually used in commerce with foreign nations and among the several states, or with the Indian tribes; and in *Trade-mark Cases*, 100 U. S. 82, the act was formally declared by the supreme court to be on this ground unconstitutional and invalid. But this does not entitle persons having marks registered under the invalid act to recover back the fees paid by them (*Woodman v. United States*, 15 Ct. of Cl. 541), though they will be credited with such fees when applying for registration under the new act. See Act of 1881, sec. 6, *infra*. Nor does the invalidity of the act justify the disregard of injunctions granted under the general jurisdiction of the court. *United States v. Roche*, 1 McCrary, 385. And it has been held that registration of a mark under the invalid act, even without re-registration under the act of 1881, is sufficient to prevent registration of a similar mark under the new act of 1881. *Ex parte Lyon, Dupuy & Co.*, 28 Off. Gaz. 191. Since the passing of the act of 1870, it has been considered in the Patent Office that while, on the one hand, the benefits of registration as trade-marks were to be reserved for trade-marks, and for trade-marks only (*e. g.*, in *Re Parker*, 13 Off. Gaz. 323, registration as a trade-mark was refused to that which could at most amount to a design), so, on the other hand, it was only by registering them as trade-marks, and not by patenting them as designs (*Ex parte King*, Comm. Decis., 1870,

<sup>2</sup>See Act of 1881, secs. 1, 2.

to the exclusive use<sup>1</sup> of any lawful trade-mark, or who intend to adopt and use any trade-mark,<sup>2</sup> for exclusive use within the United States, may obtain protection for such lawful trade-mark<sup>3</sup> by complying with the following requirements,<sup>4</sup> to wit:

p. 109; *Re Whyte*, id. 1871, p. 304), or registering them as labels (*Re Godillot*, 6 Off. Gaz. 641; *Re Simpson & Sons*, 10 id. 333; *Ex parte Davids & Co.*, 16 id. 94; *Ex parte Schumacher & Ettlinger* (1), 19 id. 791), that the benefits of the statute could be obtained for trade-marks. Descriptive words not registrable as trade-marks were properly allowed to be registered as labels. *Ex parte Waeflerling*, 16 id. 764; *Ex parte Brigham*, 20 id. 891; *Ex parte Lutz*, 33 id. 1389; and see

<sup>1</sup>In *McElwee v. Blackwell*, 15 Off. Gaz. 658, it was held that although where registration had been wrongfully granted to one, it might subsequently be properly granted to another who was really entitled to the exclusive use, yet it would not be granted to another who was not entitled to the exclusive use, even though he might be entitled to use the mark to some extent. And see *Wright v. Simpson*, 15 id. 968; also *Sorg v. Welsh*, 16 id. 910, as to admissions of right in another; and *Yale Cigar Manufacturing Co. v. Yale*, 30 id. 1183. Under the act of 1881 registration will be refused where it appears that the applicant is only one of several who have a right to use the mark. *Ex parte Langdon*, 61 Off. Gaz. 286.

<sup>2</sup>Under these words a new trade-mark might be registered prior to any actual use. *Re Rothschild*, 7 Off. Gaz. 220; and see *Hoosier Drill Co. v. Ingels*, 14 id. 785. This is not the case under the act of 1881. See secs. 1 and 2, notes, and *Ex parte Strasburger & Co.*, 20 Off. Gaz. 155.

<sup>3</sup>As to what is a lawful trade-mark, see *infra*, sec. 79. Registration cannot make a lawful trade-mark out of that which does not contain the necessary elements (*Moorman v. Hoge*, 2 Sawy. 78; *Schumacher & Ettlinger v. Schwenke* (2), 36 Off. Gaz. 457); but by sec. 7 of the act of 1881 registration is *prima facie* evidence of ownership. It has been doubted whether the use of a registered trade-mark can be restrained (*Decker v. Decker*, 52 How. Pr. 218); but in *Glen Cove Manufacturing Co. v. Ludeman*, 23 Blatchf. 46, an injunction was granted in such a case. See also *Schumacher & Ettlinger v. Schwenke* (2), 36 Off. Gaz. 457. Separate registration must be obtained for each mark which differs from another by the addition of a symbol: *e. g.*, "X," "XX," "XXX," were held to require separate registration. *Re English*, Comm. Decis. 1870, 142; and see *Re Eagle Pencil Co.*, 10 Off. Gaz. 981.

<sup>4</sup>Absolute compliance with these requirements is necessary on the part of applicants. *Re Hankinson*, 8 Off. Gaz. 89. But it is not necessary that the very words of the act should be cited, so long as the spirit of it is satisfied. *Re Vidvard & Sheehan*, 8 id. 143.

First. By causing to be recorded in the Patent Office,<sup>1</sup> the names of the parties and their residence and place of business,<sup>2</sup> who desire the protection of the trade-mark.

Second. The class of merchandise<sup>3</sup> and the particular description of goods<sup>4</sup> comprised in such class, by which the trade-mark has been or is intended to be appropriated.

Re Park, 12 id. 2, in which it was sought to register as part of a label a device for which the applicant had previously sought registration as a trade-mark. In *United States v. Marble*, 22 id. 1366, however, the supreme court of the District of Columbia held that the commissioner of patents had no authority to refuse registration to a label merely on the ground that it might have been registered as a trade-mark; but in the later case of *Ex parte Schumacher & Ettlinger* (2), 22 id. 1291, the commissioner again refused registration as labels to what he considered to be trade-marks; and in *Ex parte Moodie*, 28 id. 1271, and *Ex parte Wiesel*, 36 id. 689, the commissioner repeated this decision, and his course was in the former case upheld on appeal by the supreme court of the District of Columbia in *Ex parte Moodie*, 28 id. 1271. The federal courts have also held that a trade-mark must be registered as such, and not copyrighted as a label. *Schumacher & Ettlinger v. Wogram*, 35 Fed. Rep. 210. It is for the commissioner to decide whether what is presented to him is a trade-mark or label. *Ex parte Moodie*, 28 Off. Gaz. 1271.

<sup>1</sup>In *Lacroix v. Escobal*, 37 La. Ann. 533, it was held that a French citizen, who had not deposited his mark in the United States patent office, as required by the convention of 1869 between the United States and France, was not entitled to maintain an action for infringement. But see *Société, etc. de la Benedictine v. Micalovitch*, 36 Alb. L. J. 364.

<sup>2</sup>The registration of the name of a firm has been held to be sufficient, without giving the particulars as to each of the partners. *Smith v. Reynolds* (2), 3 Off. Gaz. 213; 10 Blatchf. 100.

<sup>3</sup>This requirement has been interpreted to exclude from registration the marks of persons other than manufacturers or merchants: *e. g.*, a carpet cleaner. *Re Hankinson*, 8 Off. Gaz. 89.

<sup>4</sup>It has been held that a description of the class and goods as "paints" is sufficient (*Smith v. Reynolds* (2), 10 Blatchf. 100), and so with "alcoholic spirits" (*Re Boehm & Co.*, 8 Off. Gaz. 319); but that "fancy goods" is insufficient, as being too general a term. *Re Lisner*, 13 id. 455. Different persons may register the same trade-mark for different descriptions of goods even in the same class. *Sorg v. Welsh*, 16 id. 910. In *Smith v. Reynolds* (2), 10 Blatchf. 100, and *s. c.* (3), 3 id. 213, it was held that a firm which had registered a trade-mark for "paints" was not entitled to restrain the use of the mark on white lead by another firm which had used the

Third. A description of the trade-mark itself<sup>1</sup> with fac-similes thereof<sup>2</sup> and the mode in which it has been or is intended to be applied and used.<sup>3</sup>

Fourth. The length of time, if any, during which the trade-mark has been used.<sup>4</sup>

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.<sup>5</sup>

Sixth. The compliance with such regulations as may be prescribed by the commissioner of patents.<sup>6</sup>

Seventh. The filing of a declaration,<sup>7</sup> under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has the right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calcu-

mark on that variety of paint before the plaintiffs had used or registered their mark; and in the former case it was held that the registration being bad as to white lead was bad *in toto*, though but for that it might have been good.

<sup>1</sup>The trade-mark must be sufficiently described for it to be possible to clearly distinguish between the essential and non-essential elements. *Re Volta Belt Co.*, 8 Off. Gaz. 144; and see rule 22 *ante*, p. 285.

<sup>2</sup>The fac-simile limits the verbal description of the mark. *Duke v. Green*, 16 Off. Gaz. 1094.

<sup>3</sup>The previous user of the applicants or their derivative title must be stated. *Ex parte Consolidated Fruit Jar Co.*, 16 Off. Gaz. 679. Only one example of the mode of use will be admitted. *Re Kimball*, 11 id. 1109. And see *Smith v. Reynolds* (2), 10 Blatchf. 100.

<sup>4</sup>See *Ex parte Consolidated Fruit Jar Co.*, 16 Off. Gaz. 679.

<sup>5</sup>A fee paid can only be recovered when it was paid by actual mistake: *e. g.*, a payment in excess, or one not required by law. When, therefore, an application has failed because the proposed mark was not registrable, the fee paid cannot be recovered, although a renewed application for the registration of an essentially different mark has proved successful. *Re Block & Co.*, 14 Off. Gaz. 235. See note 1, p. 300, *supra*, as to crediting fees paid under this invalid act.

<sup>6</sup>See sec. 81, *infra*, and note thereto.

<sup>7</sup>As to the necessity for the filing of this declaration, and for the production of sufficient evidence of it, on a trial for infringement, see *Smith v. Reynolds* (1), 10 Blatchf. 85, where an injunction was refused on the ground of the deficiency of such evidence.

lated to deceive,<sup>1</sup> and that the description and facsimiles presented for record are true copies of the trade-mark sought to be protected.

SECTION 78.<sup>2</sup> And be it further enacted, that such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods.<sup>3</sup> Provided that six months prior to the expiration of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the commissioner of patents, and the fee for such renewal shall be the same as for the original registration certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years; And provided further, that

<sup>1</sup>A declaration that no other person, firm or corporation has a right to the use of the same, or substantially the same, mark, is a sufficient compliance with this requirement. *Re Vidvard & Sheehan*, 8 Off. Gaz. 143.

<sup>2</sup>See Act of 1881, secs. 5, 7, 11.

<sup>3</sup>An illegal registration by a part owner not entitled to exclusive use, was held not to justify issuing another certificate to another part owner of the same mark, in order to put him on an equal footing in court. *McElwee v. Blackwell*, 15 Off. Gaz. 658. In an interference, the applicant was granted registration as against a prior registrant whose user had been experimental and interrupted. *Sternberger v. Thalheimer*, 3 Off. Gaz. 120.

nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

SECTION 79.<sup>1</sup> And be it further enacted, that any person or corporation who shall reproduce, copy, counterfeit, or imitate any such recorded trade-mark, and affix the same to goods of substantially the same description, properties and qualities as those referred to in the registration,<sup>2</sup> shall be liable to an action on the case for damages for such unlawful use of such trade-mark at the suit of the owner thereof in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use.<sup>3</sup> The commissioner of patents<sup>4</sup> shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark,<sup>5</sup> or which is merely

<sup>1</sup>See Act of 1881, secs. 3, 7.

<sup>2</sup>See *Osgood v. Rockwood*, 11 Blatchf. 310; Fed. Cas. No. 10605, where it was held that persons who had registered a trade-mark for prints made according to a patented process were not entitled under this act to an injunction against a person who had used the mark on prints not made in accordance with the patent.

<sup>3</sup>The United States circuit courts had jurisdiction under this act in cases of infringement of trade-mark, even when both parties were citizens of the same state. *Duwel v. Bohmer*, 14 Off. Gaz. 270; but see secs. 7 and 11 of the act of 1881.

<sup>4</sup>The validity of the decisions of the acting commissioner was upheld in *Simpson v. Wright* (2), 15 Off. Gaz. 293.

<sup>5</sup>The question what may be registered as being a "lawful trade-mark" has been considered in many cases. The device of a crown is a good trade-mark. *Smith v. Reynolds* (2), 10 Blatchf. 100. The arms of one of the states could not be registered as a trade-mark. *Ex parte Davids & Co.*, 16 Off. Gaz. 94. And it has been held that the same is the case with the Freemasons' square and compass, *Re Tolle*, 2 id. 415; and the word "Masonic," *Ex parte Smith* (3), 16 id. 764. In *Re Thomas*, 14 id. 821, the Freemasons' symbols were allowed to be registered in combination, and *Re Tolle*, *supra*, was overruled. In *Ex parte King* (2), 46 id. 119, the decision in *Re Thomas*,

the name of a person, firm, or corporation only,<sup>1</sup> unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, or which is identical with the trade-mark appropriated to the same

14 id. 821, was followed, and the design of the badge adopted by the Grand Army of the Republic was allowed to be registered as a trade-mark for writing paper by a person who had no connection with that society, and it was said that, that society not having used their badge as a mark on writing paper, they would be infringing the applicant's rights if they were to begin to do so. The words "Knights of Labor" were refused registration as a mark for whisky on this ground and because deceptive. *Ex parte Bloch & Co.*, 40 Off. Gaz. 443. A word which has become common, *e. g.*, "Calhoun" plow, cannot be registered. *Re Hall & Co.*, 13 id. 229. Registration has been refused to the following words and expressions, on the ground of descriptiveness: "Beeswax oil," *Re Hawthaway* (1), *Comm. Decis.* 1871, 97; *s. c.* (2), id. 284; "Razor Steel," *Re Roberts* (4), id. 100; "Invisible" face powder, *Ex parte Palmer*, id. 289; "A. Richardson's Patent Union Leather Splitting Machine," *Re Richardson*, 3 Off. Gaz. 120; "Für Familien-Gebrauch," and "Lawrence Feiner Familien-Flannel," *Re Lawrence*, 10 id. 163; "Iron Stone" drain pipes, *Re Rader & Co.*, *Comm. Decis.*, 1878, 67; "Croup Tincture," *Re Roach*, 10 Off. Gaz. 333; "Crack-proof" India rubber, *Re Goodyear Rubber Co.*, 11 id. 1062; "Evaporated" articles of food, *Ex parte Alden*, 15 id. 389; "Standard A" cigars, *Ex parte Cohn* (1), 16 id. 680; "Druggists' Sundries," *Ex parte Cohn* (2), 16 id. 680; "Safety" powder, *Ex parte Safety Powder Co.*, 16 id. 136; "Medicated Prunes," *Ex parte Smith* (2), 16 id. 679; "Satin Polish," shoe polish, *Re Brigham*, *Comm. Decis.* 1881, 38; "Swing" scythe sockets, *Ex parte Thompson*, *Derby & Co.*, 16 Off. Gaz. 137; "Granulated Dirt Killer" soap, *Ex parte Waeflerling*, 16 id. 764; "Famous," merchandise generally, *Re Brand Stove Co.*, 62 Off. Gaz. 588; and "Splendid" flour, *Ex parte Stokes*, 64 Off. Gaz. 437. And the same has been the case with respect to the figure of a fish for fishing lines, *Re Pratt & Farmer*, 10 id. 866; and the representation of a twig with three

<sup>1</sup> Thus, in *Re Rowe & Post*, 9 Off. Gaz. 496, the name "The New York Cutlery Co." was refused registration as a new mark. As to the registration of names as old marks, see *post*, note 2, p. 308. See also *Re Porter Blanchard's Sons*, *Comm. Decis.* 1871, 97; *Re Roberts* (1), id. 113; *s. c.* (2), id. 100; *s. c.* (3), id. 101; *Re India-rubber Comb Co.*, 8 Off. Gaz. 905; *Re Consolidated Fruit Jar Co.*, 14 id. 269; *Ex parte Davids & Co.*, 16 id. 94; *Re Creedmore Cartridge Co.*, 56 id. 1333. The prohibition does not extend to the registration of the name of a person other than the applicant, and such names may be registered, at all events with their owners' consent, if living. *Ex parte Sullivan & Burke*, 16 id. 765; *Ex parte Pace*, *Talbott & Co.*, 16 id. 909.



class of merchandise and belonging to a different owner and already registered or received for registration, or which so nearly resembles such last mentioned trade-

leaves and a plum, for prunes, *Ex parte Smith* (2), 16 id. 679; and see *Popham v. Wilcox*, 66 N. Y. 69. On the other hand, "The Blanchard Churn," *Re Porter Blanchard's Sons*, Comm. Decis. 1871, 97; "Beaverine" boots and shoes, *Re Francis & Mallon*, id. 283; and "Dr. Lobenthal's *Essentia Antiphthisica*," *Re Rohland*, 10 Off. Gaz. 980, have been admitted to registration as being non-descriptive. In a series of cases registration has been refused on the ground that the term claimed, if properly applicable to the goods with respect to which it was used, was descriptive, but if not, was deceptive: *e. g.*, "Bromo-Quinine," *Re Grove*, 67 Off. Gaz. 1447; "American Sardines," *Re American Sardine Co.*, 3 id. 495; "Egg Macaroni," *Re Bole Bros.*, 12 id. 939; "Cachemire Milano," *Re Warburg & Co.*, 13 id. 44; "French Paints," *Ex parte Marsching & Co.*, 15 id. 294; "London" animal foods, *Ex parte Knapp*, 16 id. 318; but see *Re Green*, 8 id. 729, where registration was granted to "German Syrup." On the latter ground of deceptiveness, the word "patent" cannot be registered as a part of a mark for an article made under an expired patent. *Re Richardson*, 3 id. 120. A geographical name is not usually registrable. *Armistead v. Blackwell*, 1 id. 603, "Durham" tobacco; *Re Tolle*, 2 id. 415, "Cherry Street Mills," and "Market Street Mills;" *Ex parte Knapp*, 16 id. 318, "London" animal foods; *Ex parte Marsching & Co.*, 15 id. 294, "French Paints;" *Ex parte Farnum & Co.*, 18 id. 412, "Lancaster" goods. But such a name may be registered when arbitrarily selected. *Re Cornwall* (2), 12 id. 312, "Dublin" soap. Similarly, numerals may be registered when arbitrarily selected. *Kinney v. Allen*, 1 Hughes, 106; *Ex parte Dawes & Fanning*, 1 Off. Gaz. 27; *American Solid Leather Button Co. v. Anthony*, 15 R. I. 338. But not otherwise. *Re Eagle Pencil Co.*, 10 Off. Gaz. 981. It has been held that a peculiarity in the form of a barrel is not registrable as a trade-mark, *Moorman v. Hoge*, 2 Sawy. 78; nor representation of such barrel when applied to the goods contained in it, *Ex parte Halliday Bros.*, 16 Off. Gaz. 500; nor is a special kind of barrel-hoop registrable. *Re Kane & Co.*, 9 id. 105. But see *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392. A special collar box was held not to constitute a trade-mark, *Carrington v. Libby*, 14 Blatchf. 123; and a sampler pattern was refused registration, *Re Parker*, 13 Off. Gaz. 323; and a strip of tobacco intended to be wrapped around the mouthpiece of cigarettes, on the ground that it was intended to serve purposes of convenience rather than of identification, *Re Gorden*, 12 id. 517; and the use of a tin tag or ticket on the goods, irrespective of shape and design, is no trade-mark, *Lorillard v. Pride*, 28 Fed. Rep. 434; though a tin tag of special shape, size and color may be, *Lorillard v. Wight*, 15 Fed. Rep. 383. There is no trade-mark

mark as to be likely to deceive the public:<sup>1</sup> Provided, that this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.<sup>2</sup>

in the shape of a plug of tobacco, *Liggett & Myers Tobacco Co. v. Hymes*, 20 Fed. Rep. 883; or of a box, *Sawyer v. Horn*, 4 Hughes, 239; *Ball v. Siegel*, 116 Ill. 137; or of sticks of chewing gum, *Adams v. Heisel*, 31 Fed. Rep. 279; or of the frame of a sewing machine originally made under a patent, *Wilcox & Gibbs Sewing Machine Co. v. Gibbons' Frame*, 21 Blatchf. 431; *Brill v. Singer Manufacturing Co.*, 41 Ohio St. 127; nor in a manner of arranging in boxes cakes of soap wrapped in differently colored paper wrappers, *Davis v. Davis*, 27 Fed. Rep. 490; nor in a *nom de plume*, *Clemens v. Belford*, 11 Biss. 459. But registration has been granted to a peculiarly shaped stick intended to be so placed in a roll of carpet as to show an octagonal ring at each end, *Lowell Manufacturing Co. v. Larned*, Fed. Cas. No. 8570. Registration cannot be granted to minor and non-essential features in a compound mark. *Ex parte Coats*, 16 Off. Gaz. 544. Occa-

<sup>1</sup>Thus, in *Re American Lubricating Oil Co.*, 9 Off. Gaz. 687, registration was refused to the word "Star" as a trade-mark on oil, the device of a star having already been registered for the same article; so in *Re Coggin, Kidder & Co.*, 11 id. 1109, to a device in which the principal feature was the name "Haxall," which had long been the trade-mark of another firm; so in *Re Bush & Co.*, 10 id. 164, to a combination mark consisting of the applicant's own registered trade-mark and two other devices appropriated by other firms; so in *Ex parte Claire*, 15 id. 248, to the words "Black Swan," the word "Swan" being already registered; so in *Ex parte Smith* (1), 16 id. 679, to "A. S. California Family ☆ Soap," "California" and "☆" being already separately on the register; and see *Ex parte Weisert Bros.*, 16 id. 680. On the other hand, in *Re Imbs*, 10 id. 463, registration was granted, notwithstanding that two other marks contained somewhat similar features; and in *Re Cornwall* (1), 12 id. 138, a device of a star and a crescent was registered, although a star had previously been registered.

<sup>2</sup>Under this proviso registration was granted to a name used as a trade-mark before 1870, *e. g.*, "The India-rubber Comb Co. of New York," *Re India Rubber Comb Co.*, 8 Off. Gaz. 905; "The Rubber Clothing Co.," *Re Rubber Clothing Co.*, 10 id. 111. See *Re Dole Bros.*, 12 id. 939; *Re Consolidated Fruit Jar Co.*, 14 id. 269; *Ex parte Consolidated Fruit Jar Co.*, 16 id. 679. This saving proviso is, however, omitted from the act of 1881, so that the prohibition as to names, etc., is universal. See Act of 1881, sec. 3, and *Ex parte Fairchild*, 21 Off. Gaz. 789, in which case registration was refused to a name which had been used as a trade-mark for twenty years, and had been registered under the act of 1870.

SECTION 80.<sup>1</sup> And be it further enacted, that the time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought into controversy.

SECTION 81.<sup>2</sup> And be it further enacted, that the commissioner of patents is authorized to make rules and regulations<sup>3</sup> and to prescribe forms for the transfer of

sionally a mark has been allowed to be registered in alternative forms, *e. g.*, "The Star Shirt," the same words with the figure of a star, and "The ☆ Shirt," *Morrison v. Case*, 9 Blatchf. 548; the figure of a lion, the word "Lion," or both, *Re Weaver*, 10 Off. Gaz. 1; and see *Re Park*, 12 *id.* 2; *Re Thomas*, 14 *id.* 821; *Ex parte Peper*, 16 *id.* 678. A bad trade-mark does not become a good one by the addition of unobjectionable elements, *Re Blakeslee & Co.*, Comm. Decis. 1871, 284, "*Cundurango Ointment Co.*;" *Re Dick & Co.*, 9 Off. Gaz. 538, "*D. D. & Co. tasteless*" drugs; *Re Rader & Co.*, 13 *id.* 596, "*Iron Stone*" in an oval border. But it appears to be possible for two marks, which separately are not good trade-marks, to form one in combination, *Ex parte Davids & Co.*, 16 *id.* 94. A trade-mark cannot be registered for the purpose of being used by all the members of an association on goods of any quality, nor can a mark which is intended to be used in furtherance of a scheme for the restraint of trade, *Ex parte Cigar Makers' Association*, 16 *id.* 958; and in *Schneider v. Williams*, 44 N. J. Eq. 391, the court refused to protect such a mark at the instance of a member of the association. In *Strasser v. Moonelis*, 108 N. Y. 611; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Allen v. McCarthy*, 37 Minn. 347; and *Bloete v. Simon*, 49 Abb. N. C. 88, however, a different view was taken of the propriety of such a mark. It seems that the decision of a competent court as to the validity of a mark is binding upon the patent office. *Re India-rubber Comb Co.*, 8 Off. Gaz. 905. If an application is refused on the ground that the proposed mark is not registrable, a renewed application for the registration of a mark not open to objection must be treated as a new application, and it cannot be treated as an amendment of the original application, nor can the fee originally paid be returned. *Re Block & Co.*, 14 *id.* 235.

<sup>1</sup>See Act of 1881, secs. 3, 4.

<sup>2</sup>See Act of 1881, sec. 12.

<sup>3</sup>It was formerly decided that the authority given to the commissioner by section 81 to make regulations empowered him to declare an interference in a trade-mark case, for the purpose of deciding a

the right to use such trade-marks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

SECTION 82.<sup>1</sup> And be it further enacted, that any person who shall procure the registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark, in the Patent Office under this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

question of title to the trade-mark, on the analogy of the practice in patent cases. *Lautz Bros. & Co. v. Schultz & Co.*, 9 Off. Gaz. 791; *Duke v. Green*, 16 id. 1094. And though it was thought in *Swift v. Peters*, 11 id. 1110, that the question whether a registered proprietor of a mark was entitled to the exclusive use of it against an ex-partner was a question for a court of law, and not for the office, it was held in *Hoosier Drill Co. v. Ingels*, 14 id. 785, that, in investigating the title of the mark, all matters relating to the ownership should be gone into; and in *Hanford v. Wescott*, 16 id. 1181, Fed. Cas. No. 6022, it was held that a decision of the examiner of interferences, unappealed from, was conclusive as to the right to a mark; and see *Josselyn v. Swezey & Dart*, 15 Off. Gaz. 702, as to reopening the evidence taken on an interference, and *Simpson v. Wright* (1), 15 id. 248, and s. c. (2), 15 id. 293, as to rehearing an interference. After the case of *United States v. Steffens*, 100 U. S. 82, it was held that the Patent Office has no longer any authority to decide questions of disputed titles to trade-marks, or to declare interferences in such cases. *Braun & Co. v. Blackwell*, 19 Off. Gaz. 481; and see *Ex parte Strasburger & Co.* 20 id. 155, and *Jacoby & Co. v. Lopez & Co.*, 23 id. 342. And in *Yale Cigar Mfg. Co. v. Yale*, 30 id. 1183, it was decided that a declaration of interference is authorized by section 3 of the act of 1881. In such cases the only duty of the office is to decide whether the opponent has or has not a better title than the applicant, not to decide any further question. *Ibid.* If, on an interference between an applicant and a registered owner with respect to the same mark, the right to registration is adjudged to the applicant, notwithstanding the opposition of the registered owner, the result is, while strictly giving the applicant merely the right to register, practically to displace the registered owner, though his mark is not removed from the register. *Ibid.* For the present rule as to interferences see note 7 to sec. 3 of the Act of 1881.

<sup>1</sup> See Act of 1881, sec. 9.

SECTION 83.<sup>1</sup> And be it further enacted, that nothing in this act shall prevent, lessen, impeach or avoid, any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if this act had not been passed.<sup>2</sup>

SECTION 84.<sup>3</sup> And be it further enacted, that no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.<sup>4</sup>

<sup>1</sup>See Act of 1881, sec. 10.

<sup>2</sup>See *Osgood v. Rockwood*, 11 Blatchf. 310; Fed. Cas. No. 10605; *United States v. Roche*, 1 McCrary, 385; Fed. Cas. No. 16180.

<sup>3</sup>See Act of 1881, sec. 8.

<sup>4</sup>It seems that this act provided no means for removing from registration a mark which was wrongfully registered, *e. g.*, a mark which did not contain any of the essential particulars. See *Armistead v. Blackwell*, 1 Off. Gaz. 603; *McElwee v. Blackwell*, 15 id. 658; *Wright v. Simpson*, 15 id. 968; *Yale Cigar Mfg. Co. v. Yate*, 30 id. 1183.

## APPENDIX D.

### LABEL ACT OF JUNE 18, 1874.

(18 Statutes at Large, 78.)

An act to amend the law relating to patents, trade-marks and copyrights.

SECTION 3. That in the construction of this act the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same.<sup>1</sup>

<sup>1</sup> This law can be sustained only under the constitutional delegation of authority to congress to legislate upon copyrights.

The provision quoted has reference only to such writings as are the result of intellectual labor and are founded in the creative powers of the mind.

"It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts." Mr. Justice Field in *Higgins v. Keuffel*, 140 U. S. 428.

No action at law or in equity can be maintained for the infringement of a label so registered (copyrighted) unless the provision of the copyright law in regard to the notice has been complied with, *i. e.*, "by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz.: 'Entered according to Act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress, at Washington;' or (at the option

of the registrant) the word 'Copyright,' together with the year the copyright was entered, and the name of the party by whom it was taken out;" thus, "Copyright, 18—, by A. B." *Higgins v. Keuffel*, 140 U. S. 428.

It is manifest that under this decision the act affords no protection to labels, and registration under it is idle. *Luby*, Patent Office Practice, p. 121. But until there is a decision declaring the law unconstitutional the Patent Office is open for this class of registration. *Ex parte H. J. Heinz Co.*, 62 Off. Gaz. 1064. It is held, however, that a label will not be admitted to registry unless it has the same degree of artistic excellence as would entitle it to copyright in the office of the librarian of congress. *Ex parte Palmer*, 58 Off. Gaz. 383. And labels containing or consisting of matter constituting trade-marks will not be registered until such trade-mark matter has been registered as trade-mark. *Ex parte Diamond Laboratory Co.*, 44 MSS. Dec. 19; *Ex parte Ruckstuhl*, 56 Off. Gaz. 927. A label bearing the name and address of the owner, the name of the article to which it is applied, with the price and directions for use, exhibiting no attempt at artistic or literary merit, will not be registered. *Ex parte Eldredge Co.*, 55 Off. Gaz. 1278. The same ruling has been made as to a label purely descriptive of the articles to which it is intended to be applied. *Ex parte C. G. Hainline & Co.*, 58 Off. Gaz. 947.

*Prints and labels defined.*—"Registered labels or prints and trade-marks are recognized by the terms of the law and decisions of the courts as applicable only to some kind of merchandise; labels, as giving the names of the manufacturers, place of manufacture, nature or quality of goods, directions for use, and the like." *Doolittle*, Assistant Commissioner, in *Ex parte Parker*, 13 Off. Gaz. 323.

Long prior to the decision of *Higgins v. Keuffel*, 140 U. S. 428 (*supra*), Judge Blatchford had held that this section was purely a copyright act, and that under the general copyright regulation of congress (sec. 4956, R. S.) no person could claim protection for a label so registered unless "before publication" he had deposited a printed copy of the title of the article in respect of which the copyright was claimed, in the Patent Office. *Marsh v. Warren*, 14 Blatchf. 263; 14 Off. Gaz. 678; Fed. Cas. No. 9121; 16 Fed. Cas. 821.

It has been held that the mere fact that words or designs which appear upon the label might be used as trade-marks does not prevent registration under this act. *Ex parte Orcutt & Son*, 8 Off. Gaz. 276; and in another early case the applicant's label was admitted to registry, but certain "arbitrary words" and "fanciful figures" were first refused or stricken out of the label, and the commissioner suggested that they should be registered as trade-marks. *Ex parte W. Simpson & Sons*, 10 Off. Gaz. 334. But as indicated in the first portion of this note, the prevailing doctrine was that "the presence in a label of matter registrable as a trade-mark excludes the whole from registration." *Ex parte Thaddeus Davids & Co.*, 16 Off. Gaz. 94. It has been held by the supreme court of the District of Columbia, however, that the commissioner of patents has no discre-

tion to determine whether a particular label should be classed as a trade-mark or as only a label. That his duties as respects this act are purely ministerial, and *mandamus* will lie to compel him to register any label properly presented for registration. United States ex rel. Wilcox & Gibbs Sewing Machine Co. v. Marble, 1 Mackey, 284; 22 Off. Gaz. 1366; United States ex rel. Schumacher v. Marble, 3 Mackey, 32. And it is now settled that a print will not be refused registration "even though it may contain matter capable of sequestration as a trade-mark, not in fact registered as a trade-mark." Greeley, Commissioner, in Ex parte United States Playing Card Co., 82 Off. Gaz. 1209, 1210.

In regard to this act, the Patent Office has adopted the following rule: "These sections of statutes (referring to sections 3, 4 and 5 of the act of June 18, 1874) are construed as authorizing the registry of 'prints' and 'labels.' A label is a device or representation not borne by an article of manufacture or vendible commodity. A print is a device or representation not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as a pictorial advertisement thereof. A label cannot be registered if it bear a device capable of registration as a trade-mark, until after such device is registered as a trade-mark. Both labels and prints, in order to be entitled to registry, must be intellectual productions in the degree required by the copyright law."

The restriction contained in this rule as to the registration of labels containing a device capable of sequestration as a trade-mark does not apply to a print containing such a device, and it will be admitted to registration, even though it may contain a device so capable of sequestration as a trade-mark, and that device has not been registered. Ex parte United States Playing Card Co., 82 Off. Gaz. 1209.

The Patent Office has furnished the following information to applicants for the registration of prints and labels under this act, and forms for use in making application for such registration:

"The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

"An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on petition, without fee.

"The word 'print,' as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic representation or intellectual production not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as an advertisement thereof.

"The word 'label,' as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic representation or intellectual production impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or



to bottles, boxes, and packages containing them, to indicate the contents of the package, the name of the manufacturer, or the place of manufacture, the quality of goods, directions for use, etc.

"By the words 'articles of manufacture' (to which such print or label is applicable by this act) is meant all vendible commodities produced by hand, machinery, or art.

"No print or label can be registered unless it properly belongs to an article of commerce and is as above defined.

"To entitle the proprietor of any such print or label to register the same in the Patent Office, the application for the registration thereof must be made to the commissioner of patents, and said application should be signed by the proprietor or his agent. There must also be filed in the Patent Office five copies of the print or label, one of which, when the print or label is registered, shall be certified under the seal of the commissioner of patents and returned to the proprietor.

"Before a print or label certificate will be delivered, the applicant must furnish a revenue stamp to the value of 10 cents, to be affixed thereto and canceled, as required by the 'Act to provide ways and means to meet war expenditures, and for other purposes,' approved June 13, 1898.

"The certificate of such registration will continue in force for twenty-eight years.

"The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate, and complying with all other regulations with regard to original applications. Within two months from the date of said renewal, the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

"The fee for registration of a print or label is \$6, to be paid in the same manner as fees for trade-marks.

"The attention of persons contemplating the registry of a print or label in the Patent Office is called to the decision of the United States supreme court in *Higgins v. Keuffel*, 55 O. G. 1139; 140 U. S. 428; to the decision of the United States circuit court in *Marsh et al. v. Warren et al.*, 14 O. G. 678, and to the decisions of the commissioner of patents in *Ex parte United States Playing Card Co.*, 82 O. G. 1209, and *Ex parte Mahn*, 82 O. G. 1210."

## FORMS.

The application for registration should be made by the proprietor or his agent, and the following are suggested as the proper forms to be used in the preparation of applications for prints and labels when filed by the proprietor. When filed by an agent they should be changed accordingly.

### FORMS OF APPLICATIONS FOR REGISTRATION OF PRINTS.

#### (1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, A. B., of the city of ———, county of ———, and state of ———, and a citizen of the United States [*or resident therein, as the case may be*], hereby furnishes five copies of a print which has never been published and which is to be used for advertising purposes for ———. The title of said print is ———, and the said print consists of the words and figures as follows, to wit: ——— [*description*].

And he hereby requests that the said print be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

A. B.,  
Proprietor.

Dated ———, 18—.

#### (2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of ———, state of ———, and doing business at No. ——— street, in said city, hereby furnish five copies of a print which has never been published and which is to be used for advertising purposes for ———. The title of said print is ———, and the said print consists of the words and figures as follows, to wit: ——— [*description*].

And they hereby request that the said print be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

C. D. & Co., Proprietors,  
By C. D., a member of the firm.

Dated ———, 18—.

## (3) FOR A CORPORATION.

To the Commissioner of Patents:

The applicant, a corporation duly created by authority of the laws of the state of ——— [or other authority, as the case may be], and doing business at ———, in said state, hereby furnishes five copies of a print which has never been published and which is to be used for advertising purposes for ———. The title of said print is ———, and the said print consists of the words and figures as follows, to wit: ——— [description].

And it is hereby requested that the said print be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

THE E. F. COMPANY,

By G. H., President [or other officer].

Dated ———, 18—.

## FORMS OF APPLICATIONS FOR REGISTRATION OF LABELS.

## (1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, A. B., of the city of ———, county of ———, and state of ———, and a citizen of the United States [or resident therein, as the case may be], hereby furnishes five copies of a label which has never been published and which is to be used on ———, of which he is the sole proprietor. The title of said label is ———, and the said label consists of the words and figures as follows, to wit: ——— [description].

And he hereby requests that the said label be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

A. B., Proprietor.

Dated ———, 18—.

## (2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of ———, state of ———, and doing business at No. ——— street, in said city, hereby furnish five copies of a label which has never been published and which is to be used on ———, of which they are the sole proprietors. The title of said label is ———, and the said label consists of the words and figures as follows, to wit: ——— [description].

And they hereby request that the said label be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

C. D. & Co., Proprietors,

By C. D., a member of the firm.

Dated ———, 18—.

## (3) FOR A CORPORATION.

To the Commissioner of Patents:

The applicant, a corporation duly created by authority of the laws of the state of —— [*or other authority, as the case may be*], and doing business at ——, in said state, hereby furnishes five copies of a label which has never been published and which is to be used on ——, of which it is the sole proprietor. The title of said label is ——, and the said label consists of the words and figures as follows, to wit: —— [*description*].

And it is hereby requested that the said label be registered in the Patent Office, in accordance with the act of congress to that effect approved June 18, 1874.

THE E. F. COMPANY,

By G. H., President [*or other officer*].

Dated ——, 18—.

## APPENDIX E.

### PENAL ACT OF AUGUST 14, 1876.

(19 Statutes at Large, 141.)

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:*

SECTION 1. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by a fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

SECTION 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any color-

able imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving or mold of any private label, brand, stamp, wrapper, engraving on paper or other substances or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully make, forge or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 6. That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade-mark, registered pursuant to the statutes of the United States, not so de-

faced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 7. That if the owner of any trade-mark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or moulds, of his said registered trade-mark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search-warrants, and may issue a search-warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner

for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trademarks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

SECTION 8. That any person who shall, with intent to defraud any person or persons, knowingly and wilfully aid or abet in the violation of any of the provisions of this act, shall upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.<sup>1</sup>

<sup>1</sup>This act is important because of its connection with the Trade-mark Cases, 100 U. S. 82. In that case the supreme court declared the act of 1870 to be unconstitutional because this act was by its express terms confined to frauds, counterfeits, and unlawful use of trademarks which were registered under the provisions of the former act. The registration act being invalid, the criminal enactment intended to protect the rights of registrants fell with it. Trade-mark Cases, 100 U. S. 82-99.

It was held that there could be no conviction under this act unless the certificate of registration contained words to show that the alleged owner acquired an exclusive property in the mark claimed. *United States v. Braun*, 39 Fed. Rep. 775.

This statute having been judicially declared void could not be and was not made operative by the enactment of the statute of 1881. *United States v. Koch*, 40 Fed. Rep. 250.



## APPENDIX F.

### TRADE-MARK ACT OF MARCH 3, 1881.<sup>1</sup>

An act to authorize the registration of trade-marks  
and protect the same.

*Be it enacted by the Senate and House of Representatives of  
the United States in Congress assembled :*

§ 1.<sup>2</sup> That owners<sup>3</sup> of trade-marks<sup>4</sup> used in commerce  
with foreign nations or with the Indian tribes,<sup>5</sup> pro-

<sup>1</sup>This act has been usually treated as valid. *South Carolina v. Seymour*, 153 U. S. 353; 67 Off. Gaz. 1191; *L. H. Harris Drug Co. v. Stucky*, 46 Fed. Rep. 624; *Hennessy v. Braunschweiger*, 89 Fed. Rep. 664. But in a late case Judge Jenkins said: "There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful." *Illinois Watch Case Co. v. Elgin National Watch Co.*, 94 Fed. Rep. 667-669; 87 Off. Gaz. 2323; 35 C. C. A. 237.

<sup>2</sup>See Notes, Act of 1870, sec. 77, *ante*, p. 300.

<sup>3</sup>Ownership is a prerequisite. A carpet cleaner was refused registration for the mark used by him on his wagons and upon carpets cleaned by him, because he could not comply with the clause of the act of 1870 requiring a statement of the class of merchandise and the particular description of goods to which he applied the mark. *Re Hankinson*, 8 Off. Gaz. 89. An official fish inspector has no trade-mark in the official brand used by him, because he has no private ownership therein. *Chase v. Mays*, 121 Mass. 343. A certificate of registration of trade-mark will not be issued to the applicant and his assignee jointly. *Ex parte Spinner*, 35 MSS. D., July, 1887. A trade-mark adopted by a real-estate dealer for use in the course of his business cannot be registered. *Ex parte Roy*, 54 Off. Gaz. 1267. When it appears that several parties have the right to the use of the mark, independent registration will not be granted to either of them. *Ex parte Langdon*, 61 Off. Gaz. 286. A certificate will not be issued to the assignee of the applicant. *Ex parte Roasted Cereals Co.*, 57 MSS. D. 455. Even when the assignment has been recorded. *Ex parte Bassett*, 55 Off. Gaz. 997; *Ex parte Spinner*, 35 MSS. D. 15.

Thus registration was refused where the facts showed that "applicant is a voluntary association or league of flour manufacturers, all members of which use the mark upon their product and have an interest severally and in common in its protection; and the present application for registration is made by the association through its

vided such owners shall be domiciled in the United

secretary, an officer duly authorized to that end. The applicant is not a corporation, nor is it, in strict use of the term, a partnership; but it is a voluntary association or league or union of the kind recognized by the laws and courts of the state of its domicile, and by the laws and courts of nearly all the states of the Union, as lawful and of the kind to which they extend protective and other relief in proper cases. As an association it does not itself make, brand, or sell the flour to which its mark is applied; but its members by its authority use the selected mark on wheat flour of their own manufacture. The league states its objects to be: 'To oppose the adulteration of flour, to assist in enforcing the law, to protect its honest millers from dishonest competition, to expose fraud, to maintain the integrity of the American milling trade, and to afford buyers a guarantee that they can obtain from members of this league absolutely pure flour.' As to its membership, the rule is: 'Any miller who does not adulterate flour can join this league upon the payment of ten dollars membership fee, and executing the affidavit and contract which are conditions of the membership.' . . . But the ownership of the mark is, by agreement of all interested parties, vested in the association, and the right to its use by any individual arises only from permission of the association and is subject to forfeiture upon failure to comply with the prescribed terms." The commissioner saying: "I can find no authority in the trade-mark act permitting this office to register a trade-mark, the right to use which is farmed out and which is not actually used by the would-be registrant. While the verified declaration accompanying the statement in this case sets forth that no other person, firm, or corporation has any right to use the mark, yet the brief of counsel shows that all of the members of the association, which is stated to be composed of a majority of the principal flour manufacturers of the United States, have a right, under certain conditions, to use the mark." Duell, Commissioner, in *Ex parte The Anti-Adulteration League*, 86 Off. Gaz. 1803.

A word to be used as the name of or mark for a patented article will not be admitted to registration. In so ruling the commissioner has said: "In view of the fact that under the trade-mark act of 1881 a certificate of registry remains in force for thirty years from its date, I do not think this office should register trade-marks which, though lawful trade-marks at the date when registry is sought, will become public property before the expiration of the thirty years. By so doing the patent office would be placed in the light of attempting to aid in prolonging a monopoly, which manifestly, under the decisions of the courts, is unwarranted. To thus attempt to give the petitioner a monopoly for many years longer than is given by the patent would be a fraud upon the public." Duell, Commissioner, in *Ex parte Velvrl Co.*, 84 Off. Gaz. 807. To the same effect see *Ex parte F. H. Gilson Co.*, 83 Off. Gaz. 1992.

States or located in any foreign country or tribe, which, by treaty, convention, or law,<sup>1</sup> affords similar privi-

<sup>4</sup>“Under the statute of March 3, 1881, ‘owners of trade-marks,’ under certain conditions as to use and upon compliance with certain requirements which need not now be considered, are entitled to obtain registration therefor. The phrase ‘owners of trade-marks’ manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark. It is therefore incumbent upon the various tribunals of the office having in charge the registration of trade-marks, when an application for registration is filed, to decide at the outset two questions: (1) Is applicant the *owner*, and (2) is that which he seeks to register a *trade-mark*? Manifestly the tribunals of this office, in deciding the question of ownership, are not precluded by the statement and declaration of ownership, made by the applicant from considering and deciding whether he is or is not the *owner* of the thing sought to be registered. It is not unusual to refuse registration because of the absence of legal title in the applicant—for example, when it appears that before applicant adopted and used his alleged mark the identical thing has been adopted and used by another. Equally is it the province and duty of the tribunals of the office having jurisdiction of the registration of trade-marks to decide whether the *thing* presented for registration is a *trade-mark*. An applicant may be the owner of the thing alleged to be his trade-mark, and yet the thing presented for registration may not be a trade-mark. The statement and declaration of applicant that the thing presented for registration is a trade-mark are not conclusive. The question is what the thing *is*, and not what it is *called*. That the statute vests in this office the power to pass upon these two questions I believe, and to pass upon such questions has been the uniform practice of my predecessors ever since the enactment of the trade-mark law of 1881.” Duell, Commissioner, in *Ex parte The Bronson Co*, 87 Off. Gaz. 1782; and in *Ex parte Buffalo Pitts Co*, 89 Off. Gaz. 2069.

<sup>5</sup>Commerce with the Indian tribes may be conducted wholly within the limits of a single state. “The power of congress is not determined by the locality of the traffic, but extends wherever intercourse with Indian tribes, or with any member of an Indian tribe, is found, although it may originate and end within the limits of a single state.” Prentice & Egan, Commerce Clause of the Federal Constitution, p. 346, citing *United States v. Holliday*, 3 Wall. 407; *Territory v. Guyott*, 9 Mont. 46.

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<sup>1</sup>The fact that a mark is lawful in a foreign country is no test of its registrability here. *Re Moet & Chandon*, 18 MSS. D. 259. In that case registration was refused although the mark had been registered in France. On the other hand, the words “Ger-

leges to citizens of the United States, may obtain regis-

mania" and "Goliath" have been registered in the United States by citizens of Germany, notwithstanding the fact that the words could not be registered in Germany as trade-mark, because it appeared that citizens of the United States had been permitted to register marks in Germany for which German citizens would not be allowed registration. *Re Manske & Co.*, 64 Off. Gaz. 858; *Re Schmidt*, 53 MSS. D. 7. Under this act a foreigner is entitled to no other or further rights than a citizen of the United States. *Ex parte Buffalo Pitts Co.*, 89 Off. Gaz. 2069.

The distinction between the terms "treaty" and "convention" is purely artificial. "A treaty is primarily a contract between two or more independent nations." Mr. Justice Field, in *Whitney v. Robertson*, 124 U. S. 190-194.

The International Convention for the Protection of Industrial Property, signed at Paris, March 20, 1883, and acceded to by presidential proclamation on behalf of the United States, March 29, 1887, cannot become operative in the absence of federal legislation. Opinions of the Attorney-General, 1889, p. 253; 47 Off. Gaz. 398; *Ex parte Zwack & Co.*, 76 Off. Gaz. 1855.

The following is a list of the existing international arrangements, by treaty or convention between the United States and foreign nations, with the date upon which such arrangements were severally consummated, and the appropriate references where they are given *in extenso*:

COUNTRY.	DATE.	REPORTED.
Austria-Hungary.....	July 1, 1872.	17 Stat. at L. 917.
Belgium (now obsolete).....	July 30, 1869.	16 Stat. at L. 765.
Belgium.....	July 9, 1884.	29 Off. Gaz. 452.
Brazil.....	June 17, 1879.	21 Stat. at L. 659.
Denmark.....	Oct. 12, 1892.	
France.....	July 6, 1869.	16 Stat. at L. 771.
Germany.....	June 1, 1872.	17 Stat. at L. 921.
Great Britain.....	July 17, 1878.	14 Off. Gaz. 233.
Italy.....	March 19, 1884.	27 Off. Gaz. 304.
Japan.....	March 9, 1897.	
Russia.....	Oct. 15, 1868.	16 Stat. at L. 725.
	Nov. 24, 1874.	
Servia.....	Dec. 27, 1882.	22 Stat. at L. 966.
Spain.....	April 19, 1883.	25 Off. Gaz. 98.
Switzerland.....	May 16, 1883.	23 Off. Gaz. 2237.
The Netherlands.....	Feb. 16, 1883.	23 Off. Gaz. 1334.

NOTE.—For treaties and conventions, 1776-1887, see "Treaties and Conventions Between the United States and Other Powers:" Government Printing Office, 1889.

The declaration with Great Britain is drawn so as to confer mutual trade-mark rights upon the subjects and citizens of each of the con-

tration<sup>1</sup> of such trade-marks by complying with the following requirements:

1st. By causing to be recorded in the Patent Office a

tracting parties throughout the dominions and possessions of the other. Citizens or residents of British colonies are therefore permitted to register their trade-marks under this treaty whenever it is satisfactorily shown that in the respective colonies similar protection is afforded to citizens of the United States.

#### LIST OF TRADE-MARK LAWS OF FOREIGN NATIONS.

The trade-mark laws of the following countries have been published in the Official Gazette:

COUNTRY.	VOLUME.	PAGE.	DATE.
Argentine Republic.....	42	333	January 24, 1888
Austria-Hungary .....	52	1539	September 2, 1890
“ “ .....	59	1611	June 14, 1892
Bulgaria.....	65	137	October 3, 1893
Brazil.....	45	235	October 9, 1888
Denmark.....	54	1419	March 10, 1891
Germany.....	31	1447	June 23, 1885
“ “ .....	71	145	April 2, 1895
Greece.....	69	126	October 2, 1894
Italy.....	24	102	July 3, 1883
Japan.....	48	1402	September 3, 1889
“ “ .....	70	1503	March 12, 1895
“ “ .....	88	1899	September 5, 1899
Mexico.....	51	809	May 6, 1890
Netherlands.....	23	1334	April 3, 1883
“ “ .....	66	174	January 2, 1894
“ “ .....	66	321	January 16, 1894
Portugal.....	70	279	January 8, 1895
Roumania.....	55	1653	June 23, 1891
Servia .....	75	1035	May 12, 1896
Switzerland.....	23	2237	June 5, 1883
Victoria.....	33	501	October 27, 1885

<sup>1</sup>“Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark; or in cases where it is necessary to give jurisdiction to the United States courts.” Hawley, J., in *Hennessy v. Braunschweiger*, 89 Fed. Rep. 664. To the same effect see *Waukesha Hygeia Mineral Springs Co. v. Hygeia Distilled Water Co.*, 70 Off. Gaz. 1319; 63 Fed. Rep. 438; 11 C. C. A. 277; *Sarrazin v. W. R. Irby Cigar & Tobacco Co.*, 93 Fed. Rep. 624-627; *Brower v. Boulton*, 53 Fed. Rep. 889; *Adams v. Heisel*, 31 Fed. Rep. 279-281.

*The act does not define trade-marks.*—“It will be observed that the statute (referring to the act of 1870) does not define the term ‘trade-mark,’ or say of what it shall consist. The term is used as though

statement specifying name,<sup>1</sup> domicile,<sup>2</sup> location,<sup>3</sup> and citizenship<sup>4</sup> of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated;<sup>5</sup> a description of the trade-mark

its signification was already known to the law. It speaks of it as an already existing thing, and protects it as such. The thing to be protected must be an existing lawful trade-mark, or something that may then for the first time be adopted as a lawful trade-mark independent of the statute. There must be a lawful trade-mark adopted without reference to the statute, and then, by taking the prescribed steps, that trade-mark, so already created and existing, may receive certain further protection under the statute." *Moorman v. Hoge*, 2 Sawy. 78. The reasoning of this opinion is equally applicable to the act of 1881. *L. H. Harris Drug Co. v. Stucky*, 46 Fed. Rep. 624-628; *Ex parte M. Block & Co.*, 40 Off. Gaz. 443.

<sup>1</sup>See Trade-mark Rules 21, 22, 23 and 24 of the Patent Office, *ante*, p. 285. The christian name of the applicant should be given in all cases, instead of the initial only. *Monroe Cattle Co. v. Becker*, 147 U. S. 47.

<sup>2</sup>Domicile, *i. e.*, the place of residence of the applicant; "that place in which he has fixed his habitation, without any present intention of departing therefrom." *Gordon, J., in Carey's Appeal*, 75 Pa. St. 201-205.

<sup>3</sup>Where an application shows the applicant to be a citizen of one foreign country and located in another, his application will be governed by the existing treaty, convention or law of the country of his location. By location is meant the *situs* of the factory or other place of business of the applicant. *Re Haggemacher*, 60 Off. Gaz. 438.

<sup>4</sup>What the applicant's citizenship may be is wholly immaterial. His right to registration is governed by the country of his location, which may or may not be identical with that of his citizenship. *Re Haggemacher, supra*.

*Citizenship defined.*—Citizenship means "residence with intention of remaining permanently at that place. A man may reside in a state for an indefinite period of time without becoming a citizen, but the moment a man takes up his residence in a state different from that where he formerly was domiciled or was a citizen, with intent and purpose of making the new place of residence his future home, that moment he loses his former domicile, and becomes domiciled in the new place; or, in other words, he ceases to be a citizen of the former place of residence and becomes a citizen of the state of his adoption." *Turner, J., in Winn v. Gilmer*, 27 Fed. Rep. 817.

<sup>5</sup>The fact that the Amoskeag Manufacturing Company had applied its mark to cotton goods except prints did not give it an exclusive right to its use on all cotton goods including prints. *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151. The term "Fancy Goods" includes too

itself<sup>1</sup> fac-similes thereof,<sup>2</sup> and a statement of the mode

many sub-classes to be allowed in one registration. *Re Lisner*, Comm. Decis. 1878, p. 46. Registration has been refused for a mark to cover an indurated blood compound and the various articles, such as door knobs, to be made from it. *Re Dibble Mfg. Co.*, 18 MSS. D. 428. Application for registration of a mark to be used upon druggists' sundries was refused because the words were too indefinite. *Re Maw, Son & Thompson*, 22 MSS. D. 403.

*What one registration may cover.*—A single trade-mark may be registered to be applied to all goods made of hard rubber. *Re India Rubber Comb Co.*, 16 MSS. D. 38. Bourbon, wheat and rye whiskies, wines, brandies and gins, may be included in one registration. *Re Boehm & Co.*, Comm. Decis. 1875, p. 103; as may "agricultural implements," *Re Manny & Co.*, 17 MSS. D. 155; "canned goods," *Re Fitzpatrick, Davis & Co.*, 18 MSS. D. 278; and "cutlery," *Re Kampfe Bros.*, 58 MSS. D. 306; as well as proprietary medicinal and toilet compounds, *Re Knight*, 38 MSS. D. 341. The Patent Office has published a classification, not of an official character. Supplement to Official Gazette, Jan. 1, 1897, division 33. One registration may, however, cover all the classes of goods upon which the trade-mark has been used. *Ex parte Clark-Jewell-Wells Co.*, 83 Off. Gaz. 915. But a picture and a word cannot be embodied in the same registration unless they are true alternatives. *Ex parte J. D. Richards & Sons*, 54 MSS. D. 425; *Ex parte Adam Roth Gro. Co.*, 62 Off. Gaz. 315; *Ex parte Kinney*, 72 Off. Gaz. 1349; *Ex parte Muir*, 87 Off. Gaz. 357; *Ex parte Lazarus Schwarz & Lipper*, 64 Off. Gaz. 1396.

<sup>1</sup>The description must distinguish the essential from the non-essential features of the mark. *Re Volta Belt Co.*, 8 Off. Gaz. 144. The essential features being those serving to distinguish the goods of the applicant, an essential feature cannot be anything that is not a valid trade-mark, such as the geographical word "Lancaster." *Re Farnum & Co.*, Comm. Decis. 1880, p. 155; 18 Off. Gaz. 412; *Re Adriance, Platt & Co.*, Comm. Decis. 1881, p. 52; 20 Off. Gaz. 1820; *Re Pierce*, 23 MSS. D. 16. The description and fac-simile incorporated in the certificate of registration are evidence to show the extent of the owner's claim of trade-mark, when he sues for its protection as a common-law trade-mark. *Richter v. Reynolds*, 59 Fed. Rep. 577; *Kohler Mfg. Co. v. Beeshore*, 53 Fed. Rep. 262; s. c., 59 Fed. Rep. 215. The essential feature of a trade-mark is not that which the registrant elects to designate as such, but that which would strike the public mind as its most salient feature. *Ex parte Standard Fashion Co.*, 89 Off. Gaz. 189.

<sup>2</sup>This section does not contemplate registration of form, material, or color. Materials are not subject to appropriation as trade-mark; it has been so held in regard to tin used as tags upon plug tobacco, *Lorillard v. Pride*, 28 Fed. Rep. 434; nor is a method of bronzing horse-shoe nails, *Putnam Nail Co. v. Bennet*, 43 Fed. Rep. 800; 59 Fed. Rep. 909; 8 C. C. A. 362; nor the form of sticks of chewing gum,

in which the name is applied and affixed to goods,<sup>1</sup> and the length of time during which the trade-mark has been used.<sup>2</sup>

Adams v. Heisel, 31 Fed. Rep. 279; nor the method in which goods are arranged in packages, Ibid., and Davis v. Davis, 27 Fed. Rep. 490.

For further discussion of form, color, etc., see *ante*, pp. 166-172.

A fac-simile need not contain any unessential portion of the mark sought to be registered. Re Watson, 16 MSS. D. 467; Re Armstrong & Co., 26 MSS. D. 260.

One fac-simile only is sufficient to illustrate the mode of using the mark. Re Kimball, Comm. Decis. 1887, p. 54.

*Fac-simile defined.*—"A fac-simile is an exact counterpart of an original, and a fac-simile represented by a drawing is an exact counterpart of an original, so far as the nature of a drawing permits. A close adherence to the language of the statute would seem to require that in each case the trade-mark and nothing but the trade-mark should be represented by the drawing, and while, perhaps, it would be going too far to apply in all cases a rule so rigorous, it is certainly within the discretion of the office to insist upon it in cases where . . . legitimate doubts arise as to whether protection should not be sought through the law relating to designs. In my judgment the cases are very rare in which the registration of a trade-mark under the statute requires or should permit of any other matter than the fac-simile of the trade-mark." Mitchell, Commissioner, in *Ex parte Hudson*, 55 Off. Gaz. 1401. Applicants are restricted to symbols which conform to their fac-similes as well as to their verbal descriptions. *Duke v. Green*, 16 Off. Gaz. 1094.

<sup>1</sup>The statement of the mode of application must be given. *Ex parte Hudson*, 55 Off. Gaz. 1401. It must appear that the trade-mark is intended to be used upon "goods or manufactured articles, the general objects of commerce." *Ex parte Roy and Nourse*, 54 Off. Gaz. 1267. The use of a trade-mark upon bill-heads, letter-heads, cards and circulars used in a business does not come within the contemplation of the statute; although it would be properly a trade-mark if used thereon as articles of commerce and not as mere vehicles of communication between a dealer and other persons. Ibid. The things to which a trade-mark may be affixed so as to be entitled to registration are goods, wares and merchandise—articles that may be transported, in contradistinction to those fixed species of property which the law includes under the term real estate. Ibid. Registration under this act is limited to marks used upon manufactures or merchandise. *Re Hankinson*, 8 Off. Gaz. 89. It is a sufficient application if the mark is used in advertising, and a lithographed reproduction of it inserted in each box containing the merchandise. *Hay & Todd Mfg. Co. v. Querns Brothers*, 86 Off. Gaz. 1323.

<sup>2</sup>The language of the Act of 1871 was "the length of time, *if any*, during which the trade-mark has been used." This was construed



2d. By paying into the treasury of the United States the sum of twenty-five dollars,<sup>1</sup> and complying with such regulations as may be prescribed by the Commissioner of Patents.

§ 2.<sup>2</sup> That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm,<sup>3</sup> or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resem-

to admit marks to registration that never had been used in commerce. *Re Rothschild*, 7 Off. Gaz. 220. It must now be shown as a prerequisite to registration that there has been actual application of the mark to merchandise and actual user in commerce. *United States v. Seymour*, 66 Off. Gaz. 1167. Registration under this statute avails nothing if the name or symbol is never used. *Siebert v. Abbott*, 72 Hun, 243.

It was held in one case that a citizen of France who had not deposited his mark in the Patent Office under the provisions of the treaty of 1869 between the United States and France could not maintain an action for infringement. *Lacroix v. Escobal*, 37 La. Ann. 533. But in a later case it is held that a registration under the Act of 1881 by a French citizen renders the deposit of the mark under the terms of that convention unnecessary. *Société de la Benedictine v. Micalovitch*, 36 Alb. L. J. 364. The dates of adoption set forth in the applications of two rival registrants are not conclusive. *Einstein v. Sawhill*, 61 Off. Gaz. 287. Where actual user appears to have been first made after application for registry, the mark may be admitted to registration upon the filing of a supplemental application. *Einstein v. Sawhill* (2), 64 Off. Gaz. 1333.

<sup>1</sup>The fee cannot be refunded because registration is refused. *Re Thayer*, 54 Off. Gaz. 957. Where the domestic branch of a house having offices in the United States and abroad, filed an application in ignorance of the fact that an identical application had been made by one of the foreign offices, the fee paid on the second application was refunded. *Re Finlayson, Bousfield & Co.*, 61 Off. Gaz. 152.

<sup>2</sup>See Act of 1870, sec. 77, *ante*, p. 300.

<sup>3</sup>An application of a partnership cannot properly be made by one not a member of the firm but merely a so-called "director." *Ex parte Kirker, Greer & Co. (Ltd.)*, 37 MSS. D. 392.

blance thereto as might be calculated to deceive,<sup>1</sup> that such trade-mark is used on commerce with foreign nations or Indian tribes, as above indicated,<sup>2</sup> and that the description and fac-similes presented for registry truly represent the mark sought to be registered.<sup>3</sup>

§ 3.<sup>4</sup> That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully<sup>5</sup> used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the

<sup>1</sup>Registration will be refused whenever in the opinion of the commissioner the mark offered is so similar to a registered mark as to be likely to lead to mistake or confusion. *Ex parte Coon*, 58 Off. Gaz. 946. In case of doubt concerning such similarity, that doubt will be resolved against the applicant. *Re Bowe*, 50 MSS. D. 168; *Re Bogardus*, 50 MSS. D. 2.

<sup>2</sup>The declaration on oath that there has been a user of the mark in the classes of commerce specified is insisted on by the Patent Office. *Ex parte Strasburger & Co.*, 20 Off. Gaz. 155.

<sup>3</sup>A word and a figure which are true alternatives constitute a single mark. *Morrison v. Case*, 9 Blatchf. 548; 2 Off. Gaz. 544. Hence they may be covered by one registration. *Re Weaver*, 10 Off. Gaz. 1; *Ex parte Kinney*, 72 Off. Gaz. 1346. But where they are not true alternatives, as in the case of the word "Crescent" and the figure of the crescent moon, and the word and figure might convey wholly different meanings to the observer, they will not be registered upon a single application. *Ex parte Lazarus Schwarz & Lipper*, 64 Off. Gaz. 1396; *Ex parte Roth Grocery Co.*, 62 Off. Gaz. 315.

<sup>4</sup>See Act of 1870, secs. 79, 80, *ante*, pp. 305-309. The fact that this act does not expressly exclude descriptive words from registration does not raise a presumption that descriptive words should be admitted to registration. *L. H. Harris Drug Co. v. Stucky*, 46 Fed. Rep. 624-627.

<sup>5</sup>See cases cited in note 5 to sec. 79 of the Act of 1870, *ante*, p. 305.

A mark that is deceptive in its nature will not receive registration. *Ex parte Bloch & Co.*, 40 Off. Gaz. 443; *Re Chichester Chemical Co.*, 52 Off. Gaz. 1061; *Re American Sardine Co.*, Comm. Decis. 1873, p. 82; *Re Grove*, 67 Off. Gaz. 1447. The coat-of-arms of the United States, or either of the states, will not be admitted to registration. *Ex parte Schmachtenberg Bros.*, 51 MSS. D. 204.

Nor will a descriptive word: as "Albany Beef," for canned sturgeon, *Re Ames*, 23 Off. Gaz. 344; "Chili Colorow," for table sauce, *Re Railton*, 25 MSS. D. 321; "Time-Keeper," for watches, *Ex parte*

name of the applicant,<sup>1</sup> nor which is identical with a registered or known trade-mark<sup>2</sup> owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind

Strasburger & Co., 20 Off. Gaz. 155; "Cristalline," for artificial jewels, Ex parte Kipling, 24 Off. Gaz. 899.

Nor a picture or word that is descriptive or deceptive. Ex parte Martin, 89 Off. Gaz. 2258; Ex parte Wolf, 80 Off. Gaz. 1271; Ex parte Grove, 67 Off. Gaz. 1447.

Nor a geographical word: as "Cromarty," for dried fish, Re Proctor, Jr., 51 Off. Gaz. 1785; "Trenton," for saws, Re American Saw

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<sup>1</sup>This prohibition is strictly enforced. Even a name used as a mark for twenty years, and admitted to registration under the act of 1870 has been refused registration under this statute. Re Fairchild, 21 Off. Gaz. 789. Congress by an enactment under date of August 5, 1882, provided: "That nothing contained in the law (of March 3, 1881), shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act." 22 Stats. at Large, p. 298. This proviso has admitted to registration names of corporations, as, for example, the words "Union Metallic Cartridge Co.," which were in use as merchandise marks prior to March 3, 1881. But no name of a corporation not used prior to that time as a mark can now be admitted to registration. Ex parte Creedmore Cartridge Co., 56 Off. Gaz. 1333. And see note to the act of August 5, 1882. Registration has been refused to a name as part of a trade-mark which also included a device. Ex parte Adriance, Platt & Co., 20 Off. Gaz. 1820. But a name used as part of an old combination trade-mark has been admitted to registry. Ex parte Frieberg & Workum, 20 Off. Gaz. 1164. A proper name joined to a geographical name does not constitute a valid trade-mark, therefore "Buffalo Pitts" was refused registration as a trade-mark for threshing machines. Ex parte Buffalo Pitts Co., 89 Off. Gaz. 2069.

<sup>2</sup>Registration has been refused where the applicant's mark, "Triumphphant" for flour, had been registered by another under the act of 1870, and not re-registered under the act of 1881. Ex parte Lyon, Dupuy & Co., 28 Off. Gaz. 191; Dyrenforth, Acting Commissioner, tersely observing that "To decide otherwise would be to open Pandora's box and turn loose fraud upon individuals and imposition upon the public." The fact that the applicants used the mark in foreign commerce while the record did not show the registrant to have done so was held immaterial. Ibid; and to the same effect, Yale Mfg. Co. v. Yale, 30 Off. Gaz. 1183. A trade-mark consisting of a design will not be admitted to registration, where the same design has been embodied in a design patent granted to another. Ex parte Lee & Shepard, 24 Off. Gaz. 1271.

of the public, or to deceive purchasers.<sup>1</sup> In an application for registration the commissioner of patents shall decide the presumptive lawfulness of claim to the alleged

Co., 58 Off. Gaz. 521; "Cloverdale," Re Hendley, 72 Off. Gaz. 1654. In many instances, however, where the commissioner has deemed the geographical word to be used in a purely arbitrary sense it has been admitted to registration. Re Cornwall & Bros., 12 Off. Gaz. 312; Ex parte Tietgens & Robertson, 87 Off. Gaz. 2117. The following extracts from leading rulings of the Patent Office may serve as guides for applicants seeking registration for geographical words. Their registrability "is to be determined in view of the circumstances of each particular case. . . . One geographical name might be either descriptive or deceptive; another geographical name applied to the same article might be neither." Thus, it was held that it having become a common practice to apply the words "Irish," "Limerick," etc., to soap, there was no objection to registering the word "Dublin," as applied to soap; in view of the state of the trade and the nature of the article, "Dublin" applied to soap manufactured in this country, was neither descriptive nor deceptive. This doctrine was announced in a decision of Acting Commissioner Doolittle, refusing registration for the word "French" as applied to American made paints on the ground that it was deceptive. Re J. Marsching & Co., 15 Off. Gaz. 294. In a later decision, refusing registration to the word "Cloverdale" as a trade-mark for canned fruits and vegetables, Acting Commissioner Fisher announced the following classification: "Geographical names may for convenience

<sup>1</sup>The commissioner must decide, "first, if the applicant has actually used the trade-mark in lawful commerce with foreign nations or with the Indian tribes, and then if he has the right to the use of it at all. If he finds that the alleged trade-mark is the name of the applicant or any other name which cannot lawfully be converted into a trade-mark at common law, or that it is identical with the trade-mark of another, registered or unregistered, or is a deceptive imitation of another, or that it is not the property of the applicant, he cannot admit it to registration, though he may be satisfied that the applicant has used it in regular commerce with foreign nations or the Indian tribes." Court of Appeals, District of Columbia, by Sheppard, J., in *United States v. Seymour*, 66 Off. Gaz. 1167-1169. Where a part of the applicant's mark was the word "Railway," which word had been registered by another, the application was refused. Ex parte Strasburger & Co., 20 Off. Gaz. 155. The question presented to the commissioner upon an issue of anticipation is "whether the trade-mark sought to be registered is so similar to any trade-mark already registered for use upon the same class of articles as to be calculated to deceive purchasers using ordinary caution." Frothingham, Assistant Commissioner, in Ex parte George B. Hurd & Co., 59 Off. Gaz. 1763; and to the same effect, Ex parte Coon, 58 Off. Gaz. 946.

trade-mark;<sup>1</sup> and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.<sup>2</sup>

be divided into three classes; first, those that are well known and in common use—such, for example, as ‘United States,’ ‘New York,’ ‘San Francisco,’ etc. The law is settled that words coming under this class ought not to be registered. The second class includes words which in their primary significance are not geographical, even though they may appear in the Postal Guide or similar publications. Such words as ‘trilby,’ ‘creole,’ ‘puritan’ and ‘volunteer,’ are good examples of this class. These words, it seems to me, ought not to be refused registration on the ground that they are geographical, since it cannot fairly be said that they are ‘words in common use as designating locality or section of a country.’ The third class would logically occupy a position between the two classes mentioned above, and it consists of words which primarily have a geographical meaning—for example, terms ending or compounded with such words as ‘city,’ ‘town,’ ‘shire,’ ‘mount,’ or ‘mont.’ Such words, I think, should not be registered, for the reason that they are clearly geographical in their primary significance, even if it cannot be said that they are widely enough known to come strictly under the first class. It seems to me that the word in question, ‘Cloverdale,’ clearly comes under the third class.” Ex parte Hendley, 72 Off. Gaz. 1654. A geographical word does not become properly registrable by being enclosed in a geometrical figure. So the word “Yucatan” was refused registration as a mark for leather, even though enclosed in a square figure. Ex parte Weil, 83 Off. Gaz. 1802.

<sup>1</sup>No court can grant registration nor direct the action of the commissioner by *mandamus*. His duties are not ministerial, but require the exercise of judgment and discretion. His performance of those duties will not be reviewed on or controlled by *mandamus*. United States v. Seymour, 66 Off. Gaz. 1167-1172.

<sup>2</sup>Under this provision the commissioner has power to declare an interference, even between a partnership and one of its members. If the applicant shows better title he will be admitted to registration notwithstanding a prior registry. Yale Mfg. Co. v. Yale, 30 Off. Gaz. 1183. In such a case the burden of proof to establish priority is upon the applicant. Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721. In cases of interference the question presented to the commissioner is substantially the same as would arise in a court of equity if either of the parties were seeking to enjoin the other from the use of the mark. Ibid. In interferences the issue is as broad as the broadest claim. S. Hershheim Bros. & Co. (Ltd.) v. J. H. Hargrave & Son, 81 Off. Gaz. 503; Joseph Banigan Rubber Co. v.

§ 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America under the seal of the Department of the Interior, and shall be signed by the commissioner of patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade-marks shall be brought in controversy.<sup>1</sup>

§ 5. That a certificate of registry shall remain in force for thirty years from this date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property else-

Bloomington, 89 Off. Gaz. 1670. By section 9 of the act establishing the court of appeals of the District of Columbia that court is given the determination of appeals from the decision of the commissioner of patents "in any interference case." That court has held that this clause does not refer to or include trade-mark interferences. *Einstein v. Sawhill*, 65 Off. Gaz. 1918. An applicant presented for registration a mark substantially the same as one registered by another under the act of 1870, which had not been re-registered under the act of 1881. Registration was refused by the examiner. The applicant then sought to institute an interference; this was refused because the former registration was void. Under all the facts the commissioner notified the registrant under the act of 1870 that an application for registry was pending with which his registry would interfere if it were a registry under the act of 1881, and that sixty days would be allowed wherein the former registrant might make an application under the act of 1881 with a view to interference. *Ex parte American Lead Pencil Co.*, 61 Off. Gaz. 151. The decision of the commissioner of patents upon interference proceedings renders the issues presented to him *res adjudicata* and they cannot be reopened in a subsequent proceeding between the parties. *Hanford v. Westcott*, 16 Off. Gaz. 1181. It is the privilege of the applicant for registration to withdraw his application as soon as the interference is declared, and seek redress in the courts. If he elects to proceed before the commissioner he is bound by the decision of the commissioner. *Ibid.*

<sup>1</sup>See Act of 1870, sec. 80, *ante*, p. 309.

where. At any time during the six months prior to the expiration of thirty years, such registration may be renewed on the same terms and for a like period.<sup>1</sup>

§ 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the treasury of the United States with intent to procure protection for the same trade-mark.<sup>2</sup>

§ 7. That registration of a trade-mark shall be *prima facie* evidence of ownership.<sup>3</sup> Any person who shall reproduce, counterfeit, copy or colorably imitate any trade-mark registered under this act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration,<sup>4</sup> shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.<sup>5</sup>

<sup>1</sup>See Act of 1870, sec. 78, *ante*, p. 304.

<sup>2</sup>The fee for registration under the act of 1881 is required to be paid upon filing the application. See Patent Office Rules, *ante*, rule 22, p. 285.

The sum of \$10 paid as a first fee under the act of 1870 is credited upon this payment on applications pending in the Patent Office when the act of 1881 went into effect. See Patent Office Rules, *ante*, rule 19, p. 284.

But all persons to whom registration was granted under the act of 1870 are entitled to register under this act without additional charge. *Jacoby & Co. v. Lopes & Co.*, 23 Off. Gaz. 342.

<sup>3</sup>Thus the registration of a mark by another throws the burden of proving priority upon one who subsequently applies for registration for the same mark. *Manitowoc Mfg. Co. v. Dickerman*, 57 Off. Gaz. 1720. See Act of 1870, secs. 78, 79; *ante*, pp. 304, 305.

<sup>4</sup>As to what is "merchandise of substantially the same descriptive properties," see *Air-Brush Mfg. Co. v. Thayer*, 84 Fed. Rep. 640; *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206.

<sup>5</sup>Registration of a mark common to the trade does not confer an exclusive right to its use. *Stachelberg v. Ponce*, 128 U. S. 686. Reg-

§ 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.<sup>1</sup>

§ 9. That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the commissioner of patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damage sustained in consequence thereof to the injured party, to be recovered in an action on the case.<sup>2</sup>

§ 10. That nothing in this act shall prevent, lessen, impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.<sup>3</sup>

§ 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trade-

istration of a mark is not conclusive. It may be restrained at the suit of one who has a prior right to its use. *Glen Cove Mfg. Co. v. Ludeman*, 23 Blatchf. 46; 22 Fed. Rep. 824, 826; *Schumacher v. Schwenke* (2), 36 Off. Gaz. 457; *Hennessy v. Braunschweiger*, 89 Fed. Rep. 664.

The registrant will not be protected in the use of his trade-mark if it is found to contain a material false representation. *Seabury v. Grosvenor*, 14 Blatchf. 262.

*Jurisdictional amount.*—The amount in controversy is the value of the trade-mark. *Symonds v. Greene*, 28 Fed. Rep. 834; *Hennessy v. Herrmann*, 89 Fed. Rep. 669.

<sup>1</sup>This provision is merely in declaration of the common law. See Act of 1870, sec. 84, *ante*, p. 311.

<sup>2</sup>See Act of 1870, sec. 82, *ante*, p. 310.

<sup>3</sup>See Act of 1870, sec. 83, *ante*, p. 310. "The present act does not abridge or qualify the common-law right, but by the express term of section 10 preserves it intact." *Wallace, J., in LaCroix v. May*, 15 Fed. Rep. 236.



mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.<sup>1</sup>

§ 12. That the commissioner of patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office.<sup>2</sup>

§ 13. That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.<sup>3</sup>

<sup>1</sup>See Act of 1870, sec. 78, *ante*, p. 304.

Where both parties are citizens of the same state the averments of the complaint must show that both the parties are using the mark in commerce with foreign nations or with the Indian tribes. *Ryder v. Holt*, 128 U. S. 525; *Luyties v. Hollender* (1), 21 Fed. Rep. 231; *Schumacher v. Schwenke*, 26 Fed. Rep. 818; *Luyties v. Hollender* (2), 30 Fed. Rep. 632; *Gravely v. Gravely*, 42 Fed. Rep. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493. Such an averment is necessary only where the proceeding is between citizens of the same state. It is not necessary where the complainant is an alien. *Hennessy v. Braunschweiler*, 89 Fed. Rep. 664.

<sup>2</sup>See Act of 1870, sec. 81. This section provides for transfers only being registered. An instrument affecting the use of a trade-mark, but not amounting to a transfer or assignment thereof, cannot legally be registered in the Patent Office. *Waukesha Springs Co. v. Hygeia Water Co.*, 63 Fed. Rep. 438-442.

<sup>3</sup>"One reading the section would infer that foreigners have been allowed under the preceding sections some privilege; but a careful reading of the act fails to disclose that a foreigner is entitled to any other or further rights than those given to citizens of the United States. The phrase 'as is above allowed to foreigners' renders the section meaningless." Duell, Commissioner, in *Ex parte Buffalo Pitts Co.*, 89 Off. Gaz. 2069.

## APPENDIX G.

ACT OF AUGUST 5, 1882.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:*

That nothing contained in the law entitled "An act to authorize the registration of trade-marks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.<sup>1</sup>

Approved August 5, 1882.

### PROTECTION OF TRADE-MARKS IN TERRITORY SUBJECT TO MILITARY GOVERNMENT BY UNITED STATES FORCES.

Circular No. 12.—Division of Customs and Insular Affairs.

WAR DEPARTMENT,  
WASHINGTON, D. C., April 11, 1899.

The following is published for the information and guidance of all concerned:

In territory subject to military government by the military forces of the United States, owners of patents, including design patents, which have been issued or which may hereafter be issued, and owners of trade-marks, prints and labels, duly registered in the United States Patent Office under the laws of the United States relating to the grant of patents and to the registration

<sup>1</sup>This act applies only to such marks as were lawful trade-marks prior to March 3, 1881, and only such marks can be admitted to registration. Long prior to 1881 it had been established that no one could exclusively appropriate a surname as a trade-mark. Therefore a surname cannot be registered under the act of 1881. Ex parte Gale Mfg. Co., 85 Off. Gaz. 1907.

of trade-marks, prints and labels, shall receive the protection accorded them in the United States under said laws; and an infringement of the rights secured by lawful issue of a patent or by registration of a trade-mark, print or label, shall subject the person or party guilty of such infringement to the liabilities created and imposed by the laws of the United States relating to said matters: Provided, that a duly certified copy of the patent or of the certificate of registration of the trade-mark, print or label, shall be filed in the office of the governor-general of the island wherein such protection is desired; and provided further, that the rights of property in patents and trade-marks secured in the islands of Cuba, Porto Rico, the Philippines and other ceded territory, to persons under the Spanish laws, shall be respected in said territory, the same as if such laws were in full force and effect.

G. D. MEIKLEJOHN,  
Acting Secretary of War.

(87 Off. Gaz. 361.)

Circular No. 21.—Division of Customs and Insular Affairs.

WAR DEPARTMENT,  
WASHINGTON, D. C., June 1, 1899.

The following is published for the information and guidance of all concerned:

Parties who desire protection in territory under government of the military forces of the United States for patents, trade-marks, prints or labels, as provided in Circular No. 12, division of customs and insular affairs, war department, should forward a certified copy of the patent or of the certificate of registration of the trade-mark, print or label, together with a letter of transmittal to the governor-general, requesting that such copy be filed in his office for reference.

Upon the receipt of such certified copy the governor-general will issue his formal receipt therefor and forward it to the party filing the same.

A fee of one dollar will be charged for filing such copy and should be inclosed with the letter of transmittal to the governor-general.

The requirements for filing under the provisions of Circular No. 12, above referred to, apply only to patents duly issued, and to trade-marks, prints or labels duly registered in the United States Patent Office under the laws of the United States. The only certification required is that issued by the commissioner of patents. Communications should be addressed to the Governor-General of Cuba, Havana, Cuba; or Governor-General of Porto Rico, San Juan, Porto Rico; or Governor-General of the Philippine Islands, Manila, Philippine Islands.

G. D. MEIKLEJOHN,  
Assistant Secretary of War.

(88 Off. Gaz. 1.)

## APPENDIX H.

### FORMS OF BILLS AND ANSWERS.

#### DECLARATION.

(Warner v. Roehr, Fed. Case No. 17189A.)

In the Circuit Court of the United States in and for the  
Northern District of Illinois.

HULBERT H. WARNER, trading and doing business under the name and style of H. H. WARNER & Co., vs.	} No. 18765. Case. Damages, \$25,000.
FRANK ROEHR.	

H. H. W., a citizen of the state of New York, trading and doing business under the firm name and style of H. H. W. & Co., at the city of Rochester, in the county of Monroe, in said state of New York, plaintiff, by W. H. B. and J. F. L., his attorneys, complains of F. R., a citizen of the state of Illinois, and residing and doing business at the city of Chicago, in the county of Cook, in the said state of Illinois and in the district aforesaid, defendant, of a plea of trespass on the case.

For that whereas, the said plaintiff shows that for several years last past he has been engaged, at the said city of Rochester, in the manufacture and sale of a certain medicinal preparation known as "Warner's Safe Kidney and Liver Cure," which preparation has become widely known through the domain of commerce, and especially in all parts of the United States, as a valuable medicine for various kinds of diseases of human beings.

That in the introduction of said medicinal preparation, and to bring it to the attention of the public, he expended in advertising the sum of about five hundred thousand dollars (\$500,000), and in various ways has expended enormous sums of money to that end; that for a better protection of his right as proprietor, manufacturer and vendor of said medicine he has caused peculiar bottles to be manufactured to contain the same, which bottles have blown into the glass thereof the name of said medicine, and which name contains a word-symbol, to wit, the word "Safe," as the essential element of a trade mark, and also the symbolic "trade-mark" consisting of the representation of a fire-proof safe; which said "trade-mark" is his sole property, no other person, firm or corporation having a right to the

use of the same, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, nor to affix to medicine or merchandise of substantially the same descriptive properties as his medicine aforesaid.

That being the owner of said "trade-mark," by virtue of priority of adoption, in connection with said medicine, this plaintiff caused the same to be recorded in the Patent Office of the United States, with a statement specifying his name, domicile, location and citizenship; the class of merchandise and the particular description of goods comprised in the class to which the particular "trade-mark" had been appropriated by him; also a description of the "trade-mark" itself with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods and the length of time during which the said "trade-mark" has been used by him for the purpose aforesaid.

Plaintiff further shows that he paid into the treasury of the United States the sum of twenty-five dollars (\$25.00) and complied with the regulations prescribed by the commissioner of patents as provided in the act of congress entitled "An act to authorize the registration of trade-marks and protect the same," approved March 3, 1881, as will more fully appear by reference to the certificate of registry of said trade-mark, numbered 9597, dated the 8th day of August, 1882, signed by E. M. Marble, commissioner of patents, and attested by the seal of the Department of the Interior, which certificate is hereto attached and made part of this declaration.

Plaintiff further shows that said "trade-mark" is applied and affixed to goods by blowing it in the glass, as aforementioned, and by printing it on paper, which in the form of labels is afterwards pasted on the bottles containing the medicine, and it is also printed on wrappers, or otherwise affixed to packages to be used in any manner calculated to notify purchasers of the contents and to guard against fraud.

This plaintiff shows that he is the sole owner by right of priority of adoption and use of a certain other trade-mark consisting of a fac-simile of his firm signature, "H. H. Warner & Co.," which said latter-mentioned "trade-mark" is printed on a separate label, and pasted over the cork of each bottle, after the same has been filled with said medicine.

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trade-mark entitled "Book of \$2,000.00 Prize Enigmas," containing the representation of a man, representing a botanist standing beside a palm tree examining a plant through a magnifying glass, and other matters not necessary to be here mentioned, all the same being printed on the cover of a pamphlet.

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trade-mark representing the front of a fire-proof safe, in the central part of which is shown a negro, on one knee gathering herbs, above whom are the words,

"Warner's Safe," and below him are the words, "Kidney and Liver Cure."

Plaintiff further shows that for the purpose of guarding against fraudulent imitations of his said medicine, and to authenticate the genuineness of goods of his manufacture, he caused, and still causes, each bottle of the same to have wrapped about it a pamphlet bearing his said trade-marks with loose circulars between the leaves of said pamphlet, and wrapped about the same another printed circular, printed in several different languages; which said pamphlet contained a great many testimonials of the intrinsic value of said medicine as a remedy for various diseases and disorders, and also facsimiles of the signatures of the signers of said testimonials; and said pamphlet containing, among other matters, a great many enigmas for the solution of which large prizes were offered by the plaintiff. That as a further precaution against fraud, and as a means of identification, the said medicine is packed in wooden boxes, which boxes contain each one dozen bottles of plaintiff's medicine labeled and wrapped as aforesaid, and bearing upon one side of the boxes the following printed words: "One Dozen Warner's Safe Kidney and Liver Cure, Manufactured by H. H. Warner & Co., Rochester, N. Y."

And the said plaintiff further shows that he has ever since the dates of the adoption of the said trade-marks been and now is solely entitled to all the rights, interests and privileges thereby so secured unto him; and that the said medicine with the accompanying trade-marks has been extensively introduced to public use, and that large quantities thereof, to wit, several millions of bottles, have been purchased and consumed by the public for which he has received several millions of dollars, and that he would but for the wrongful acts of the said defendant, Frank Roehr, have made further large gains, profits and advantages from the manufacture and sale of said medicine. And plaintiff further shows that heretofore, to wit, on or about the — day of October, A. D. 1883, at the city of Chicago, in the district aforesaid, the said defendant Frank Roehr, well knowing the premises, and the rights and privileges theretofore secured unto him the said plaintiff, and in order to deprive him of his profits, benefits and advantages which might and otherwise should and would have accrued to him at the said district, and elsewhere, unlawfully, unjustly, and wrongfully simulated the various aforesaid trade-marks, circulars, labels, wrappers, packages and boxes, in which said genuine medicine of this plaintiff has been put up for the purposes of commerce, and for the purpose of carrying into execution his nefarious enterprise in that respect, the said defendant, F. R., employed large capital, and a large number of assistants, including printers, electrotypers, photographers, and other persons skilled in the arts necessary for the accomplishment of his unlawful purpose aforesaid, and did make exact representations of the genuine trade-marks, labels, etc., hereinbefore described, so closely resembling the genuine as to be calculated to deceive purchasers, and which in many instances did actually deceive purchasers, who supposed that they

were buying the genuine medicine manufactured as aforesaid by this plaintiff, when in fact the simulated packages contained only a base fluid, colored to resemble the genuine medicine of the plaintiff.

Plaintiff further shows that said defendant, F. R., manufactured large quantities of packages made in exact representation of this plaintiff's genuine packages, and containing inside thereof the simulated labels, wrappers, etc., hereinbefore described, and bottles filled with a fluid purporting to be this plaintiff's genuine medicine, but which in fact was not so, but only a base imitation thereof, and offered for sale at the district aforesaid and elsewhere, and did sell large quantities of the same, all of which said wrongful acts of said defendant, F. R., were done without the knowledge, consent or acquiescence of the said plaintiff, and with the intent to injure and defraud him, to the damage of this plaintiff of twenty-five thousand dollars (\$25,000), and therefore he brings this suit.

W. H. B.,

J. F. L.,

Plaintiff's Attorneys.

Indorsed: Filed Dec. 6, 1883, Wm. H. Bradley, Clerk.

#### BILL OF COMPLAINT.

(Taylor v. Carpenter, 3 Story, 458.)

To the Judges of the Circuit Court of the United States for the District of Massachusetts:

J. T. and W. T., of the borough of Leicester, in that part of the United Kingdom of Great Britain and Ireland called England, manufacturers, subjects of Victoria the First, queen of said kingdom, and aliens to each and all of the United States of America, and the territories and districts thereof, bring this bill of complaint against D. C., of F., in the said district of Massachusetts, manufacturer, a citizen of the said state of Massachusetts. And thereupon the said J. T. and W. T., complaining, say that for many years past they have been very extensively engaged in manufacturing cotton thread at Leicester aforesaid, and vending the same in large quantities, not only in England, but throughout the United States, and in particular in the city of B., in said district. That their said thread is, and for many years has been, put up for sale on spools, and labeled on the top of the spools "Taylor's Persian Thread" in a circle, in the center of which is the number of the thread, and on the bottom of some of the spools "J. & W. Taylor, Leicester," and on the bottom of others, "J. & W. Taylor," with the number of yards of thread on each spool, each spool usually containing two hundred yards or three hundred yards of thread, and the spools containing two hundred yards being black and labeled "200 yds." on the bottom of the spool, and those containing three hundred yards being red, and labeled "300 yds." on the bottom of the spools. And on the center of some of the



said labels on the bottom of each spool is stamped the symbol or print of the head and forepart of a lion rampant. And on the center of other of said labels is stamped a coat-of-arms, the shield whereon contains a lion rampant, and over the same three balls with the motto "In Deo Confido." And your orators further say that their spools so marked, stamped, colored, or labeled as aforesaid, are put up for sale in paper envelopes, each containing one dozen of spools; which said envelopes are prepared and stamped by your orators for said purpose, and some of said envelopes bear in raised letters stamped on them the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on the top of each spool, Taylor's Persian Thread, and on the bottom J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor." And on other of the said envelopes is stamped a coat-of-arms representing a shield, the upper division of which is gilt, and contains three red balls, and the lower division thereof is red and contains the effigy of a lion rampant, with the motto under the same, "In Deo Confido." Your orators further show unto your honors that their said thread has been and is manufactured of various sizes and numbers, to meet the wants of the trade; and by means of the care, skill and fidelity with which your orators have conducted the manufacture thereof for a series of years, their said thread has acquired a great reputation in the trade throughout the United States, and large quantities of the same are constantly required from your orators to supply the regular demand for the consumption of the country. And your orators have established agencies for the sale thereof to the wholesale dealers and jobbers in the cities of B., N. Y., P. and N. O., and in addition thereto your orators employ B. W., now residing in said city of N. Y., as their general agent for the United States, in relation to the sale of their said spool sewing cotton thread; and a mercantile firm of H. & C. are the agents of your orators for the sale of the same in the city of B.; and your orators further show unto your honors that their said thread is known and distinguished by the trade and the public as "Taylor's Persian Thread," and that your orators were the original manufacturers thereof, and the first who introduced the same to the public. That your orators' said general agent, on or about the first day of March last past, hearing that complaints were made of the quality of "Taylor's Persian Thread," proceeded to investigate the cause of said complaint, and thereupon ascertained that a spurious article of spool sewing cotton thread was offered for sale by sundry jobbers in the said city of B., as and for your orators' "Persian Thread," and that such complaints had arisen from the fraudulent imposition of such spurious article on the public. Your orators further show unto your honors that their said agent further ascertained, upon inquiry, and your orators charge the facts to be, that the said spurious thread so sold and offered for sale in the said city of B., or some of it, was furnished to the said jobbers by D. C., either by him personally or by one F. D. E., of B., his agent in that behalf.

and your orators are informed and believe that the said D. C. has sold the said thread, put up, marked and designated as aforesaid, in the said city of B.; that the said D. C., disregarding the rights of your orators, and fraudulently designing to procure the custom and trade of persons who are in the habit of vending or using your orators' said "Persian Thread," and to induce them and the public to believe that his said thread was in fact manufactured by your orators, had engaged extensively in the manufacture of sewing cotton thread, and caused the same to be put up for sale in envelopes and on spools similar to those used by your orators, and so colored and stamped and labeled as to resemble exactly the said spools and envelopes used by your orators. And the said spool sewing cotton thread, prepared by the said D. C. and sold by him, and which he is engaged in selling as aforesaid, is an exact imitation of the same article which your orators had been manufacturing as aforesaid, and selling in the United States for many years before the said D. C. commenced his said fraudulent imitation thereof. And the said spurious article, although inferior in quality to the genuine Persian Thread manufactured by your orators, can only be distinguished therefrom, so exact is the said D. C.'s imitation as aforesaid, by a careful examination of its quality, and by its falling short in the number of yards contained on each spool from the number marked thereon as the contents thereof. And that the general appearance of the spurious article is the same as that of your orators' genuine thread, and well calculated to deceive those dealing in the purchase and sale thereof. Your orators further show unto your honors that their said general agent has obtained specimens of the said spurious Persian Thread so sold by the said D. C. That in some of the specimens thus obtained, the thread is put upon black spools, and in other of said specimens the thread is put upon red spools, and said black and red spools are of the same size and appearance with those used by your orators, on the top of which spurious spools there is pasted a round paper label, partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center of the circle the number of the thread; and on the other end on the bottom of such spurious spools there is pasted a round paper label on some of which is printed in a circle the words, "J. & W. Taylor, Leicester," and on others, "J. & W. Taylor," with the number of yards of thread on the spools, and across others of the labels on said black spools the letters and figures "200 yds.," and on said red spools the letters and figures "300 yards" are printed, and in the center of the said labels there is impressed the figure or symbol of the head and forepart of a lion rampant. And in other of said specimens the thread is put on spools corresponding in all particulars to those herein just before described, except that the labels on the bottom thereof bear a coat-of-arms, the center of the shield whereof contains a lion rampant, with three balls over the same, and with the motto under, "In Deo Confido." Your orators have also obtained specimens of the envelopes in which said D. C.'s spurious thread is put up and sold by him or

his agents, which bear the same inscriptions, letters and stamps that those used and employed by your orators bear. And in all these particulars of the labels on each end of the said spurious spools of thread, and the envelopes in which they are put up, they are exactly like the envelopes and the labels on the respective ends of the spools of your orators' genuine Persian Thread, as hereinbefore stated. Your orators further show unto your honors that they have not yet ascertained the extent to which the said D. C. has carried his said fraudulent imitation and sale of your orators' said thread. But your orators' said general agent has found the same offered for sale to the trade in at least six wholesale or jobbing houses in the city of B., as "Taylor's Persian Thread"—from which your orators believe, and they therefore charge, on their belief, that the said D. C. has been and is engaged in selling his said fraudulent and spurious imitation of your orators' "Persian Thread" to a large extent in various places in the United States, with intent that the same should circulate and be received and used by the public as Taylor's genuine "Persian Thread." And your orators further show unto your honors that the fraudulent and inequitable conduct of the said D. C. is not only injuring them in the sales of their said genuine "Persian Thread," and the profits which they would otherwise reasonably make thereon, but by the inferior quality and false measure the said spurious "Persian Thread" is greatly prejudicing the reputation of your orators' said "Persian Thread" in the market, and, unless the said imitation is discontinued or prevented, will ultimately destroy the character and standing of the genuine article. And your orators also charge that the said spurious article is a fraud and deception upon such of the citizens of the state of Massachusetts, and of the United States, as purchase the same, believing it to be the genuine article manufactured by your orators. And your orators further show unto your honors that in the month of March last past, having discovered a portion of the aforesaid fraudulent conduct of the said D. C., your orators did file their bill of complaint before the chancellor of the state of New York, wherein they set forth many of the facts which are in substance hereinbefore stated, and prayed for an injunction to restrain the said D. C. from the aforesaid fraudulent use of the name and trade-marks of your orators, and the same was granted by the court; and the said D. C. having appeared and filed his answer to the said bill, did therein admit that he had used the name and trade-mark of your orators in manner set forth in the bill aforesaid; but denied that the article manufactured by him was of inferior quality to that manufactured by your orators; and afterwards an application was made to the chancellor to dissolve the injunction aforesaid, which last mentioned motion is now before the said chancellor, and by reason of the great number of causes depending before him, the aforesaid cause cannot be decided without great delay. And your orators are informed and believe it to be true that the said D. C., residing out of the jurisdiction of the chancellor of the state of New York, can, with impunity, disregard the injunction aforesaid, and that he has continued to make sales in the city of B.

and elsewhere of the said thread, put up, labeled, and appearing precisely like that made, put up, and sold by your orators, and your orators continue to be greatly injured thereby.

In consideration whereof, and for as much as your orators are remediless in the premises at common law, and cannot have adequate relief save by the aid and interposition of this court, to the end, therefore, that the said D. C., if he can, show why your orators should not have the relief hereby prayed, and may upon his corporal oath, and according to the best and utmost of his knowledge, remembrance, information and belief, full, true, direct and perfect answers make to the several interrogatories hereinafter numbered and set forth; and the said D. C. and his attorneys, solicitors, counselors, agents and servants may be enjoined and restrained from manufacturing, selling or offering for sale, directly or indirectly, any spool cotton sewing thread manufactured by him or any person other than your orators, under the denomination of "Taylor's Persian Thread," or on spools with the words, "Taylor's Persian Thread," or "J. & W. Taylor, Leicester," or "J. & W. Taylor," printed, painted, written, or stamped, or attached or pasted thereon, or with your orators' said device of a lion rampant, or with their said coat-of-arms thereon; or on spools so made or having any label, printing or device thereon, in such manner as to be colorable imitations of your orators' said spool thread, usually known as "Taylor's Persian Thread," and that the said D. C. may be decreed to account to your orators for all the profits which he has made by the sale of his said fraudulent imitation of your orators' thread, and all the profits which your orators would have made on the sales of their genuine thread but for the said D. C.'s inequitable and wanton piracy of their said name, spools and labels; and that your orators may have their costs and charges in this behalf paid by the said D. C.; and that your orators may have such other and further relief in the premises as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

May it please your honors to grant unto your orators a writ of injunction, issuing out of and under the seal of this court, to be directed to the said D. C., his attorneys, solicitors, counselors, agents and servants, therein and thereby commanding and enjoining them, under a certain penalty in the said writ to be expressed, according to the foregoing prayer of your orators.

May it also please your honors to grant unto your orators a writ of subpoena, issuing out of and under the seal of this court, to be directed to the said D. C., commanding him on a certain day and under a certain penalty in the said writ to be inserted, personally to be and appear before your honors in this honorable court, then and there to answer the premises, and to stand to, abide by, and perform such order and decree therein as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

C. P. C., of Counsel.

C. P. and B. R. C.,  
Solicitors.

J. & W. T.,  
By W. B., their Agent  
and Attorney.

United States of America, }  
 District of Massachusetts, } ss.

Personally appeared before me the above-named B. W., on this second day of December, A. D. 1843, and made oath that this bill in equity by him signed, in as far as it states matters within his knowledge, is true to his knowledge, and in as far as it states matters within his belief, is true to his best belief.

W. W. S., Commissioner, etc.

Interrogatories to be answered by D. C.:

1. Whether or not have you manufactured and sold, in Massachusetts or elsewhere, thread put upon black spools, on one end of each of which spools is pasted, or otherwise fastened, a circular paper label partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center thereof the number of the thread, and on the other end of each of said spools is pasted or otherwise fastened a circular white paper label, on which is printed in a circle the words "J. & W. Taylor, Leicester," and across the same label "200 yds.," and in the center of the same label there is impressed the figure or symbol of a lion rampant?

2. Whether or not you have manufactured and sold, in Massachusetts or elsewhere, thread put upon red spools, corresponding in all respects to the black spools described in the preceding interrogatory, except in the color of the spool and in the quantity of thread thereon; and in the letters and figures "300 yds." printed across the said white paper label?

3. What number of each kind of the said spools of thread have you manufactured and sold? State the same accurately, and distinguish the kind and number of the thread, and the number of black spools and the number of red spools so sold by you since you commenced selling the same, and the times when and the places where the same have been sold.

4. What have been the profits made or realized by you on the manufacture and sale of thread put upon spools colored, decorated and fitted up in the manner described in the first and second interrogatories?

5. To whom and what persons in particular have you sold the said thread put up in the manner described in the first and second interrogatories?

6. Who is, and who has been, your agent in Boston for the sale of your thread put upon spools fitted up in the manner described in the first and second interrogatories?

7. Whether or not did you admit in an answer signed, sworn to and filed by you in the court of chancery in and for the state of New York, to a bill of complaint therein pending wherein the said J. T. and W. T. are complainants, and yourself is defendant, that you have engaged in the manufacture of sewing cotton thread, which you have caused to be put up for sale on spools similar to those used by the complainants, and so colored, stamped and labeled as to resemble

exactly or as nearly as the same could be done, the said spools used by the complainants, and the said spool sewing cotton, which has been prepared and sold by you, is an exact imitation of the same article which the complainants had been selling in the United States many years before you commenced manufacturing your thread?

8. Whether or not have you manufactured and sold in Massachusetts sewing cotton thread upon black spools and upon red spools, on one end of each of which is fastened a circular paper label, described as in interrogatory numbered 1, and on the other end is fastened a circular paper label on which is stamped a coat-of-arms, the shield whereof contains a lion rampant, and over the same three balls, with the motto under the shield, "In Deo Confido," and around said shield is printed in some of said labels, "J. & W. Taylor, Leicester," and in others, "J. & W. Taylor," with the number of yards on said spools?

9. Whether or not have you put up and sold your sewing cotton thread, colored, stamped and labeled in all or some of the modes described in this bill in envelopes or wrappers, some bearing in raised letters the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on top of each spool Taylor's Persian Thread and on the bottom J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor," and others bearing a coat-of-arms, the upper division of which is in gilt, and has three red balls thereon, and the lower division is red, and has a lion rampant thereon.

C. P. and B. R. C.,  
Solicitors.

### BILL OF COMPLAINT.

(Carson v. Ury, 39 Fed. Rep. 777.)

In the Circuit Court of the United States for the Eastern Division  
of the Eastern Judicial District of Missouri:

JAMES CARSON, Complainant,	}	In Equity.
vs.		
HENRY URY, HARRIET URY, RICHARD		
URY, ERSKINE MANSFIELD and A.		
BELINER, Defendants.		

J. C., a resident and citizen of the city of New York, in the state of New York, files this his amended bill of complaint, under leave of court had and obtained, against the above defendants, H. U., H. U., R. U., E. M. and A. B., all of whom are citizens of the state of Missouri and residents of the city of St. Louis, in the eastern division of the eastern judicial district of the said state, and there-upon your orator complains and says:

First. That your orator for more than seven years has been and

now is a member of the Cigar Makers' International Union of America; that the members of said union are severally cigar makers residing in the United States, and said union is a voluntary unincorporated association of practical cigar makers formed for the purpose of promoting the mental, moral and physical welfare of the members, by assisting them to obtain labor at remunerative wages, by affording them pecuniary aid in case of sickness and providing money in case of death, and generally to maintain a high standard of workmanship and fair wages of cigar makers.

Second. That the question which is the subject of this action is one of common and general interest to all members of the Cigar Makers' International Union of America, and that they are very numerous, being over twenty-five thousand in number, and that it is impracticable, therefore, to bring them all before the court in this action.

Third. That as your orator is informed and believes, for the purpose of designating the manufacture of members of the Cigar Makers' International Union of America, the said union through its delegates in convention assembled in Chicago in the month of September, 1880, devised and adopted a trade-mark or label to which they gave the name of "Union Label," a fac-simile of which is annexed hereto and marked "Exhibit A;" that prior to the adoption of said label the same had not been known or in use in this country or elsewhere, and ever since said adoption the members of the Cigar Makers' International Union of America have exclusively used said labels, and the same have been conspicuously posted on the outside of cigar boxes containing cigars made by the members of said Cigar Makers' International Union of America.

Fourth. That the members of said union are by the constitution and laws of said union allowed to make and sell cigars, and to use on such cigars so made and sold by them labels like said "Exhibit A," provided they do not employ others to make said cigars; and that your orator for about two years last past has been making and selling cigars in the city of New York aforesaid and has used there the labels like said "Exhibit A," and has built up a profitable trade for himself under said label, and that your orator was the owner of the cigars which he thus made and sold under said label to the public.

Fifth. That the said label affixed to cigar boxes is intended as a guaranty that the cigars therein contained are manufactured by members of the Cigar Makers' International Union of America, and that good and clean workmanship has thereby been secured; and that the cigars were not made in tenement houses or state prisons or by coolies, and for these reasons the cigars so labeled command a higher price in the market than cigars of similar appearance, but without such label, can command; that there is a large demand among the public for cigars having said label, which demand has been growing every year since the organization of said union, and the use of said label has been and is a source of great profit and advantage to your orator and to the other members of said union.

Sixth. That it is the practice of said union to furnish gratuitously copies of the genuine label marked "Exhibit A" to all manufacturers of cigars in the United States who employ exclusively members of the said union, who themselves own and sell the cigars which they make.

Seventh. That the wages demanded and received by the members of said union, are about three dollars higher per one thousand cigars than the wages demanded and received by other workmen, and that union-made cigars, that is, boxes of cigars carrying the said labels, bring in the market about three dollars more per thousand than such cigars would bring without such labels; that this is the case because the cigars bearing said labels are known to the public to be made by competent workmen in clean and healthy shops.

Eighth. That by the use of said genuine labels as aforesaid, your orator and other members of said union have made great profits and the public is protected from impure and unhealthy cigars.

Ninth. That said union does not issue labels to manufacturers employing tenement house labor, or prison labor, or coolie labor, or who do not pay the required scale of wages demanded by said union, and that said union does not sell any such labels either to manufacturers or to the public.

Tenth. That as your orator is informed and believes, since the adoption and use of said label by said union, and since the time when your orator commenced to sell cigars bearing said genuine label, the said defendants have conspired and federated together to cheat and defraud your orator and the members of said union so using said label as aforesaid, and fraudulently impose upon manufacturers and dealers in cigars and upon the public by manufacturing and offering for sale and selling and giving away for use on cigar boxes, labels which are spurious and counterfeits of said genuine labels, and in furtherance of this fraudulent and illegal business have adopted the name "B. Alberts." That your orator is informed and believes that the said name of B. Alberts is fictitious and that there is no person of that name, but that the same was first adopted by defendant B.; but however this may be, your orator further says that said defendants under said name have manufactured, offered for sale and sold spurious and counterfeit labels for use as aforesaid— a copy of which said spurious and counterfeit label is hereto annexed, marked "Exhibit B." That the spurious label so offered and given away and sold by said defendants under the said name of B. Alberts is a close imitation and counterfeit of the genuine adopted by said union as aforesaid. That the said defendants have also lately inserted an advertisement in the United States Tobacco Journal, a newspaper published in the city of New York, state of New York, and in other publications, representing to the public that they had for sale copies of said genuine label, issued by authority of said Cigar Makers' International Union of America, and containing a representation of such label. All of which acts of said defendants are done without the authority or permission of your orator or the officers and mem-



bers of said union, and against its will and protest. That in furtherance of said fraudulent and illegal purposes, and with the intent to cheat and defraud as aforesaid, said defendants have published a fictitious address, in said name of B. Alberts as aforesaid, to wit: No. 222 Pine street, in the city of St. Louis, there being no person by the name of B. Alberts at said address, and have caused all mail there received in answer to their advertisements to be delivered to the place of business of said defendants, H. U. and H. U., with whom, as your orator is informed, the other defendants are associated at No. 304 North Main street, in the city of St. Louis.

Eleventh. That said wrongful and fraudulent acts of said defendants, and their continuation, are calculated to deceive and mislead and do deceive and mislead the public into the belief that said defendants have authority from said union to sell or give away said genuine labels, and further tend to deceive the public into the belief that the cigars thus labeled by the purchasers of said labels from the defendants are the cigars made and sold by your orator and such other makers of cigars as have authority to use the genuine label of said union; and they further tend to deceive the public into the belief that the false and spurious labels sold and offered for sale, or given away by said defendants, are the genuine labels of said union.

Twelfth. That your orator has, and the other members of said Cigar Makers' International Union of America have, a valued and pecuniary interest in the genuine labels issued by said union, and used by the members thereof, and that he has, and they have, suffered irreparable damage by the wrongful acts of said defendants, and that, if suffered to continue, the wrongful acts of said defendants will tend to produce further irreparable damage to your orator and to the other members of said Cigar Makers' International Union of America.

Thirteenth. That your orator has no adequate remedy at law for said injury.

Fourteenth. That said injury cannot be adequately compensated in money, but your orator alleges that the matters in dispute and injury to him, exclusive of interest and costs, exceed the sum of two thousand dollars.

Fifteenth. That as your orator is informed and believes, one or more of said defendants, prior to the commencement of said wrongful acts, were members of said union and well acquainted with its constitution, by-laws and practice, but are not now members of said union.

Sixteenth. And your orator further shows unto your honors on information and belief, that said defendants have made and sold, and caused to be made and sold, large quantities of said labels and have large quantities on hand, which they are now offering for sale, and have made and realized large profits and advantages therefrom; but to what extent and how much exactly your orator does not know and prays a discovery thereof; and that said labels have been used by many manufacturers of cigars in the sale of cigars which were not

made by your orator or by any member of the Cigar Makers' International Union of America.

Seventeenth. And your orator further says that the use and sale of said labels by said defendants, and their preparation for and avowed determination to continue the same, and their other aforesaid and unlawful acts in disregard and defiance of your orator, have the effect to and do encourage and induce others to disregard your orator's rights in the premises.

And your orator prays that said defendants, H. U., H. U., R. U., E. M. and A. B., their servants, agents, attorneys and workmen, and each and every of them, may be restrained and enjoined provisionally and perpetually, by the order and injunction of this honorable court, from directly or indirectly making, using, vending, delivering or in anywise counterfeiting or imitating said genuine label of the Cigar Makers' International Union of America, or from making, selling or offering for sale or giving away any labels like or similar to those issued by said Cigar Makers' International Union of America, and that the defendant may be decreed to pay the costs of this suit, and that your orator may have such further or such other relief as to this honorable court shall seem meet and as shall seem agreeable to equity.

An answer under oath is hereby expressly waived.

May it please your honors to grant unto your orator the writ of injunction, as well provisional as perpetual, issuing out of and under the seal of this honorable court, commanding, enjoining and restraining said defendants, H. U., H. U., R. U., E. M. and A. B., commanding them by a certain day and under certain penalty to be and appear in this honorable court then and there to answer the premises and to stand to and abide such order and decree as may be made against them.

And your orator will ever pray, etc.

A. K., of Counsel.

B., S. & K.,  
Complainants' Solicitors,  
with whom are H. O. & J.

STATE OF NEW YORK, <i>Southern District of New York,</i> City and County of New York,	}	ss.
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J. C., being duly sworn, says that he is the complainant named in the foregoing complaint, that he has read said complaint, and that the allegations contained therein are true except those which are stated therein to be alleged on information and belief, and as to those he believes said complaint to be true.

J. C.

Sworn to before me this 23d day of March, 1889.

H. M. T.,

Notary Public of New York County.

## BILL OF COMPLAINT.

(Buck's Stove &amp; Range Co. v. Kiechle, 76 Fed. Rep. 758.)

*[Caption and facts showing jurisdiction.]*

That many years ago, to wit, in or about 1866, the complainant adopted, as a distinguishing characteristic for its cooking stoves and ranges, white enamel lining—that is to say, a lining of white enamel for the inside of the doors of its cooking stoves and ranges—to the end that the trade and public might come to recognize the cooking stoves and ranges of complainant's manufacture by this peculiarity, as a characteristic which would distinguish the cooking stoves and ranges of complainant's manufacture from the cooking stoves and ranges of all other manufacturers of cooking stoves and ranges; the fact being that, at the time the complainant adopted the aforesaid distinguishing characteristics, and for years thereafter, and until the actions of the defendants hereinafter complained of, no other cooking stove manufacturer in the United States had or has made and sold cooking stoves and ranges with oven doors having the inside thereof lined with white enamel. That the similarity in general style, shape and design of cooking stoves and ranges made by different stove manufacturers in the United States is, and has been during all the time hereinafter referred to, so very similar that, to the average purchaser buying a stove or range for use in the household, it is difficult to distinguish the stove or range of one manufacturer from the stove or range of another; especially so in view of the fact that the plates comprising the different parts of the stove or range can be and readily are taken apart and used by a rival manufacturer as patterns from which to mould a stove or range of its own in close similitude to the stove or range of the manufacturer who has obtained celebrity in the market for his goods. That complainant, since in or about 1866, has used great skill and fidelity in the manufacture of its stoves or ranges, always enameling with white enamel the inner face of its stove and range doors, with the result that for years last past, and long prior to the action of defendants hereinafter complained of, its stoves and ranges had obtained great celebrity in the market of the United States, especially in the middle, northern, southern and western states, and in the city of Evansville, Ind., as "White Enamel" stoves and ranges, and were so known by the trade and public in all the territory aforesaid, and distinguished by the trade and public from the stoves and ranges of other stove manufacturers as "White Enamel" stoves and ranges. That, in exposing stoves and ranges for sale, it is the custom and demand to show the intending purchaser the oven of the stove or range, and to open the oven door to that end, or (what is also common) to leave at least one of the oven doors open, so that the oven is in plain view; and that in recognition of this custom and demand, as an effective way of impressing on the mind of the trade and public complainant's stoves and ranges, and characterizing by a distinguishing feature its stoves and ranges from all others, it has, since 1866, continuously used, and now uses, white enamel lining for the oven doors of its

cooking stoves and ranges, with the result intended and desired as hereinbefore set forth. That its trade in the manufacture and sale of cooking stoves and ranges, with white enamel used, as aforesaid, as a distinguishing feature, has steadily increased from year to year; that it was the first to adopt the aforesaid white enamel for an inner lining for oven doors of cooking stoves and ranges; and that, but for the action of defendants hereinafter complained of, it would now be in the undisturbed enjoyment of its celebrity which it has earned with the trade and public for its cooking stoves and ranges as "White Enamel" stoves and ranges. That the good-will of complainant in the manufacture and sale of cooking stoves and ranges under said name, "White Enamel," because of said distinguishing characteristic, is of the value of \$100,000. That defendants, well knowing the premises, but seeking how they might trade on the reputation of complainant, and find a ready sale for their products, without authority of complainant, and in violation of its rights, and contrary to equity and good conscience, have recently, before the filing of this bill, made or caused to be made cooking stoves and ranges in general external appearance similar to complainant's manufacture, enameling the inside face of such cooking stoves and ranges with white enamel, with the result that said cooking stoves and ranges can be, and in fact are, sold to the trade, and by the trade to the public, as "White Enamel" cooking stoves and ranges, to the manifest and irreparable injury of complainant, the actions of said defendants hereinbefore set forth being calculated to deceive, and resulting in actual deception of, the trade and public. That by reason of such wrongful conduct the complainant has suffered loss and damage in the sum of \$10,000. That complainant has called the attention of defendants to its aforesaid rights, and to defendants' wrongful conduct, and asked them to desist, which they have refused to do. That complainant has no adequate remedy at law, and it therefore brings this suit, and prays for an injunction and for an accounting of damages.

#### BILL OF COMPLAINT.

(Hennessy v. Herrmann, 89 Fed. Rep. 669.)

In the Circuit Court of the United States for the Northern Judicial District of the State of California.

JACQUES RICHARD MAURICE HENNESSY,	} In Equity.
JACQUES FRANCIS HENRY HENNESSY,	
JAMES RICHARD CHARLES HENNESSY,	
ARMAND CASTILLON and EMMANUEL	
CASTAIGNE,	
<i>against</i>	
J. H. and C. S.	

To the Honorable Judges of the Circuit Court of the United States for the Northern Judicial District of California:

First. J. R. M. H., J. F. H. H., J. R. C. H., A. C. and E. C., all of Cognac in France, and citizens of the Republic of France, bring

this their bill of complaint against J. H. and C. S., of the city and county of San Francisco, state of California, residents of the Northern Judicial District aforesaid, and citizens thereof, and thereupon your orators complain and say:

Second. Complainants state that at all the times hereinafter mentioned they were copartners under the firm name and style of James Hennessy and Company. That the complainants are, and for a long time previous to the commission of the grievances hereinafter mentioned have been, exporters, bottlers and vendors of a cordial or liquor known as Hennessy brandy, which the complainants and their predecessors in the partnership business have for upwards of thirty years last past produced, bottled and sold.

Third. That said brandy when bottled by these complainants is put up in peculiar tall, dark colored bottles, to wit, twelve inches in height, bearing (a) a rectangular label bearing the inscription, "Jas. Hennessy & Co., Cognac," in gold letters on a white ground, encircled by a wreath of vine leaves and grapes, in gold, said wreath being surmounted by an arm bearing a battle axe, also in gold; (b) a small oblong label of white with gold border lines, bearing the word "France" in gold; (c) a crescent-shaped label; (d) a cork branded with the words "James Hennessy & Co.;" (e) a metal capsule; all with their own proper devices and trade-marks adopted by the complainants for that purpose the year A. D. 1870, and all encased in square wooden boxes holding twelve bottles each.

Fourth. That complainants' trade-marks have been duly registered under the provisions of the statute of the United States in the year A. D. 1881. That by reason of the long experience and great care of the complainants in their said business, and the good quality of said brandy, distinguished as it was by its trade-marks, trade-names, labels, corks, capsules, and the shape, size and color of its bottles, the same has become widely known in the community and throughout the world as a useful and valuable cordial and acquired a high reputation as such, and has commanded and still commands an extensive sale throughout the United States and Europe, which is and has been a source of great profit to these complainants. That your orators' trade-name and trade-marks are of a value of two thousand dollars and upwards. That said brandy when bottled by complainants is known as such brandy to the public, buyers and consumers thereof by the said name of James Hennessy & Company's brandy, or Hennessy brandy, or Hennessy cognac, together with the complainants' own proper devices, trade-names, and trade-marks aforesaid, and by its straw wrappers or casings accompanying and enclosing said bottles, and by the peculiar shape and color of the bottles themselves.

Fifth. Complainants state that notwithstanding the long and quiet use and enjoyment by the complainants of said trade-name and trade-mark and to the form, device and descriptive matter of said labels, the defendants, well knowing the premises and with the preconceived intention to injure the complainants, and with the purpose to defraud

them, and with the purpose to deprive these complainants of the benefits and profits resulting from the great reputation acquired for said brandy, and the consequent demand therefor, and with the intent to acquire for themselves the benefits and profits of said reputation, and with the intent to assist others to palm off on the public brandy not being exported, sold or bottled by complainants, as the goods of the complainants, and in wilful disregard of complainants' rights in the premises, kept, offered for sale and sold, and advertised for sale, and now keep, offer for sale and sell in the city and county of San Francisco and state of California, and elsewhere in the United States of America, counterfeit labels in imitation of complainants' labels under the name of "Hennessy & Co.," using fac-similes of complainants' trade-name, devices and labels, which with intent to deceive and defraud the public and the buyers and consumers thereof they have caused to be sold to dealers engaged in counterfeiting the bottled brandy of your orators; that defendants sold said labels for the purpose and with the intent that they should so be used, and that in fact they have been so used, in fraud of your orators' rights.

Sixth. That such imitation labels are calculated to deceive the purchasers and consumers of said brandy, and are calculated to cause the public and the buyers and consumers thereof to believe that the brandy kept and offered for sale and sold by defendants' customers is the brandy exported, bottled and sold by the complainants.

Seventh. That such imitation is calculated to deceive and mislead the purchasers and consumers of the complainants' brandy, and has actually deceived and misled and still does mislead many of them to buy the brandy or liquor sold by the defendants' customers in the belief that it is the brandy exported and bottled by the complainants, to the great loss, injury and damage of the complainants. That the article so put up and sold by the defendants' customers is of greatly inferior quality to that of the complainants, and deleterious to the health of the consumer, and the general esteem and reputation of the brandy exported by the complainants has been and is now being injured and damaged thereby.

Eighth. Forasmuch as your orators can have no adequate relief except in this court, and to the end, therefore, that the defendants may, if they can, show why your orators should not have the relief hereby prayed, and may make a full disclosure and discovery of all the matters aforesaid, and according to the best and utmost of their knowledge, remembrance, information and belief, full, true, direct and perfect answer make to the matters hereinbefore stated and charged, but not under oath, an answer under oath being expressly waived.

And that the defendants may be decreed to account for and pay over adequate damages arising from their aforesaid acts in violation of your orators' rights, your orators pray that your honors may grant a writ of injunction issuing out of and under the seal of this honorable court, perpetually enjoining and restraining the said defendants, their clerks, attorneys, agents and servants from keeping, offering

for sale, or selling any brandy not being the brandy exported and bottled by your orators, put up in bottles of the general form, shape and color of complainants' bottles, and wrapped with labels of the form, device and in the manner complained of, or in any other form and device which shall be a colorable imitation of complainants' brandy, or from applying to any such brandy the name "Hennessy Brandy," or from using upon or in connection with said brandy or any counterfeit of your orators' labels or cases the name "Hennessy," or any combination of such name or name of like sound, and that the defendants deliver up to your orators all bottles having thereon said false label, and also all such false labels in their possession or under their control, to the end and purpose that the same may be destroyed.

And that your honors upon the rendering of the decree above prayed may assess, or cause to be assessed, the damages your orators have sustained by reason of the premises.

May it please your honors to grant unto your orators not only a writ of injunction conformable to the prayer of this bill, but also a writ of subpoena of the United States of America, directed to the said J. H. and C. S., commanding them on a day certain to appear and answer unto this bill of complaint, and to abide and perform such order and decree in the premises as to the court shall seem proper and required by the principles of equity and good conscience.

J. L. H., of Counsel.

A. L. P. and J. L. H.,  
Solicitors for Complainants.

UNITED STATES OF AMERICA, }  
*Northern Judicial District of California,* } ss.

J. L. H., on behalf of the said complainants, Jacques Richard Maurice Hennessy, Jacques Francis Henry Hennessy, James Richard Charles Hennessy, Armand Castillon and Emmanuel Castaigne, and duly authorized to act for them herein, being on his oath sworn, deposeth and says that he has read the above bill of complaint, and that the matters therein set forth are true to his best knowledge, information and belief.

J. L. H.

Subscribed and sworn to before me, this 19th day of July, 1898.

S. H.,

Clerk U. S. Cir. Ct., N. D. C.

### ANSWER.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the Circuit Court of the United States in and for the Ninth  
Circuit and District of California.

WILLIAM J. BENKERT, Complainant,	}	No. 3507.
vs.		
MORRIS ROSENTHAL and SAMUEL FEDER, Defendants.		

The answer of M. R. and S. F. to the bill of complaint of W. J. B., complainant.

These defendants, saving and reserving to themselves all right of

exception to said bill of complaint on account of the many errors therein contained, for answer thereto or to so much and such parts thereof as they are advised by counsel it is necessary or important for them to make answer unto, answering, say:

That they have no knowledge or information other than from said bill of complaint as to the partnership or business of the complainant and Casper Benkert, or the continuance thereof, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the sale by Casper Benkert to complainant of his interest in said alleged business and the carrying on and ownership and proprietorship thereof, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the business of the partnership of C. Benkert & Son and of complainant, or of the boots and shoes manufactured and sold by them or either of them, or of the quality, quantity and price of such boots and shoes, or the mark or other designation thereof or thereon, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the placing as a trade-mark upon said boots and shoes, and to indicate the ownership and origin thereof, the words "C. Benkert & Son," and to the knowing of said boots and shoes by the name of "C. Benkert & Son," and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the name of "C. Benkert & Son" being a trade-mark, or the ownership of said name, or the right to use and place the same upon boots or shoes, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

These defendants and each of them deny that they have for more than five years last past been partners in trade as set forth in said bill of complaint, except as follows: for the four years previous to the month of March, 1884, they, with one Bromberger, were partners in trade under the firm name of Rosenthal, Feder & Co., and in said month said Bromberger retired from the copartnership formed by them; since said month these defendants have been partners in trade as set forth in said bill of complaint.

These defendants and each of them deny that within five years or at any time or times whatsoever they or either of them had manufactured or sold, or are now manufacturing or selling, large or any quantities of boots and shoes or boots or shoes, or each or either, on any of which they have placed in plain or conspicuous letters, or at all, the name "C. F. Benkert & Son," in imitation of the name of



"C. Benkert & Son," as alleged in said bill of complaint' or at all.

Defendants and each of them deny that they or either of them have stamped in sole-leather or buttons or any other part of said boots and shoes, or any boots or shoes whatsoever, in plain conspicuous letters or otherwise, the name or words "C. F. Benkert & Son, Phila."

Defendants deny that they have manufactured or are still manufacturing said boots and shoes or any boots or shoes marked with the name of "C. F. Benkert & Son" in San Francisco, Hawaiian Islands, other domestic or foreign markets or elsewhere, and admit and show to this court that they have sold in San Francisco and elsewhere a small quantity of boots and shoes marked "C. F. Benkert & Son," comprising not more than two hundred and fifty dozen pairs thereof; and further state and show that the boots and shoes so sold were of an entirely different class, style, nature and grade from the boots and shoes alleged in said bill of complaint to be manufactured by the complainant and as such were recognized by and sold to the customers and patrons of these defendants.

Defendants say they have no knowledge or information other than from said bill of complaint as to the relative quality, cost of manufacture and prices of sale of said boots and shoes and the boots and shoes made by the complainant, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants and each of them deny that they have had manufactured for them as set forth in said bill of complaint large or any quantities of boots or shoes or any boots or shoes whatever on which was printed the name "C. F. Benkert & Son" or stamped "C. F. Benkert & Son, Phila.," as set forth in said bill of complaint, excepting not more than three hundred and twenty-one dozens thereof, and the defendants and each of them deny that they have sold or are still selling boots and shoes with said words printed or stamped thereon in San Francisco or elsewhere, excepting that they have heretofore sold not more than the two hundred and fifty dozens thereof aforesaid.

The defendants and each of them deny that they have placed or caused to be placed on said boots or shoes alleged to have been sold by them or upon any other boots or shoes whatsoever said words, to wit, "C. F. Benkert & Son," for the purpose of deceiving the public or purchasers generally, or any other person, or causing them or any of them to believe the said boots or shoes were manufactured by the complainant or at all. They deny that the public or purchasers generally or any of them have been deceived or have believed on account of said names being on said boots or shoes that the same were genuine or other boots or shoes manufactured by the complainant, and that being deceived as alleged in said bill of complaint, or being deceived at all, have purchased or are now purchasing, or these defendants have sold or are now selling, said boots or shoes as or for genuine or other boots or shoes manufactured by the complainant. They deny

that by any of the acts and doings set forth in said bill of complaint they or either of them have unlawfully or otherwise greatly or at all injured or depreciated the complainants' trade in fine or other boots or shoes, or the good or other reputation or standing of said boots or shoes, alleged in said bill of complaint to have been had by them.

Defendants and each of them deny that, unless restrained by injunction, they by using said name on the boots and shoes sold by them will infringe on the alleged name and trade-mark of the complainant and deny that they have already at any time been doing the same.

The defendants state and show that they have sold not more than two hundred and fifty dozens of boots and shoes marked "C. F. Benkert & Son," and have realized therefrom a profit of about and not more than five hundred (500) dollars.

The defendants and each of them deny that by reason of the said alleged infringement, or of any other act or doing of these defendants or either of them, the complainant has suffered loss or damage to a very large or other amount or any loss or damage whatsoever.

Without this that there is any other matter, cause or thing in the said bill of complaint contained material or necessary for these defendants or either of them to make answer unto and not herein and hereby well and sufficiently answered, confessed, traversed and avoided is true to the knowledge or belief of these defendants; all of which matters and things these defendants are ready and willing to aver, maintain and prove as this honorable court shall direct, and humbly pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

I. S. B.,  
Of Counsel for Defendants.

M., B. & M.,  
Solicitors for Defendants.

## APPENDIX I.

### FORMS OF INJUNCTION.

#### INTERLOCUTORY DECREE.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the United States Circuit Court, Northern District of  
California, Ninth Judicial Circuit.

WILLIAM J. BENKERT, Complainant, vs. SAMUEL FEDER and AURELIA ROSENTHAL, Executrix of the Last Will and Testa- ment of MORRIS ROSENTHAL, Deceased, Defendants.	}	No. 3507.
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At a stated term, to wit, the February term, 1888, of the circuit court of the United States of America of the ninth judicial circuit, in and for the northern district of California, held at the court room thereof, in the city and county of San Francisco, on Monday, the 1st day of June, A. D. 1888.

Present: The Honorable Lorenzo Sawyer, circuit judge.

This cause having come on to be heard upon the bill of complaint herein, the answer of the defendants, and replication of the complainant, the bill of revivor, the stipulation of the parties in regard thereto, and the proofs, documentary and written, taken and filed in said cause, and having been argued by counsel for the respective parties and submitted to the court for consideration and decision:

Now, therefore, on consideration thereof, it is ordered, adjudged and decreed, and the court doth hereby order, adjudge and decree, as follows, to wit:

That the name of "C. Benkert & Son" has been a trade-name and also a trade-mark upon boots and shoes for upwards of twenty-five years last past, and as such trade-name and trade-mark is good and valid in law.

That the complainant, William J. Benkert, is, and ever since the year 1876 has been, the exclusive owner of said trade-name and trade-mark, and during all said time, at the city of Philadelphia, in the state of Pennsylvania, has carried on the business, under the said trade-name, of manufacturing and selling boots and shoes, and during all said time has stamped and printed, and used upon all the said boots and shoes so made and sold by him, the said words "C. Benkert & Son" as a trade-mark.

That the original defendants herein, Samuel Feder and Morris Rosenthal, have infringed upon the said trade-name and trade-mark and upon the exclusive rights of the complainant under the same — that is to say, by manufacturing and selling within the ten years last past, and prior to the commencement of this suit, large quantities of boots and shoes upon each of which they have placed in plain, conspicuous, printed letters the name “C. F. Benkert & Son” in imitation of the name “C. Benkert & Son” as charged in the bill of complaint.

And it is further ordered, adjudged and decreed, that the complainant do have and recover of and from the defendants, Samuel Feder and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, the profits, gains and advantages which the said defendants or either of them have received or made, or which have arisen or accrued to them, or either of them, from the infringement of the said trade-name and said trade-mark of “C. Benkert & Son” by the making, using and selling, or the making, using or selling of said boots and shoes having placed thereon the name “C. F. Benkert & Son” or any other name in imitation of complainant’s trade-name and trade-mark of “C. Benkert & Son.”

And it is further ordered, adjudged and decreed, that the said complainant do recover of the defendants his costs and charges and disbursements in this suit to be taxed.

And it is further ordered, adjudged and decreed, that it be referred to S. C. Houghton, Esq., the standing master in chancery of this court, residing in the city and county of San Francisco, northern district, and state of California, to ascertain and take, and state, and report to this court, an account of the number of pairs of boots and shoes manufactured and sold or manufactured or sold by the original defendants, Samuel Feder and Morris Rosenthal, or either of them, and also the gains, profits and advantages which the said original defendants or either of them, or the estate of said Morris Rosenthal, have received, or made, or which have arisen or accrued to them or either of them, or it, from infringing the said exclusive rights of the said complainant by the manufacturing and selling, or manufacturing or selling, of boots and shoes having stamped and placed upon them the infringing trade-mark in imitation of the trade-mark of “C. Benkert & Son.”

And it is further ordered, adjudged and decreed, that the complainant on such accounting have the right to cause an examination of the defendants, Samuel Feder and Aurelia Rosenthal, and each of them, and their and each of their agents, servants, or workmen or other witnesses as may be necessary to take said accounting, and also the production of the books, vouchers and documents of which said defendants, Samuel Feder or Aurelia Rosenthal, and their and each of their attorneys, servants, agents and workmen may be possessed, and cause them to attend for such purposes before said master from time to time as such master shall direct.

And it is further ordered, adjudged and decreed, that a perpetual

injunction be issued in this case, against the said defendants Samuel Feder and Aurelia Rosenthal, restraining and perpetually enjoining them and each of them, and their and each of their servants, agents, clerks and workmen, and all persons claiming or holding under or through them, from manufacturing or using or selling, or in any way disposing of, boots and shoes or boots or shoes having stamped, or printed, or in any way marked thereon the name "C. F. Benkert & Son," or any other name in imitation or simulation of the said trade-mark "C. Benkert & Son," pursuant to the prayer of the said bill of complaint.

LORENZO SAWYER,

United States Circuit Judge, Ninth  
Judicial Circuit.

### WRIT OF INJUNCTION.

In the Circuit Court of the United States for the Ninth Judicial Circuit in and for the Northern District of California.

BOORD & SON, Complainant,

vs.

E. G. LYONS COMPANY, Respondent.

} In Equity.

The President of the United States, To E. G. Lyons Company, its clerks, agents, servants and employees, Greeting:

Whereas, It has been represented to us in the circuit court of the United States for the northern district of California that Boord & Son, a corporation, of London, England, have a valid trade-mark in a device consisting of a cat standing upon a barrel, as applied to bottled gin, and that you, the said E. G. Lyons Company, have infringed said right by dealing in bottled gin bearing an imitation of said trade-mark:

Now, therefore, you, the said E. G. Lyons Company, your clerks, agents, servants and employees, are strictly commanded and enjoined under the pains and penalties which may fall upon you, and each of you, in case of disobedience, that you forthwith and until the further order, judgment and decree of this court, desist from dealing in any gin bottled in imitation of complainant's gin and bearing the device of a cat standing upon a barrel.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, this 14th day of October, in the year of our [SEAL] Lord one thousand eight hundred and ninety-eight, and of our Independence the 123d.

SOUTHARD HOFFMAN, Clerk.

### FINAL DECREE.

(Royal Baking Powder Co. v. Royal Chemical Co.,  
Price & Steuart, 1.)

This cause having been tried at a special term of this court, before the Hon. Hooper C. Van Vorst, one of the justices thereof, without a

jury, and the proofs and allegations of the parties having been heard, the said court gave its decision in writing in favor of the plaintiffs, and against the defendants, with costs; which decision has been filed with the clerk of this court:

Now, in pursuance thereof, it is hereby adjudged that the plaintiffs are entitled to judgment on all the issues, and judgment is hereby rendered in favor of the plaintiffs, and against the defendants thereon, and it is hereby also adjudged that the plaintiffs are entitled to the exclusive use of the term "Royal," as their trade-mark, on labels attached to baking powder manufactured by them, and in connection with the words "baking powder." And it is further adjudged, that the use by the defendants of the word "Royal" on labels affixed to baking powder, made by the defendants, or printed or written on boxes, labels or otherwise howsoever, in connection with baking powder made by them, was in violation of the plaintiffs' rights.

And it is further adjudged, that the defendants, their agents, clerks, workmen, servants and attorneys, perpetually refrain, and they are hereby perpetually enjoined and restrained, from using the term or designation "Royal" on, or around, or in connection with, any cans, boxes or other packages, of any nature or kind whatever, containing baking powder, or in any sign, invoice, billhead, card, circular, advertisement, in connection with baking powder, and from using the name "Royal Baking Powder," and from selling and disposing of any baking powder with the word "Royal" attached thereto, except on such baking powder as is obtained from the plaintiffs.

And it is further adjudged, that the plaintiffs recover of the defendants their costs and disbursements in this action.

#### INJUNCTION.

(Gillis v. Hall, 2 Brewst. 342.)

Defendants enjoined "from making and selling any preparations as and for the preparations specified in plaintiff's label, and from using the name of Hall, or R. P. Hall, or Reuben P. Hall, either singly or in connection with others, upon any such preparation; or from making or using any trade-mark, label or wrapper in imitation of those now in use by plaintiff."

(Colton v. Thomas, 2 Brewst. 308.)

Injunction against defendant "restraining the further use of the cards and signs complained against in the bill; and also to restrain the employment by him of any device by which the patients and patrons of the plaintiff, without the exercise of excessive care, will be induced to suppose that the defendant's place of business is the place of business of the Colton Dental Association."

(*Gillott v. Esterbrook*, 47 Barb. 455.)

“Ordered and adjudged that the said defendants, R. E., R. E., Jr., J. C., Jr., and J. B., and each of them, their agents and servants, do absolutely and perpetually desist and refrain from infringing or using the said trade-mark of the plaintiff, and from making or selling pens with said numerals ‘303’ impressed on the boxes or packages containing steel pens.”

(*Jurgensen v. Alexander*, 24 How. Pr. 269; *Cox*, 298.)

Ordered: (1) “That the defendant, his agents, clerks, servants and all others employed under or in connection with him be perpetually enjoined and restrained from disposing of, selling, or causing to be disposed of or sold, any watches bearing the false, simulated and spurious stamp or mark, ‘Jules Jurgensen, Copenhagen.’”

2. “That the defendant do produce before Nathaniel Jarvis, Esq., appointed herein referee for such purpose, the said watches, which at the time of the commencement of this suit were in defendant’s possession, and had upon them the said false, simulated and spurious trade-mark, to be erased or obliterated therefrom, by or under the direction of the said referee, at the cost and expense of the said defendant.”

(*Coffeen v. Brunton*, 4 McLean, 516; *Cox*, 82.)

“To enjoin the defendant from using the label or directions accompanying the liniment he sells as aforesaid, or other labels or directions, or any advertisements or handbills respecting the same words which are used by the complainant on his label or directions, and which tend to produce an impression on the purchaser and the public that the liniment sold by the defendant contains the same ingredients as the ‘Chinese Liniment,’ and is, in effect, the same medicine.”

(*N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 Fed. Rep. 869.)

Defendant enjoined from putting up and selling or offering for sale “The particular form of packages which has been referred to in the bill and put in evidence as ‘defendant’s second package,’ or any other form of package which shall, by reason of the collocation of size, shape, colors, lettering, spacing and ornamentation, present a general appearance as closely resembling the ‘complainant’s package,’ referred to in the bill and marked in evidence, as does the said ‘defendant’s second package.’ This injunction shall not be construed as restraining defendant from selling packages of the size, weight, and shape of complainant’s package, nor from using the designation ‘Buffalo soap powder’ nor from making a powder having the appearance of complainant’s ‘Gold Dust,’ nor from using paper of a yellow color as wrappers for its packages, provided such packages are so differentiated in general appearance from said ‘complainant’s package’ that they are not calculated to deceive the ordinary purchaser.”

MANDATE OF CIRCUIT COURT OF APPEALS, AFFIRMING  
DECREE OF INJUNCTION.

(Feder v. Benkert, 76 Fed. Rep. 613.)

UNITED STATES OF AMERICA—ss.

THE PRESIDENT OF THE UNITED STATES OF AMERICA, To the Honorable the Judges of the Circuit Court of the United States for the Northern District of California, Greeting:

WHEREAS, lately in the circuit court of the United States for the northern district of California, before you, or some of you, in a cause between William J. Benkert, complainant, and Samuel Feder, and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, respondents, a decree was duly entered in favor of the said complainant, which said decree is of record in the office of the clerk of the said circuit court, to which record reference is hereby made and the same is hereby expressly made a part hereof, and as by the inspection of the transcript of the record of the said circuit court, which was brought into the United States circuit court of appeals for the ninth circuit, by virtue of an appeal agreeably to the act of congress in such cases made and provided, fully and at large appears.

AND WHEREAS, in the year of our Lord one thousand eight hundred and ninety-five, the said cause came on to be heard before the said circuit court of appeals, on the said transcript of record, and was argued by counsel:

On consideration whereof, it is now here ordered, adjudged and decreed, that the decree of the said circuit court in this cause be, and the same is hereby, affirmed, with costs.

You, therefore, are hereby commanded that such further proceedings be had in said cause as according to right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, the 16th day of November, in the year of our Lord one thousand eight hundred and ninety-five.

F. D. MONCKTON,  
Clerk of the United States Circuit Court  
of Appeals for the Ninth Circuit.



## APPENDIX J.

### UNOFFICIAL TRADE-MARK CLASSIFICATION.

(Suggested by Commissioner of Patents, January 1, 1897.)

#### DIVISION XXXIII.

##### *Trade-marks.*

This classification has no official character, but is a grouping of merchandise kindred in character to facilitate search by the Office. The parenthetical references point to the titles of analogous groups into which the field of search may extend, depending on the nature of the merchandise.

- |  |  |
|--|--|
| 1. Agricultural implements.              | 24. Firearms, ammunition and explosives. |
| 2. Baking-powder and yeast.              | 25. Flour.                               |
| 3. Beverages.                            | 26. Food and relishes.                   |
| 4. Blacking and leather dressing.        | 27. Fuel.                                |
| 5. Boots, shoes, and lasts.              | 28. Games and toys.                      |
| 6. Brooms and brushes.                   | 29. Glassware.                           |
| 7. Buttons.                              | 30. Gloves.                              |
| 8. Canned goods.                         | 31. Headwear.                            |
| 9. Carpets, etc.                         | 32. Household articles.                  |
| 10. Cement, plaster, and bricks.         | 33. Inks.                                |
| 11. Cigars and cigarettes.               | 34. Iron, steel, and manufactures.       |
| 12. Cleaning and polishing preparations. | 35. Jewelry and plated ware.             |
| 13. Coffee and tea.                      | 36. Lamps, lanterns, etc.                |
| 14. Confectionery.                       | 37. Lard and tallow.                     |
| 15. Corsets.                             | 38. Laundry articles.                    |
| 16. Cured meats.                         | 39. Leather and saddlery.                |
| 17. Cutlery and edge-tools.              | 40. Locks and hardware.                  |
| 18. Dairy products.                      | 41. Machines.                            |
| 19. Dentistry.                           | 42. Malt liquors.                        |
| 20. Drugs and chemicals.                 | 43. Matches.                             |
| 21. Dry-goods.                           | 44. Medical compounds.                   |
| 22. Fancy goods.                         | 45. Miscellaneous.                       |
| 23. Fertilizers.                         | 46. Musical instruments.                 |
|  | 47. Needles and pins.                    |

- |                                       |  |
|---------------------------------------|--|
| 48. Oils and lubricants.              | 64. Starch, corn-starch and products.    |
| 49. Optics and measuring instruments. | 65. Stationery miscellany.               |
| 50. Packing (machinery).              | 66. Stoves and heaters.                  |
| 51. Paints and painter's supplies.    | 67. Sugar, syrup, and molasses.          |
| 52. Paper and envelopes.              | 68. Surgical instruments and appliances. |
| 53. Poisons for animals.              | 69. Tailoring and clothing.              |
| 54. Publications.                     | 70. Time-keeping instruments.            |
| 55. Receptacles.                      | 71. Tobacco and snuff.                   |
| 56. Rope, cord, and twine.            | 72. Toilet articles and preparations.    |
| 57. Rubber goods.                     | 73. Tools and devices.                   |
| 58. Sewing-machines and attachments.  | 74. Umbrellas, parasols, and canes.      |
| 59. Sewingsilk, cotton and thread.    | 75. Underwear and furnishings.           |
| 60. Shirts, collars and cuffs.        | 76. Vehicles.                            |
| 61. Soap.                             | 77. Wines.                               |
| 62. Spices, mustard and salt.         |  |
| 63. Spirituous liquors.               |  |

*Prints and Labels.*

Not classified, but arranged in chronological order and preserved for reference in the Examiner's room.

One registration is sufficient to cover all the classes of goods upon which the mark is used. The applicant should, however, state for each class of goods the length of time for which the trade-mark has been used for that class of goods. Ex parte Clark-Jewell-Wells Co., 83 Off. Gaz. 915.

## APPENDIX K.

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## APPENDIX L.

### INTERNATIONAL ARRANGEMENTS.

#### INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

(Signed at Paris, March 20, 1883. Ratifications exchanged at  
Paris, June 6, 1884.)

*(Official Translation.)*

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure by mutual agreement complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say: [Here follow the appointments of the plenipotentiaries.]

Who having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:

##### ARTICLE I.

The governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia and Switzerland constitute themselves into a union for the protection of industrial property.

##### ARTICLE II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trade-marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

## ARTICLE III.

Subjects or citizens of states not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the states of the union, shall be assimilated to the subjects or citizens of the contracting states.

## ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval; either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade-mark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade-marks. A month longer is allowed for countries beyond sea.

## ARTICLE V.

(Relates only to patents.)

## ARTICLE VI.

Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union.<sup>1</sup>

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

## ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

## ARTICLE VIII.

A trade-name shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trade-mark.

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<sup>1</sup> No effect can be given to this or any other article of the convention by the courts of Great Britain, except so far as it is embodied in section 103 of the Patents Act, 1883. *Re California Fig Syrup Co.*, 40 Ch. D. 620. And to be registered in Great Britain, a foreign mark must contain one of the essential particulars defined in section 64 of said act. *Re Carter Medicine Co.*, L. R. (1892), 3 Ch. D. 472.

## ARTICLE IX.

All goods illegally bearing a trade-mark or trade-name may be seized on importation into those states of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

## ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade-name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

## ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognized international exhibitions.

## ARTICLE XII.

Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

## ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the contracting states, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the union.

## ARTICLE XIV.

The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting states by delegates of the said states. The next meeting shall take place in 1885 at Rome.

## ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

## ARTICLE XVI.

States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present convention.

## ARTICLE XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

## ARTICLE XVIII.

The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing state, the convention remaining in operation as regards the other contracting parties.

## ARTICLE XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Dated at Paris the 20th March, 1883.

(Signed by the Plenipotentiaries.)

## FINAL PROTOCOL.

*(Official Translation.)*

On proceeding to the signature of the convention concluded this day between the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia and

Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. (Relates only to patents.)

3. The last paragraph of article II does not affect the legislation of each of the contracting states, as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of article VI is to be understood as meaning that no trade-mark shall be excluded from protection in any state of the union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of article VI.

5. The organization of the special department for industrial property mentioned in article XII shall comprise, so far as possible, the publication in each state of a periodical official paper.

6. [After providing for the common expenses of the international office, continues:]

The Swiss government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the states of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations, or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the service of members of the union, in order to supply them with any special information they may need on questions relating to the internal system of industrial property.



The administration of the country in which the next conference is to be held will make preparation for the transactions of the conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present protocol.

(Signed by the Plenipotentiaries.)

#### ACCESSION OF GREAT BRITAIN AND IRELAND TO THE CONVENTION.

The undersigned, ambassador extraordinary and plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by article XVI of that convention to states not parties to the original convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said international convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to co-operate on her part in the execution of the stipulations contained in the convention and protocol aforesaid.

The undersigned makes this declaration on the part of Her Britannic Majesty, with the express understanding that power is reserved to Her Britannic Majesty to accede to the convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's government.

In witness whereof the undersigned, duly authorized, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(Signed) LYONS.

[L. S.]

DECLARATION OF ACCEPTANCE OF ACCESSION  
OF GREAT BRITAIN.*(Official Translation.)*

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the protection of industrial property, concluded at Paris, March 20th, 1883, together with a protocol dated the same day, by the declaration of accession delivered by her ambassador extraordinary and plenipotentiary to the government of the French Republic; the text of which declaration is word for word as follows:

[Here is inserted the text of the declaration of accession in English.]

The President of the French Republic has authorized the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties to assist in the accomplishment of the obligations stipulated in the convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorized, has drawn up the present declaration of acceptance and has affixed thereto his seal.

Done at Paris, the 2d April, 1884.

(Signed) JULES FERRY.

[L. S.]

This convention is not self-executing, but requires legislation to make it effective in the United States. Opinion of Miller, Attorney-General, 47 Off. Gaz. 397; Ex parte Zwack & Co., 73 Off. Gaz. 1855.

For a list of the existing treaties and conventions between the United States and foreign nations see *ante*, p. 326.





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